TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1916.

No. 721.

THOMAS EWING, COMMISSIONER OF PATENTS, PETITIONER,

vs.

THE UNITED STATES EX REL. THE FOWLER CAR COMPANY.

ON WRIT OF CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

PETITION FOR CERTIORARI FILED OCTOBER 12, 1916.
CERTIORARI AND RETURN FILED NOVEMBER 22, 1916.

SUPREME COURT OF THE UNITED STATES.

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THOMAS EWING, COMMISSIONER OF PATENTS, PETITIONER,

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THE UNITED STATES EX REL. THE FOWLER CAR COMPANY.

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70468—16——1

1 Court of Appeals of the District of Columbia.

THOMAS EWING, COMMISSIONER OF PATENTS, APPELLANT,
vs.
U. S. EX. REL. THE FOWLER CAR COMPANY. } No. 2924.

Supreme Court of the District of Columbia.

UNITED STATES EX RELATIONE THE FOWLER CAR Company, petitioner,
vs.
THOMAS EWING, COMMISSIONER OF PATENTS, respondent. } At Law, No. 58768.

UNITED STATES OF AMERICA,
District of Columbia, ss:

Be it remembered, that in the Supreme Court of the District of Columbia, at the city of Washington, in said District, at the times hereinafter mentioned, the following papers were filed and proceedings had in the above-entitled cause, to wit:

Petition.

Filed January 18, 1916.

In the Supreme Court of the District of Columbia.

UNITED STATES EX RELATIONE THE FOWLER CAR Company, petitioner,
vs.
THOMAS EWING, COMMISSIONER OF PATENTS, respondent. } At Law, No. 58768.

Your petitioner, The Fowler Car Company, respectfully represents:

(I.) That your petitioner is a corporation duly organized and existing under the laws of the State of Illinois and has its principal office and place of business at Chicago, County of Cook and State of Illinois, and brings this action in its own right.

2 (II.) That the respondent, Thomas Ewing, is the Commissioner of Patents, and resides at Washington, in the District of Columbia.

(III.) That, as your petitioner is advised and believes, prior to the 22nd day of May, 1915, William E. Fowler, sr., a citizen of the United States and a resident of Chicago, in the county of Cook and State of Illinois, was the true, original, and first inventor or discoverer of certain new and useful improvements in car-floor construction, not known or used by others in this country before his in-

vention or discovery thereof, not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to the hereinafter mentioned application for letters patent of the United States therefor, and not in public use or on sale in the United States for more than two years prior to said application; and for which invention or discovery no application for letters patent in any foreign country had been filed by said Fowler or his assigns or legal representatives more than twelve months prior to the filing of the application for a patent for his said invention in this country.

(IV.) That on the 22nd day of May, 1915, said William E. Fowler, sr., duly filed in the United States Patent Office an application for letters patent of the United States for said invention or discovery; that said application was in writing and addressed to the Commissioner of Patents, in due form, as required by the Statutes of the United States and by the Rules of Practice in the United States Patent Office, in such case made and provided; that with such application was filed a written description of said invention and of the manner of making, constructing, and using the same in such full, clear, concise, and exact terms as to enable any person skilled in the art to which said invention appertains or with which it is most closely connected, to make, construct, and use the same; that said application particularly pointed out and distinctly claimed the parts, improvements, and combinations which were claimed to be the invention of the said William E. Fowler, sr.; that the specification and claims of said application were duly signed by William E. Fowler, sr., and attested by two witnesses; that there was furnished with said application drawings of said invention signed by the attorneys of said William E. Fowler, sr., and attested by two witnesses; that the said William E. Fowler, sr., made oath before a proper officer, according to law, that he verily believed that he was the original, first, and sole inventor of the improvement described and claimed in the specification forming part of the said application; that he did not know and did not believe that the same was ever known or used before the invention or discovery thereof by the said William E. Fowler, sr., or patented or described in any printed publication in any country before his invention or discovery thereof, or more than two years prior to the aforesaid application for letters patent, or in public use or on sale in the United States for more than two years prior to said application; and, further, that said invention had not been patented in any country

3 foreign to the United States on an application filed by the said William E. Fowler, sr., or his legal representatives or assigns, more than twelve months prior to said application, and that no application for patent on said improvement has been filed by said William E. Fowler, sr., or his representatives or assigns in any country foreign to the United States; that the said William E. Fowler, sr., did at the time of the filing of said application pay the Commissioner of Patents the sum of fifteen dollars ($15), the fee

required by law, and did in all other respects fully comply with the Statutes of the United States and the Rules of Practice in the United States Patent Office in such case made and provided; that such application was duly accepted by the Commissioner of Patents as a valid and complete application under the law; and that said application became known and designated as application Serial No. 29,794, and is now a valid and subsisting application.

(V.) That on the 19th day of May, 1915, the said William E. Fowler, Sr., by an instrument in writing, and for a valuable consideration, did sell, assign and transfer to The Fowler Car Company, your petitioner, its successors and assigns, the entire right, title, and interest in and to said invention and application, and in and to any letters patent that might be granted for said invention, and, in said assignment, did request the Commissioner of Patents to issue any patent that might be granted upon said application to your petitioner, its successors and assigns; and that your petitioner has since the date of said assignment continued to be and now is the owner of said invention and application and all rights thereunder, and is entitled to have issued to it any patent that may be granted for said invention upon said application.

(VI.) That on the 19th day of May, 1915, your petitioner duly appointed Charles C. Linthicum of Chicago, Illinois, its attorney in fact, to prosecute said application, to make alterations and amendments therein, to receive the patent when issued, and to transact all business in the Patent Office in connection with said application, and requested that all communications respecting said application be addressed to Charles C. Linthicum, 715 Monadnock Bldg., Chicago, Illinois.

(VII.) That on the 18th day of November, 1915, the respondent, Thomas Ewing, Commissioner of Patents, wrote a letter to Charles C. Linthicum, the petitioner's attorney, in which it was stated that "there is another application pending claiming substantially the same invention as that defined in the following claims:

1. In a railway car, the combination with the floor and side wall, of a side will, a substantially Z section sub-sill resting on said side sill and interposed between said floor and wall.

2. In a railway car, the combination with the side sill, and floor and side wall, of a substantially Z section sub-sill interposed between said floor and wall, said sub-sill engaging the flange of the side sill.

3. In a railway car, the combination with the side sill, and floor and side wall, of a substantially Z section sub-sill interposed between said floor and wall, said sub-sill engaging the flange of the side sill to prevent lateral movement of the sub-sill on the side sill.

4. In a railway car, the combination with the side sill, and floor and side wall, of a substantially Z section sub-sill supported by said side sill, said sub-sill engaging with a groove in said side wall, and with a rabbet in said floor.

5. In a railway car, the combination with the side sill and side, of a substantially Z section sub-sill interposed between said side sill and side, and adapted to prevent lateral movement of the side.

6. In a railway car, the combination with the side sill and side, of a substantially Z section sub-sill interposed between said side sill and side, and adapted to prevent lateral movement of the side, and a floor resting on said sub-sill.

In order to determine whether it is necessary to declare an interference you are requested to obtain a statement from Fowler setting forth when he conceived the invention defined in the above quoted claims, when he disclosed it to others, and when he reduced it to practice. This statement will not be made a part of the record and will be returned to you.

A response is requested within twenty days."

A copy of said letter of November 18, 1915, is hereunto annexed, marked "Exhibit A."

(VIII.) That on the 23rd day of November, 1915, the said Charles C. Linthicum, in behalf of your petitioner, replied to the last named letter of the respondent and accompanied the same with a statement setting forth the dates called for by the respondent's communication of November 18, 1915, a copy of which statement is hereunto annexed, marked "Exhibit B," but insisted that on the respondent's own showing an interference already existed under the statutes and rules between the aforesaid Fowler application, owned by your petitioner, and the other pending application referred to by the respondent in his said communication of November 18, 1915, and requested that an interference be declared between said applications.

(IX.) That on or about the 26th day of November, 1915, your petitioner's said attorney prepared and filed in the Patent Office an amendment to said Fowler application in which the claims suggested by the Commissioner were inserted in said application. A copy of said amendment is hereunto annexed, marked "Exhibit C."

(X.) That on the 10th day of December, 1915, respondent in reply to the letter of said Charles C. Linthicum last above referred to again wrote to Mr. Linthicum, refusing to declare an interference between your petitioner's Fowler application and the undisclosed pending application, claiming the same invention. A copy of said letter of December 10, 1915, is hereunto annexed, marked "Exhibit D."

(XI.) That Section 4904 of the Revised Statutes of the United States which authorizes and directs the institution of interference proceedings, reads as follows:

"Sec. 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any
5 pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And

the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe."

(XII) That section 483 of the Revised Statutes of the United States, conferring power to regulate proceedings in the Patent Office, reads as follows:

"Sec. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may, from time to time, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

(XIII) That, pursuant to such statutory authority, regulations, known as "Rules of Practice in the United States Patent Office," have been established by the respondent, by and with the approval of the Secretary of the Interior, and now regulate and govern the declaration of interferences between pending conflicting applications and between pending applications that conflict with unexpired patents, and have the force and effect of law, being binding as well upon the respondent as upon applicants for patent.

(XIV) That rule 93 of such regulations provides as follows:

"93. An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. The fact that one of the parties has already obtained a patent will not prevent an interference, for, although the commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor."

(XV) That rule 94 of such regulations provides as follows:

"94. Interferences will be declared in the following cases, when all the parties claim substantially the same patentable invention: (1) Between two or more original applications containing conflicting claims."

(XVI) That rule 95 of such regulations provides as follows:

"95. Before the declaration of interference all preliminary questions must be settled by the primary examiner, and the issue must be clearly defined: the invention which is to form the subject of the controversy must be decided to be patentable, and the claims of the respective parties must be put in such condition that they will not require alteration after the interference shall have been finally decided, unless the testimony adduced upon the trial shall necessitate or justify such change."

(XVII) That rule 96 of such regulations provides as follows:

"96. Whenever the claims of two or more applications differ in phraseology, but cover substantially the same patentable subject matter, the examiner, when one of the applications is ready
6 for allowance, will suggest to the parties such claims as are necessary to cover the common invention in substantially the same language. The examiner will send copies of the letter suggest-

ing claims to the applicant and to the assignees, as well as to the attorney of record in each case. The parties to whom the claims are suggested will be required to make such claims and put the applications in condition for allowance within a specified time in order that an interference may be declared. Upon the failure of any applicant to make the claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by the claim, and the issue of the patent to the applicant whose application is in condition for allowance will not be delayed unless the time for making the claim and putting the application in condition for allowance be extended upon a proper showing. If a party make the claim without putting his application in condition for allowance, the declaration of the interference will not be delayed, but after judgment of priority the application of such party will be held for revision and restriction, subject to interference with other applications."

(XVIII) That rule 110 of such regulations provides as follows:

"110. Each party to the interference will be required to file a concise preliminary statement, under oath, on or before a date to be fixed by the office, showing the following facts:

"(1) The date of original conception of the invention set forth in the declaration of interference.

"(2) The date upon which a drawing of the invention was made.

"(3) The date upon which the invention was first disclosed to others.

"(4) The date of the reduction to practice of the invention.

"(5) A statement showing the extent of use of the invention.

"(6) The application shall state the date and number of any application for the same invention filed within twelve months before the filing date in the United States, in any foreign country adhering to the international convention for the protection of industrial property or having similar treaty relations with the United States.

"If a drawing has not been made, or if the invention has not been reduced to practice or disclosed to others or used to any extent, the statement must specifically disclose these facts."

(XIX) That from the hereinabove recited correspondence between the respondent and petitioner, and particularly from respondent's letter of November 18, 1915, "Exhibit A," it clearly appears, and petitioner charges the fact to be, that there are now pending in the Patent Office two applications for patents, to wit, petitioner's said Fowler application and an application of an applicant to your petitioner unknown, which applications disclose and claim the same patentable invention, and that a case of interference exists between said applications under the statute and rules, and that it is the duty of the respondent, under the statute and rules, to declare said interference and to call upon each applicant for the sworn preliminary statement required by rule 110; that there has been
7 and continues to be a dereliction of duty on the part of respondent in not declaring such interference; that the call by

respondent upon petitioner, in his letter of November 18, 1915, for an informal unsworn statement of the dates respecting the conception, disclosure, and reduction to practice of the Fowler invention was entirely irregular and unjustifiable under the rules; that the action of the respondent in allowing and passing to issue, with a view to its going to patent, the conflicting interfering application of the unknown applicant, without the declaration of an interference and without calling upon both applicants for sworn preliminary statements, constitutes a breech and violation of the statute and of the rules, and is calculated to and will seriously damage and injure your petitioner; that your petitioner is, under the statute and rules, entitled to an immediate interference with said unknown applicant, before said unknown applicant receives a patent; that if said unknown applicant receives a patent and thereafter petitioner's Fowler application is put in interference with such patent and your petitioner, after a long and expensive course of litigation, is decided to be entitled to an award of priority over said unknown applicant, and receives a patent upon said Fowler application, your petitioner, in order to get rid of the menace of the outstanding patent to such unknown applicant, will have to file a bill in equity under the provision of section 4918 of the Revised Statutes of the United States for the cancellation of such outstanding patent, or, if the owner of such outstanding patent so elects, said owner may, on his part, file a bill in equity of the same nature, against your petitioner under said section 4918 and pray that your petitioner's patent be canceled, all of which possibilities of litigation may be prevented and the delay and expense incident thereto averted, if the respondent be required to discharge his plain duty under the statute and under the rules governing the conduct of proceedings in the Patent Office, by forthwith declaring an interference while the rights of both parties are in the application stage and before either party receives a patent.

(XX) That the conduct of respondent complained of is a matter of large public concern involving, as it does, the integrity, validity, and binding effect of the interference rules of the Patent Office upon respondent and other officials whose duty it is to observe and enforce them; that for over a quarter of a century respondent's predecessors have, without exception, regarded said interference rules as imposing upon them the legal duty of declaring an interference whenever two pending applications claimed substantially the same patentable subject matter; and that respondent's conduct complained of is a radical departure from, and violation of, such long-settled practice.

(XXI) That the respondent has refused and continues to refuse to declare the aforesaid interference, or to withdraw the application of the aforesaid unknown applicant from issue, though requested so to do; and that as your petitioner is advised and believes a patent will in due course, issue to the aforesaid unknown applicant unless this court interposes in your petitioner's behalf; that by the

refusal of the respondent to so declare such interference and to withhold the issuance of said patent for interference purposes, your petitioner is deprived of legal rights vested in him by the laws of the United States relating to the granting of letters patent for inventions and by the Rules of Practice governing proceedings in the Patent Office in interference cases, and is entirely without redress or remedy in the premises, unless this honorable court by its writ of mandamus shall interpose in its behalf.

Wherefore, your petitioner prays that a writ of mandamus may be issued by this honorable court to the said respondent, Thomas Ewing, Commissioner of Patents, commanding him to declare or to direct to be declared an interference between your petitioner's said Fowler application and the application of the aforesaid unknown applicant whose interfering application is now pending, and further commanding and directing him to withdraw from the issue the said interfering application of said unknown applicant, and further commanding and directing him not to issue a patent to said unknown applicant, upon said interfering application, unless and until opportunity is given your petitioner to be heard, in lawful interference proceedings upon the question of priority of invention, as between William E. Fowler and the aforesaid unknown applicant, in respect to the patentable subject matter claimed, in common, in said aforesaid applications.

THE FOWLER CAR COMPANY,
By CHARLES H. HUGHES,
Secretary and Treasurer.

MELVILLE CHURCH,
C. C. LINTHICUM,
Attorneys for Petitioner.

STATE OF ILLINOIS,
County of Cook, ss:

Charles H. Hughes, being duly sworn, deposes and says that he is secretary and treasurer of The Fowler Car Company, the petitioner above named; that he has read the foregoing petition by him signed for and on behalf of the said The Fowler Car Company and knows the contents thereof; that the statements therein contained are true of his own knowledge, except as to those matters therein stated to be on information and belief, and as to such matters he verily believes it to be true.

CHARLES H. HUGHES.

Subscribed and sworn to before me this 30th day of December, 1915.

[SEAL.]

T. D. BUTLER,
Notary Public.

9

EXHIBIT "A."

WASHINGTON, D. C., *November 18, 1915.*

Mr. CHARLES C. LINTHICUM,
Monadnock Building, Chicago, Illinois.

SIR: My attention has been called to the application of William E. Fowler, sr., Serial No. 29,794, filed May 22, 1915, in which you are the attorney of record.

There is another application pending claiming substantially the same invention as that defined in the following claims:

1. In a railway car, the combination with the floor and side wall, of a side sill, a substantially Z section sub-sill resting on said side sill and interposed between said floor and wall.

2. In a railway car, the combination with the side sill, and floor and side wall, of a substantially Z section sub-sill interposed between said floor and wall, said sub-sill engaging the flange of the side sill.

3. In a railway car, the combination with the side sill, and floor and side wall, of a substantially Z section sub-sill interposed between said floor and wall, said sub-sill engaging the flange of the side sill to prevent lateral movement of the sub-sill on the side sill.

4. In a railway car, the combination with the side sill, and floor and side wall, of a substantially Z section sub-sill supported by said side sill, said sub-sill engaging with a groove in said side wall, and with a rabbet in said floor.

6. In a railway car, the combination with the side sill and side, of a substantially Z section sub-sill interposed between said side sill and side, and adapted to prevent lateral movement of the side.

7. In a railway car, the combination with the side sill and side, of a substantially Z section sub-sill interposed between said side sill and side, and adapted to prevent lateral movement of the side, and a floor resting on said sub-sill.

In order to determine whether it is necessary to declare an interference, you are requested to obtain a statement from Fowler setting forth when he conceived the invention defined in the above quoted claims, when he disclosed it to others, and when he reduced it to practice. This statement will not be made a part of the record and will be returned to you.

A response is requested within twenty days.

Respectfully,

THOS. EWING, *Commissioner.*

10 EXHIBIT "B."

CHARLES C. LINTHICUM,
Counsel in Patent Causes,
Monadnock Building, Chicago.

London: Wm. Edward Lake, W. J. Mellersh-Jackson, 28 Southampton Buildings.

Chicago: Charles F. Murray, Lewis T. Greist, Franklin M. Warden, William N. Cromwell, Eben O. McNair, jr.

New York: D. Anthony Usina, 71 Broadway.

Pittsburgh, Pa.: Richard D. Little, Oliver Building.

Washington, D. C.: H. Schuyler Shepard, McGill Building.

NOVEMBER 23, 1915.

HON. COMMISSIONER OF PATENTS, *Washington, D. C.*

SIR:

William E. Fowler. Car Floor Construction. Filed May 22, 1915. Serial No. 29,794.

In response to your request, I beg to say that I conceived the subject matter of the claim quoted in your letter on or about April 16, 1915, disclosed the same to others and made drawings on or about the same date, and have not reduced the invention to practice by constructing any full-sized devices.

Respectfully submitted.

(S'g'd) WILLIAM E. FOWLER, SR.

EXHIBIT "C."

In the United States Patent Office.

Div. 34, Room 304.

In re Application of WILLIAM E. FOWLER. Car Floor Construction. Filed May 22, 1915. Serial No. 29,794.

Amendment.

HON. COMMISSIONER OF PATENTS, *Washington, D. C.*

SIR: Please insert the following new claims:

1. In a railway car, the combination with the floor and side wall, of a side sill, a substantial Z section sub-sill resting on said side sill and interposed between said floor and wall.

2. In a railway car, the combination with the side sill, and floor and side wall, of a substantially Z section sub-sill interposed between said floor and wall, said sub-sill engaging the flange of the side sill.

11 3. In a railway car, the combination with the side sill, and floor and side wall, of a substantially Z section sub-sill inter-

posed between said floor and wall, said sub-sill engaging the flange of the side sill to prevent lateral movement of the sub-sill on the side sill.

4. In a railway car, the combination with the side sill, and floor and side wall, of a substantially Z section sub-sill supported by said side sill, said sub-sill engaging with a groove in said side wall, and with a rabbet in said floor.

5. In a railway car, the combination with the side sill and side, of a substantially Z section sub-sill interposed between said side sill and side, and adapted to prevent lateral movement of the side.

6. In a railway car, the combination with the side sill and side, of a substantially Z section sub-sill interposed between said side sill and side, and adapted to prevent lateral movement of the side, and a floor resting on said sub-sill.

It is thought that these claims appear in a co-pending application and they are inserted at this time with the request that, if such claims do appear in a co-pending application an interference be declared.

Respectfully submitted.

(S'g'd) C. C. LINTHICUM,
Attorney for Applicant.

CHICAGO, ILL., *Nov. 23, 1915.*

EXHIBIT "D."

WASHINGTON, D. C., *December 10, 1915.*

MR. CHARLES C. LINTHICUM,
Monadnock Building, Chicago, Illinois.

SIR: Enclosed please find the statement of William E. Fowler, Sr., made in response to the request in my letter of November 18, 1915.

The dates of invention claimed by Fowler are subsequent by several months to the filing date of the application of the other party. The other party's case will be passed to issue as soon as possible and when patented will be cited as a reference against such claims in Fowler's application as it may be found to anticipate.

An interference will not be declared.

Respectfully,

THOS. EWING,
Commissioner.

Enclosure.

Rule to Show Cause.

Filed January 18, 1916.

* * * * * * *

Upon consideration of the petition and mandamus in the above entitled cause, it is, this 18th day of January, 1916, Ordered:

That the respondent herein show cause on the 26" day of January, 1916, at 3 o'clock p. m., before this Court, sitting as Cir-

12 cuit Court No. 2, why a writ of mandamus should not issue, as prayed in said petition, provided that a copy of this order and of said petition be served on the respondent on or before the 19th day of January, 1916.

And it is further ordered that further proceedings in the United States Patent Office in the matter of the interfering application of the unknown party mentioned in the petition, be stayed until the determination of this cause or the further order of this Court.

WENDELL P. STAFFORD, *Justice.*

Marshal's Return.

Served a copy of the within order on Thomas Ewing, Com. of Patents, personally, Jan. 18, 1916.

MAURICE SPLAIN, *Marshal.*

Answer to Rule to Show Cause.

Filed January 25, 1916.

* * * * * * *

The Honorable the Judges of the Supreme Court of the District of Columbia:

The respondent, Thomas Ewing, Commissioner of Patents, in response to the order to show cause why a writ of mandamus should not issue and in answer to relator's petition, says upon information and belief:

That the party, William E. Fowler, Sr., filed in the Patent Office upon May 22, 1915, an application for letters patent for an improvement in Car Floor Construction, which application was numbered 29,794, that Charles C. Linthicum was appointed attorney for the applicant, and that the application was assigned to the Fowler Car Company of Chicago, Illinois.

Respondent admits that on November 18, 1915, a letter was written to the applicant's attorney, in which it was stated that there was another application pending in the Patent Office claiming substantially the same invention as that defined in certain claims, which claims are set out in the petition, and that the attorney was requested to obtain from the applicant a statement setting forth when he conceived the invention, when he disclosed it to others, and when he reduced it to practice, in order that it might be determined whether it would be necessary to declare an interference.

Respondent further admits the receipt of a letter stating the date upon which the applicant conceived the invention, disclosed the same to others, and made drawings thereof, and that an amendment was filed to the application containing the claims set out in respondent's letter (relator's Exhibit A), and that this amendment (relator's Exhibit C) contained a request that an interference be declared on these claims.

13 Respondent further admits that on December 10, 1915, the attorney was notified that an interference involving these claims would not be declared, for the reason that the date of conception of the invention stated by the applicant Fowler in his letter of November 23, 1915, (relator's Exhibit B), was subsequent by several months to the filing date of the application of the other party, and that the other party's application would be passed to issue as soon as possible, and that subsequently it was passed to issue.

Respondent avers that the date of conception stated by the applicant Fowler is several months subsequent to the date on which the other application referred to was filed.

Respondent denies that in writing the letters of November 18, 1915, and December 10, 1915 (relator's Exhibits A and D), and in refusing to declare an interference between the application owned by petitioner and the other application, he has violated any statute or any rule of the Patent Office.

Further answering respondent avers that an interference is, as defined by the rules of practice of the Patent Office, a proceeding for the purpose of determining the question of priority of invention, and that where an applicant informs the Patent Office that the invention shown in his application was made at a date which is subsequent to the date upon which another application for the same invention was filed, the statute does not require that an interference be established between his application and the prior application.

Respondent avers that in asking the later applicant to inform the Patent Office of his date of invention he was only asking for information upon which he might form, as required by section 4904 of the Revised Statutes, an opinion whether a situation existed where the statute required that said later application be put into interference with said earlier pending application.

Respondent further answering avers that his action was not in conflict with the rules of practice relating to interferences, since these rules do not contemplate a declaration of an interference where it is known that the later applicant made his invention subsequently to the filing of the earlier application; in other words, they do not contemplate the declaration of an interference except where there is a possible conflict in the dates of invention.

Respondent denies that petitioner has shown any injury or any threatened injury. The only allegation of injury made in the petition is that if the application owned by the petitioner should be put in interference with a patent granted upon the other application, and priority should be awarded to the former and petitioner granted a patent upon his application, a bill in equity under the provisions of section 4918 of the Revised Statutes would be necessary in order to get rid of the menace of the outstanding patent. The date of conception of the invention alleged by the applicant Fowler is, however, subsequent to the filing date of the other party, and there would therefore be no ground upon which to award priority to the appli-

cant Fowler. Furthermore, if such an interference could be declared, a litigation to be conducted between the application owned
14 by the petitioner and the patent issued to the other party would be no longer or more expensive than a litigation to be conducted between the two applications. No suit could be brought under section 4918 of the Revised Statutes either by or against this petitioner, unless it were proved that Fowler was the first inventor and a patent issued to him; but, as above stated, the date upon which Fowler states he conceived the invention is subsequent to the date upon which the other application was filed.

Further answering, respondent avers that there are now pending in the Patent Office approximately 141,500 applications, and that approximately 67,000 applications for patent are filed each year; that a large number of applications are found to contain conflicting claims; that it is of the highest public interest that the prosecution of all applications be brought to a speedy conclusion, so that patents may be issued on those applications which are found allowable; that in a large number of interferences where the junior applicant makes no claim of prior conception the prosecution of the applications involved is greatly delayed, owing to the presentation of motions involving questions which do not involve the question of priority, but which constitute reasons why no interference should ever have been declared and amount merely to opposition to the grant of a patent to the senior party; that it is therefore highly desirable, without declaring an interference, to ascertain whether the later applicant claims to have conceived the invention at a date prior to the filing date of the earlier applicant, and, if he makes no such claim, to grant a patent upon the earlier application without needless delay; that this procedure does not deprive the later applicant of any right to contend thereafter that the patent granted on the earlier application is not a bar, under the provisions of section 4886 of the Revised Statutes, to the grant of a patent on his later application; that the practice thus set out is a part of the general policy of the Patent Office to prevent as much as possible the accumulation of applications pending before the Patent Office; and that within the last year the office has finally disposed of somewhat more cases than it received, as is required if it will keep up with its work.

Further answering, the respondent states that in accordance with the restraining order issued on January 18, 1916, the application of the other party has been withdrawn from issue.

And now, having fully answered the petition, respondent prays that the rule to show cause issued against him be discharged and that the restraining order issued on January 18, 1916, be vacated.

THOMAS EWING,
Commissioner of Patents.

DISTRICT OF COLUMBIA, *ss:*

I, Thomas Ewing, being first duly sworn, on oath depose and say that I am the Commissioner of Patents; that I have read the forego-

ing answer by me subscribed and know the contents thereof; that the matters and things therein stated of my own knowledge are true and those stated on information and belief I believe to be true.

THOMAS EWING.

15 Subscribed and sworn to before me this 25th day of January, 1916.

[SEAL.]

EDW'D B. FO..,
Notary Public in and for D. C.

Motion for Judgment.

Filed January 26, 1916.

* * * * * * *

And now comes the petitioner, by Melville Church, its attorney, and moves for a peremptory writ of mandamus against the respondent, notwithstanding the return of the respondent herein.

MELVILLE CHURCH,
Attorney for Petitioner.

WASHINGTON, D. C., *January 26", 1916.*

Supreme Court of the District of Columbia.

WEDNESDAY, *January 26", 1916.*

Session resumed prsuant to adjournment, Hon. Wendell P. Stafford, justice presiding.

* * * * * * *

This cause came on to be heard upon the petition filed herein, the rule to show cause issued, the answer to said rule, and the motion of petitioner for judgment notwithstanding said answer and was argued and submitted to the court. Wherefore, upon consideration thereof, it is now ordered that the prayer of said petition be, and the same is hereby granted. Whereupon it is ordered that a writ of mandamus issued herein, directed to Thomas Ewing, Commissioner of Patents, commanding him to declare or direct to be declared an interference between the application of William E. Fowler, sr., filed May 22, 1915, for Improvements in Car Floor Construction, and the application for a similar invention of the unnamed applicant referred to in said petition and answer, pursuant to the statute and rules in such cases made and provided.

Further, it is considered that the petitioner recover of the respondent its costs of suit to be taxed by the clerk and have execution thereof.

From the foregoing, the defendant by his attorney of record, in open court, notes an appeal to the Court of Appeals.

Assignments of Error.

Filed January 29, 1916.

* * * * * * *

Now comes the respondent and assigns the following errors in the action and proceedings of the Supreme Court of the District of Columbia in the said cause:

16 The court erred:

1. In granting relator's petition for a writ of mandamus and in ordering said writ to issue.

2. In ordering that further proceedings in the United States Patent Office in the matter of the application of the unknown party mentioned in the petition be suspended.

3. In commanding the respondent to declare or direct to be declared an interference between the application of William E. Fowler, senior, No. 29794, and the application of the unknown applicant, referred to in the petition.

4. In holding that the action taken by the respondent was not within his discretionary authority as Commissioner of Patents, under the statutes of the United States and the rules of practice of the United States Patent Office.

5. In holding that it was the duty of the respondent, under the circumstances set out in the petition, to order the declaration of the interference.

6. In holding that relator has shown that he was injured or threatened with injury by the action taken by the respondent.

7. In not dismissing the relator's petition for a writ of mandamus.

R. F. WHITEHEAD,
Attorney for Respondent.

JANUARY 28, 1916.

Order for Transcript of Record.

Filed January 29, 1916.

* * * * * * *

The clerk of said court will prepare a transcript of record for appeal to the Court of Appeals of the District of Columbia, to include the following papers:

Petition of relator and exhibits attached thereto;
The rule on respondent to show cause;
The respondent's answer to the rule to show cause;
Motion by relator for judgment;
The order of Justice Stafford;
The notice of appeal;
Assignments of error;
Designation of record.

R. F. WHITEHEAD.
Attorney for Respondent.

JANUARY 28, 1916.

Supreme Court of the District of Columbia.

UNITED STATES OF AMERICA,
District of Columbia, ss:

I, John R. Young, clerk of the Supreme Court of the District of Columbia, hereby certify the foregoing pages numbered from
17 1 to 30, both inclusive, to be a true and correct transcript of the record, according to directions of counsel herein filed, copy of which is made part of this transcript, in cause No. 58768 at law, wherein United States ex relatione The Fowler Car Company, is petitioner, and Thomas Ewing, Commissioner of Patents, is respondent, as the same remains upon the files and of record in said court.

In testimony whereof, I hereunto subscribe my name and affix the seal of said court, at the city of Washington, in said District, this 7th day of February, 1916.

[Seal Supreme Court of the District of Columbia.]

JOHN R. YOUNG, *Clerk.*

Endorsed on cover: District of Columbia Supreme Court. No. 2924. Thomas Ewing, Commissioner of Patents, appellant vs. U. S. ex rel. The Fowler Car Company. Court of Appeals, District of Columbia. Filed Feb. 7, 1916. Henry W. Hodges, clerk.

18 Monday, April 3rd, A. D. 1916.

THOMAS EWING, COMMISSIONER OF PATENTS, APPELLANT,
vs.
UNITED STATES EX RELATIONE THE FOWLER CAR COMPANY. } No. 2924.

The argument in the above-entitled cause was commenced by Mr. R. F. Whitehead, attorney for the appellant, and was continued by Messrs C. C. Linthicum and Melville Church, attorneys for the appellee, and was concluded by Mr. R. F. Whitehead, attorney for the appellant.

19 Court of Appeals of the District of Columbia.

THOMAS EWING, COMMISSIONER OF PATENTS, APPELLANT,
v.
UNITED STATES EX RELATIONE THE FOWLER CAR COMPANY, appellee. } No. 2924.

(Opinion.)

Mr. Justice Van Orsdel delivered the opinion of the court:

This appeal is from a judgment of the Supreme Court of the District of Columbia awarding appellee, petitioner below, a writ of

mandamus commanding appellant, the Commissioner of Patents, to declare, or direct to be declared, an interference between petitioner's application for a patent and the application of an undisclosed applicant for a patent for a similar invention.

It appears that on November 18, 1915, the commissioner wrote a letter to petitioner's attorney stating that there was another application pending in the Patent Office containing substantially the same invention as that defined in seven claims set out in full in the letter. After setting out the claims the letter contained the following request: "In order to determine whether it is necessary to declare an interference, you are requested to obtain a statement from Fowler setting forth when he conceived the invention defined in the above quoted claims, when he disclosed it to others, and when he reduced it to practice. This statement will not be made a part of the record and will be returned to you."

Shortly thereafter, on November 23, 1915, petitioner's attorney wrote the commissioner enclosing the following communication from petitioner: "In response to your request I beg to say that I conceived the subject-matter of the claim quoted in your letter on or about April 16, 1915, disclosed the same to others and made drawings on or about the same date, and have not reduced the invention to practice by constructing any full-sized devices."

On the same date petitioner, through his attorney, filed and amendment to his application, inserting the claims suggested in the commissioner's letter, with the following statement: "It is thought that these claims appear in a copending application, and they are inserted at this time, with the request that if such claims do appear in a copending application an interference be declared." On December 10, 1915, the commissioner replied to petitioner's attorney as follows: "The dates of invention claimed by Fowler are subsequent by several months to the filing date of the application of the other party. The other party's case will be passed to issue as soon as possible, and when patented will be cited as a reference against such claims in Fowler's application as it may be found to anticipate."

The commissioner's return to the rule to show cause is based upon the ground that petitioner's date of conception is several months subsequent to the date on which the other application was filed, and that this finding justifies the commissioner in refusing to declare an interference.

Concededly, the commissioner found that an interference existed between the pending applications, but to avoid what he deemed must, in all probability, result in fruitless litigation, he refused to declare an interference. It is urged by counsel for petitioner that having found the existence of an interference the commissioner is without discretion to refuse its declaration. That the finding of an interference it a matter confided to the discretion of the commissioner was held by this court in Trussed Concrete Steel Co. v. Ewing (42 App. D. C., 179; 42 Wash. Law Rep., 314), where the court in its opinion said: "The determination of the existence of an inter-

ference is confided by the statute to the judgment and discretion of the Commissioner of Patents; and whether in the exercise of that judgment in the present case he was right or wrong, the conclusion was a possible one, and is not subject to review by mandamus. (United States ex rel. Ness v. Fisher, 223 U. S., 683.)"

But we have here a different case. Not only had an interference been found to exist, but the claims in interference were suggested in the commissioner's letter to petitioner. Section 4904, R. S. U. S., defining the procedure in the Patent Office when the commissioner is of opinion that an interference exists between pending applications, reads as follows: "Whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the commissioner shall prescribe."

20 Section 483, R. S., confers upon the Commissioner of Patents, subject to the approval of the Secretary of the Interior, the power to "establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office." In the exercise of this power the following regulations, constituting the rule of procedure in such cases, and having the force of statute while in existence, were promulgated and put in force:

"93. An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. The fact that one of the parties has already obtained a patent will not prevent an interference, for, although the commissioner has no power to cancel a patent, he may grant another patent for the same invention to the person who proves to be the prior inventor.

"94. Interferences will be declared in the following cases, when all the parties claim substantially the same patentable invention:

"(1) Between two or more original applications containing conflicting claims."

The limitations upon the power of courts to control executive or judicial officers by mandamus are well defined. Where official or judicial discretion is reposed in such an officer, the exercise of that discretion can not be controlled by mandamus. The remedy, however, may be invoked to compel the officer to act. As we have observed, the commissioner may not be compelled to find the existence of an interference. Neither can he be compelled to decide the issue raised in a particular way. But we are here asked to compel action—not to control discretion. Congress has created a statutory right in applicants for patents, when conflict is found by the commissioner

to exist between pending applications in the Patent Office. The mere finding of the existence of such a conflict presents an issue which justice demands shall be litigated between the parties. In the case of conflicting applications, Congress has provided a tribunal and procedure for ascertaining who, in fact, is the real inventor and entitled to priority and the patent. The statute is mandatory upon the commissioner to permit the parties, or either of them, to invoke its aid. The commissioner has no more power to refuse to put the machinery of the law in operation by declaring an interference and taking jurisdiction of such a case, than this court would have to refuse to take jurisdiction of an appeal taken in accordance with the law and the rules governing its appellate procedure.

The procedure provided by statute for the protection of the rights of the citizen, whether in the courts or in the departments of the Government, is mandatory upon the officers charged with its administration. No rule of convenience to avoid delays caused by the great volume of business, or for any other reason, will justify such a departure from the course of procedure defined, as will deprive an applicant for a patent of his statutory rights. It may well be that, in the great majority of cases, a litigant in the position of petitioner can not possibly prevail in the course of litigation following the declaration of an interference. But it is designed for the protection of the property rights of the small minority who may be found entitled to prevail.

If the welfare of the public business demands an amendment of the procedure, it is a matter for the legislative department of the Government, and not for the executive or judicial departments. The finding by the commissioner of the existence of an interference raises an issue between the parties upon which they are entitled to be heard, and the statute points out the remedy. When this stage is reached, the statute provides for an adjudication "to determine the question of priority of invention." It is not possible for the commissioner by any short cut he may devise to deprive the applicant of this right. He is required to put the machinery of the law in operation by the declaration of the interference as prescribed by the rules. No discretion is reposed in him. The duty is imperative.

The judgment is affirmed with costs.

Affirmed.

21 Monday, April 24th, A. D. 1916.

THOMAS EWING, COMMISSIONER OF PATENTS, appellant, *vs.* UNITED STATES EX RELATIONE THE FOWLER CAR Company.	No. 2924, April Term, 1916.

Appeal from the Supreme Court of the District of Columbia. This cause came on to be heard on the transcript of the record from

the Supreme Court of the District of Columbia and was argued by counsel. On consideration whereof, it is now here ordered and adjudged by this court that the judgment of the said Supreme Court in this cause be, and the same is hereby, affirmed with costs.

Per Mr. JUSTICE VAN ORSDEL.

APRIL 24, 1916.

22 Court of Appeals of the District of Columbia.

I, Henry W. Hodges, clerk of the Court of Appeals of the District of Columbia, do hereby certify that the foregoing printed and typewritten pages numbered from 1 to 21, inclusive, constitute a true copy of the transcript of record and proceedings of said Court of Appeals in the case of Thomas Ewing, Commissioner of Patents, appellant, vs. United States ex relatione The Fowler Car Company, No. 2924, April term, 1916, as the same remain upon the files and records of said Court of Appeals.

In testimony whereof I hereunto subscribe my name and affix the seal of said Court of Appeals, at the city of Washington, this 23d day of September, A. D. 1916.

[SEAL.]

HENRY W. HODGES,
Clerk of the Court of Appeals of the District of Columbia.

23 UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to the honorable the judges of the Court of Appeals of the District of Columbia Circuit, greeting:

Being informed that there is now pending before you a suit in which Thomas Ewing, Commissioner of Patents, is appellant, and The United States ex relatione The Fowler Car Company is appellee, No. 2924, which suit was removed into the said Court of Appeals by virtue of an appeal from the Supreme Court of the District of Columbia, and we, being willing for certain reasons that the said cause and the record and proceedings therein should be certified by the said Court of Appeals and removed into the Supreme
24 Court of the United States, do hereby command you that you send without delay to the said Supreme Court, as aforesaid, the record and proceedings in said cause, so that the said Supreme Court may act thereon as of right and according to law ought to be done.

Witness the honorable Edward D. White, Chief Justice of the United States, the fifteenth day of November, in the year of our Lord one thousand nine hundred and sixteen.

JAMES D. MAHER,
Clerk of the Supreme Court of the United States.

25 In the Supreme Court of the United States.

October Term, 1916.

THOMAS EWING, COMMISSIONER OF PATENTS, PETITIONER,
v.
THE UNITED STATES, EX REL. THE FOWLER CAR CO. } No. 2924.

Stipulation as to return to writ of certiorari.

It is hereby stipulated by counsel for the parties to the above-entitled cause that the certified copy of the transcript of the record now on file in the Supreme Court shall be taken as the return of the clerk of the Court of Appeals of the District of Columbia as to the writ of certiorari issued herein.

JNO. W. DAVIS,
Solicitor General.
MELVILLE CHURCH,
CHARLES C. LINTHICUM,
Counsel for Respondents.

NOVEMBER 17, 1916.

26 THOMAS EWING, COMMISSIONER OF PATENTS, appellant,
vs.
UNITED STATES, EX REL. THE FOWLER CAR Company. } No. 2924.

In obedience to the writ of certiorari filed in this cause and returned herewith, I, Henry W. Hodges, clerk of the Court of Appeals of the District of Columbia, hereby certify the foregoing to be a true copy of the stipulation of counsel filed herein agreeing that the certified copy of the transcript of record now on file in the Supreme Court of the United States shall constitute the return of the clerk of the Court of Appeals to said writ of certiorari.

In testimony whereof I hereunto subscribe my name and affix the seal of said Court of Appeals, at the city of Washington, this 20th day of November, A. D. 1916.

[SEAL.] HENRY W. HODGES,
Clerk of the Court of Appeals of the District of Columbia.

(Endorsed on cover:) File No. 25551. Supreme Court U. S. October Term, 1916. Term No. 721. Thomas Ewing, Commissioner of Patents, petitioner, vs. The United States ex rel. The Fowler Car Co. Writ of certiorari and return. Filed November 22, 1916.

○

In the Supreme Court of the United States.

OCTOBER TERM, 1916.

THOMAS EWING, COMMISSIONER OF Patents, petitioner,
v.
THE UNITED STATES *ex rel.* THE Fowler Car Company. } No.

PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA, AND BRIEF IN SUPPORT THEREOF.

To the Honorable The Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Thomas Ewing, Commissioner of Patents of the United States, respectfully prays for a writ of certiorari to review the judgment of the Court of Appeals of the District of Columbia in the above-entitled cause.

QUESTION PRESENTED.

The question presented is:

Whether the Commissioner of Patents in arriving at an "opinion" under Revised Statutes, section 4904, as to the existence of interference between two

pending applications for patent may decide that no such interference exists and may decline to refer the determination of the question of priority to a primary examiner, in cases where he (the Commissioner) has knowledge that the person filing the later application (*i. e.*, the junior applicant) claims as the date of the conception of his invention a date subsequent to the filing of the application of the earlier applicant (*i. e.*, the senior applicant); in other words, where the Commissioner has knowledge based on admissions of the junior applicant himself which show that no question of priority of invention exists in the case, is he obliged to refer the matter to the primary examiner to determine the question of priority?

STATEMENT OF THE FACTS.

(1) On May 22, 1915, William E. Fowler, Sr., filed an application for letters patent for a certain invention relating to railway cars, the rights in which invention he had duly assigned to The Fowler Car Company (R. 2). On November 18, 1915, the Commissioner of Patents wrote to the car company's attorney: "there is another application pending claiming substantially the same invention as that defined in the following claims." The Commissioner then set forth the specific claims. And the Commissioner continued: "In order to determine whether it is necessary to declare an interference you are requested to obtain a statement from Fowler setting forth when he conceived the invention defined in the above quoted claims, when he disclosed it to others and when he

reduced it to practice. This statement will not be made a part of the record and will be returned to you" (R. 3, 4, 9). On November 23, 1915, the car company's attorney, in response to this letter, filed a letter from Fowler stating that he conceived the subject matter of the claims quoted in the Commissioner's letter on or about April 16, 1915, and that he disclosed the same to others and made drawings on or about the same date and had not reduced the invention to practice by constructing any full-sized devices (R. 4, 10). Immediately after—on November 26, 1915—the car company filed an amendment of his original application by inserting the claims to which the Commissioner had referred in his original letter, and stated: "It is thought that these claims appear in a co-pending application and they are inserted at this time with the request that if such claims do appear in a co-pending application an interference be declared" (R. 4, 10, 11).

On December 10 the Commissioner of Patents wrote to the car company's counsel (R. 4, 11):

> The dates of invention claimed by Fowler are subsequent by several months to the filing date of the application of the other party. The other party's case will be passed to issue as soon as possible and when patented will be cited as a reference against such claims in Fowler's application as it may be found to anticipate.
>
> An interference will not be declared.

(2) Thereupon The Fowler Car Company filed in the Supreme Court of the District of Columbia a

petition for a writ of mandamus in which it set forth the provisions of sections 4904 and 483 of the Revised Statutes, also Rules 93, 94, 95, 96, and 110 of the Patent Office; and after reciting the refusal of the Patent Commissioner to declare an interference—*i. e.*, to refer the applications to the primary examiner to determine the question of priority—the petitioner prayed that a writ of mandamus be issued commanding the Commissioner of Patents (R. 8):

> to declare or to direct to be declared an interference between your petitioner's said Fowler application and the application of the aforesaid unknown applicant whose interfering application is now pending, and further commanding and directing him to withdraw from issue the said interfering application of said unknown applicant, and further commanding and directing him not to issue a patent to said unknown applicant, upon said interfering application, unless and until opportunity is given your petitioner to be heard, in lawful interference proceedings upon the question of priority of invention, as between William E. Fowler and the aforesaid unknown applicant, in respect to the patentable subject matter claimed, in common, in said aforesaid applications.

(3) The Commissioner of Patents filed an answer January 25, 1916, in which he admitted (R. 12, 13)—

> that on December 10, 1915, the attorney was notified that an interference involving these claims would not be declared, for the reason

> that the date of conception of the invention stated by the applicant Fowler in his letter of November 23, 1915 (relator's Exhibit B), was subsequent by several months to the filing date of the application of the other party, and that the other party's application would be passed to issue as soon as possible, and that subsequently it was passed to issue.

The Commissioner further averred in his answer (R. 13)—

> that the date of conception stated by the applicant Fowler is several months subsequent to the date on which the other application referred to was filed.

And he denied that (R. 13)—

> in refusing to declare an interference between the application owned by the petitioner and the other application, he has violated any statute or any rule of the Patent Office.

The Commissioner of Patents further averred (R. 13)—

> that an interference is, as defined by the rules of practice of the Patent Office, a proceeding for the purpose of determining the question of priority of invention, and that where an applicant informs the Patent Office that the invention shown in his application was made at a date which is subsequent to the date upon which another application for the same invention was filed, the statute does not require that an interference be established between his application and the prior application.

Respondent avers that in asking the later applicant to inform the Patent Office of his date of invention he was only asking for information upon which he might form, as required by Section 4904 of the Revised Statutes, an opinion whether a situation existed where the statute required that said later application be put into interference with said earlier pending application.

Respondent further answering avers that his action was not in conflict with the rules of practice relating to interferences, since these rules do not contemplate a declaration of an interference where it is known that the later applicant made his invention subsequently to the filing of the earlier application; in other words, they do not contemplate the declaration of an interference except where there is a possible conflict in the dates of invention.

(4) The Supreme Court of the District of Columbia on January 26, 1916, ordered that the prayer of the petition be granted and that a writ of mandamus issue (R. 15). Appeal was duly taken to the Court of Appeals of the District of Columbia, and the case was heard at the January term, 1916. On April 24, 1916, the judgment of the lower court was affirmed with costs (R. 18–21).

STATUTES AND PATENT OFFICE RULES INVOLVED.

If two or more claimants for patent file applications in the Patent Office, which applications are found to cover the same invention, a special mode of

procedure is provided for by the Patent Act, Revised Statutes, section 4904:

> Sec. 4904. Whenever an application is made for a patent which, *in the opinion of the Commissioner*, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe. [Italics ours.]

The method by which a determination of the question of priority of invention is to be made is provided in Patent Rules 93 to 132, inclusive, as follows:[1] After the primary examiner determines

[1] Rules 93 and 94 as existing prior to January, 1916, so far as concerns this case, were as follows:

Rule 93. An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. The fact that one of the parties has already obtained a patent will not prevent an interference, for, although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor.

Rule 94. Interferences will be declared in the following cases when all the parties claim substantially the same patentable invention:

(1) Between two or more original applications containing conflicting claims.

(2) Between an original application and an unexpired patent containing conflicting claims, when the applicant, having been rejected on the patent, shall file an affidavit that he made the invention before the patentee's application was filed. * * *

that the invention is a patentable invention, and after the Commissioner decides that an interference exists, then the examiner of interferences proceeds to "institute and declare the interference." (See Rule 102.)[1] The cases in which "interferences will be declared" are stated in Rule 94. After the institution and declaration of an interference by the examiner of interferences, a case proceeds in the Patent Office in the form of a litigated suit between parties with provisions for appeal, etc.

REASONS OF PUBLIC IMPORT FOR THE ISSUE OF THE WRIT.

This case is important in that the decision of the Court of Appeals of the District of Columbia overturns a systematic reform instituted by the Commissioner of Patents in the interest of the public and, as he contends, in conformity with the statute and rules.

The course pursued by the Commissioner in the case at bar was not an isolated, disconnected action, but was in pursuance of a practice instituted by him in the Patent Office in the year 1914, and applied throughout the year 1915, with great advantage, to effect more speedy action upon applications filed and more prompt grant of patents. Delays in the Patent Office have hitherto been of great injury to inventors and to the public. The complicated system of interference

[1] Rule 102. When the notices of interference are in proper form, the examiner of interferences will add thereto a designation of the time within which the preliminary statements required by Rule 110 must be filed, and will, *pro forma*, institute and declare the interference by forwarding the notices to the several parties to the proceeding.

proceedings which has gradually grown up, all based on the very few and simple words of Revised Statutes, section 4904, has been a source of much animadversion.

In *Allen* v. *United States ex. rel. Lowry* (1905), 26 App. D. C. 8, 18, it is said:

> * * * From the simple and summary mode first adopted for determining the question of priority of invention, that proceeding, by system of Patent Office rules, has grown to be a veritable old man of the sea, and the unfortunate inventor who becomes involved therein is a second Sinbad the Sailor. It is known to all who are familiar with the practice in interference proceedings that, by motions, petitions, and appeals of every conceivable character that the ingenuity of the skilled attorney can devise, interferences can be, and are, prolonged for years, to the injury of the public, and often to the financial ruin of the parties.

As the Commissioner of Patents himself states in his brief in the Court of Appeals:

> (p. 5) Among all the classes of the work which the office is called upon to do nothing so readily develops complex situations as that which is concerned with the rights of rival inventors. The difficulty of disposing of interference proceedings has been so great and the cost and delay to applicants has been so serious as to cause grave injury and well-founded complaint.

One of the direct and serious results of inefficient handling of interferences has been the detention of applications in the office for many years. It frequently happens that after an application has gone through an interference it immediately enters upon another. This may continue until the value of the invention has been lost or until the applicant rightfully entitled to a patent, if he is not a man of means, is worn out and defeated.

There are pending in the office at the present time more than 3,000 applications which have been there not less than five years, and 200 applications which have been there not less than ten years.

(p. 9) An applicant without considerable means may be prevented by a succession of interferences with parties junior to him from obtaining his patent for five, ten, or fifteen years. It may mean financial ruin. Consider, for example, inventions in the field of toys and puzzles, ornamental designs, or patterns in dress goods, or other articles of mere fashion which are usually short lived. Or, to cite a large engineering development, take the propulsion of street cars by cable, which came into vogue in the last century during the late seventies, flourished during the eighties, and became obsolete during the early nineties.

(p. 10) The injustice to the senior party arising out of delay in the granting of his patent can not be too strongly pressed. Oppositions growing out of interference proceedings have been made in the past in many cases

instruments of oppression by strong manufacturing concerns engaged in infringing. While the application is still in the office, no right of action and no ultimate right of recovery is acquired. Whatever manufacturing is done and profits made by rival manufacturers while the application is delayed in the office is absolutely lost to the inventor, even though he ultimately obtains a satisfactory patent and is successful in suits upon it. It is not a compensation that his patent extends for seventeen years from the date of grant; for seventeen years is more than the life of many inventions and may extend beyond the life of the patentee. Besides, the infringer may skim the cream and get out of business before the patent is granted. This is of frequent occurrence. It is the interest of the inventor which the office, in the practice now attacked, is seeking to protect, not as against an assignee, but against a rival and junior inventor or an infringer.

Any practice, consonant with the statute, which will obviate, expedite and simplify these interference proceedings, is highly desirable in the public interest.

For these reasons it is submitted that a writ of certiorari should issue and the question involved be determined by this court.

BRIEF IN SUPPORT OF PETITION.

The original petitioner, the Fowler Car Company, contends that the statute requires the Commissioner to refer the matter to the primary examiner for a

determination of priority, irrespective of the knowledge which the Commissioner may have as to the date claimed for his invention by the applicant.

The Commissioner, on the other hand, contends that where he knows from the applicant's own statement that the date of the invention is subsequent to the date of the application of the senior applicant, then he (the Commissioner) is entitled to find that no interference exists in fact between the two applications, and that it is only when he is of "opinion" that such interference in fact exists that the statute makes any further action mandatory.

The Court of Appeals held that "the finding by the Commissioner of the existence of an interference raises an issue between the parties upon which they are entitled to be heard" (R. 20, 21), and that under Revised Statutes, section 4904, it is the mandatory duty of the Commissioner, when he has found an interference to exist, to direct the primary examiner to proceed to determine the question of priority of invention, and that "he is required to put the machinery of law in operation by the declaration of the interference as prescribed by the rules" (R. 21).

The Court of Appeals has evidently proceeded on an erroneous assumption. It states (R. 19):

> Concededly, the commissioner found that an interference existed between the pending applications, but to avoid what he deemed must, in all probability, result in fruitless litigation, he refused to declare an interference. It

> is urged by counsel for petitioner that, having found the existence of an interference, the commissioner is without discretion to refuse its declaration.

This statement, that "Concededly, the Commissioner found that an interference existed," assumes a concession which was not made by the Commissioner or by his counsel, and which, on the other hand, is expressly repelled by the Commissioner. The same erroneous assumption was made in the brief for The Fowler Car Company, filed in the Court of Appeals (p. 10), in which counsel say: "It is not denied and can not be disputed that the Honorable Commissioner of Patents decided that there was such an interference."

The Commissioner of Patents not only did not decide that "there was such an interference," but in the answer filed by him in this case he expressly states that "in asking the later applicant to inform the Patent Office of his date of invention, he was only asking for information upon which he might form, as required by section 4904, an *opinion* whether a situation existed where the statute required that such later application be put into interference with such earlier pending application"—i. e., an "opinion" whether the pending applications interfered in fact.

I.

If the Commissioner of Patents has knowledge that any facts exist which render impossible an interference or conflict between claims, he has a right, without more, to find that there is no interference in fact. He is not required to institute an interference proceeding to determine priority, when he is aware of facts which show that no question of priority can arise in the case.

The Court of appeals confuses the two uses of the word "interference":

(*a*) The existence of an interference in fact, as to the existence of which the Commissioner, under Revised Statutes, section 4904, must arrive at an "opinion."

(*b*) The technical "declaration of interference" provided for by the Patent Office Rules, 93 and 94, which is a proceeding to be instituted under said rules only after the Commissioner shall have decided that in his "opinion" an interference in fact existed.

The decision of the Commissioner as to the existence of such interference in fact is not subject to the control of the court.

> The determination of the existence of an interference is confided by statute to the judgment and discretion of the Commissioner of Patents; and whether in the exercise of that judgment in the present case he was right or wrong the conclusion was a possible one, and is not subject to review by mandamus. (*United States ex. rel. Trussed Concrete Steel Co.* v. *Ewing* (1914), 42 App. D. C., 179; 42 W. L. R. 314.)

The above case was cited by the Court of Appeals in its opinion, but the court went on to say: "we have here a different case. Not only had an interference been found to exist, but the claims in interference were suggested in the Commissioner's letter to petitioner" (R. 19). This reference is to the Commissioner's letter of November 18, 1916, in which he notified Fowler that (R. 9)—

> There is another application pending claiming substantially the same invention as that defined in the following claims. * * *
>
> In order to determine whether it is necessary to declare an interference, you are requested to obtain a statement from Fowler setting forth when he conceived the invention defined in the above quoted claims, when he disclosed it to others and when he reduced it to practice.

But there is nothing in this letter which can be construed as a finding by the Commissioner, as required by section 4904, that Fowler's application, "in the opinion of the Commissioner, would interfere with any pending application," and the Commissioner in his answer filed in this case (as stated *supra*) expressly negatives any such construction.

In fact, it is evident that the Commissioner was seeking to obtain from Fowler the information as to the date of his conception of his invention for the express purpose of "forming an opinion" as to whether any interference existed.

Under his power to decide whether there is any conflict or interference in fact between pending

applications or between an issued patent and a pending application, the Commissioner will not and can not properly find that there is an interference if there are any facts present which would make such a conflict inherently impossible. The technical declaration of interference is instituted only for the purpose of deciding priority between truly conflicting applications.

See, in general:

> A reference to section 4904 shows that interference means a dispute on the question of priority of invention. (BLATCHFORD, J., in *United States & Foreign Salamander Felting Co.* v. *Asbestos Felting Co.* (1880), 4 Fed. 813 815.)
>
> * * * interferences were instituted for the purpose of deciding the question of priority of invention and for no other purpose, * * *. (*Allen* v. *United States ex rel. Lowry* (1905), 26 App. D. C. 8, 16.)
>
> The mere refusal of the Commissioner to direct an investigation and determination of the examiners as to an alleged interference of an application for a patent with any pending application, or with any unexpired patent, is but a preliminary *opinion*, as to the propriety of such examination, formed in the exercise of a sound discretion; and as the foundation for the exercise of such discretion, the Commissioner is at liberty to obtain extrinsic information as to the interfering claims. *Potter* v. *Dixon*, 5 Blatchf. 160. From this preliminary opinion of the Commissioner, no appeal lies to this Court. (ALVEY,

C. J., in *Westinghouse* v. *Duncan* (1894), 2 App. Cas. D. C. 131, 135.)

* * * I think the sixth, seventh, and eighth sections must be taken together in construction, from which it will appear clear that the nature of the interference alluded to in the eighth section is a patentable interference, and that it can not exist before the Commissioner has satisfied himself by the examination as directed that there is *prima facie* evidence (from the vouchers produced by the applicant) that all the conditions exist and all the previous requirements of the sixth and seventh sections have been fulfilled; and without such interference no question of priority of invention can arise in which is included the patentability of the invention. (MORSELL, J., in *Jones* v. *Wetherill* (1885), 1 McArthur's Patent Cas. D. C. 409, 412.)

The following possible cases are analogous to that at bar. It might appear on the face of the papers of the junior applicant that he had abandoned his invention, or the Commissioner might have definite knowledge that the invention had been abandoned. In such case, the Commissioner could not find that any interference existed in fact between the two applications, inasmuch as no patent could be issued to an applicant who had abandoned his invention (see Revised Statutes, sec. 4886); and hence there could be no interference in fact between two applications when, to one of the applicants, no patent under the law could be issued.

So, also, it might appear in the papers of the junior applicant that he had filed an application for a foreign patent more than twelve months prior thereto, and that a foreign patent had issued thereon, or the Commissioner might have independent knowledge of that fact. In such case, under the law (Revised Statutes, sec. 4887) no patent could be issued. Clearly the Commissioner could not conclude that, in his opinion, any conflict existed between such an application and a prior pending application.

So, if the Commissioner has knowledge from the statement of the junior applicant himself that no question as to priority exists and that the senior applicant is, in fact, the prior inventor, the Commissioner clearly can not be compelled to decide that any interference exists when he *knows* the contrary.

In other words, if the Commissioner has knowledge that any facts exist which render it impossible that an interference or conflict between claims can exist in fact, he has a right, without more, to find that there is no interference in fact.

II.

That the above is the proper construction of the statute and of the powers of the Commissioner thereunder is made very plain by reference to the practice of the Patent Office for upward of 40 years in relation to interference between an unexpired patent and a pending application.

There is no difference between the language of the statute with reference to applications interfering with

other applications and the language of the statute with reference to applications interfering with unexpired patents. Now, it has always been the practice of the Patent Office to refuse to declare an interference between an unexpired patent and an application filed after a grant of the patent, unless the applicant shall file an affidavit alleging that he made the invention prior to the date of the filing of the application upon which the patent was granted. This provision is found in Rule 94 of the Patent Office Rules, as revised January 1, 1916, as follows:

> Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the same invention which are allowable in the application of each party, and interferences will also be declared between applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved: *Provided*, That where the filing date of any applicant is subsequent to the filing date of any patentee, the applicant shall file an affidavit that he made the invention before the filing date of the patentee.
>
> * * * * *

And in the previous rules, in force from December 1, 1879, in substantially the following form:

> Between an original application and an unexpired patent, when the applicant having

> been rejected on the patent shall file an affidavit showing that he made the invention before the patentee's application was filed.

From 1871 to 1879 the corresponding section of the rule did not specifically require an affidavit, and read as follows:

> When an applicant having been rejected upon any unexpired patent claims to have made the invention before the patentee * * *.

It thus appears that from 1871 to 1879, a junior applicant was obliged, in his claims, to set forth that he made the invention before the patentee (which of course means before the date of the application of the patentee); and since 1879, under the rules of the Patent Office, before a declaration of interference will be made by the Patent Office, the junior applicant has been obliged to file an affidavit that he made the invention before the patentee's application was filed.

This is substantially what the Commissioner asked the junior applicant in the present case to do, except that a simple statement from the applicant was accepted instead of an affidavit. The powers of the Commissioner regarding the declaration of interference between two co-pending applications and between a pending application and an unexpired patent being precisely the same under the statute, the reasoning of the Court of Appeals in the present case will invalidate the proviso of Rule 94 (cited

supra, p. 19), and a rule which has been in existence in the Patent Office for upwards of forty years must be declared illegal.

The Commissioner contends that such can not be the true construction of the law.

See Commissioner Paine in *Ex Parte Nagel*, C. D. (1880), 17, 21:

> It is provided in section 4904 of the Revised Statutes that—
>
> Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the Primary Examiner to proceed to determine the question of priority of invention.
>
> This obviously does not mean that the Commissioner is to declare an interference whenever an application is filed in which is claimed an invention which is also claimed in an unexpired patent. On the contrary, as a rule, an application is to be rejected if it contains a claim embraced in an unexpired patent. It is only when the applicant makes oath that he made the invention before the filing of the patentee's application that an interference is declared between an original application and an unexpired patent. If, instead of the *prima facie* proof furnished by the date of the patentee's application and of his patent, on the one hand, and the contradictory proof furnished by the affidavit of the applicant, the record presented conclusive

proof in favor of either party, an interference would be a frivolous proceeding, for which the Commissioner would be able to find no excuse.

III.

The mandamus should have been denied, since it commanded an entirely vain thing.

Even if the assumption of the Court of Appeals were correct, that the Commissioner had already found an interference in fact to exist, nevertheless the court was wrong in ordering mandamus to issue, for the reason that mandamus will not issue to compel the performance of a vain thing. In the present case, the inventor having stated the date of conception of his invention, and the Commissioner having been thus informed that this date is subsequent to the date of the application of a prior applicant, the only finding which would be possible, even if a technical declaration of interference should be made, would be a finding that the prior, or senior, applicant was the prior inventor; and the junior applicant (Fowler) would be left precisely in the same position as at the institution of these proceedings.

In such case the prior, or senior, applicant's application would go through the Patent Office in the regular course of procedure in an *ex parte proceeding* and patent would issue to him, which patent Fowler might attack as invalid by reason of nonpatentability, either in *ex parte* proceedings taken in the Patent Office on his own application or by a defense raising these

points in a suit for infringement brought against him by the patentee.

Fowler contends that by the failure of the Commissioner to cause a declaration of interference he is deprived of some right, because, incidental to the procedure for interference proceedings provided for by the Patent Office Rules, there is a rule allowing a motion to dissolve an interference (Rule 122).

It was virtually stated at the hearing below that the declaration of interference was sought, not in order that Fowler might be shown to be the first inventor, but that the petitioner have an opportunity to oppose the granting of a patent to the unknown applicant; *in other words, it was sought to have the declaration of interference in order that it might be shown later to the Patent Office (on a motion for dissolution of the interference) that it ought not to have been declared.*

It is submitted that the statute does not require the declaration of an interference for any such purpose. A and B may independently make the same invention. If A files an application and B does not, B has no right to contest in the Patent Office the patentability of A's claims; for the Rules provide that the proceedings as to patentability shall be *ex parte*. If B files a later application, but states to the Patent Commissioner a date of his invention which is later than A's application, he has no greater right to contest the patentability of A's claim than if he, B, had filed no application whatever, inasmuch as the only provision made in the Patent Act for a

contest or litigated proceeding is under section 4904 in a case where priority of invention is necessary to be determined.

The motion to dissolve is a mere incident to the procedure *after* the Commissioner shall have found the existence of an interference in fact in his "opinion," and after the technical declaration of interference by the examiner. The making of such a motion is not an independent, substantive right given by any statute.

> * * * motions to dissolve are not the creature of any statute, but of the rules of the Patent Office, and no provision, by Patent Office Rules, for such motions, was made until many years after the statutes relating to interferences were enacted. Section 42 of the Act of 1870, reenacted in 1874 and now in force and known as Section 4904 of the Revised Statutes, in line with the earlier statutes, provides for the institution of interferences for the sole purpose of determining the question of priority of invention, * * *.
>
> (*Allen* v. *United States ex. rel. Lowry* (1905), 26 App. 8, 16, 17.)

The question whether a writ of mandamus should be awarded in cases where no substantial change or result will be attained has been considered by the courts in many cases from earliest dates, and the principle on which all the cases have been decided is that expressed by Kent, J., in *Trustees* v. *Nicoll*, 3 Johns. 566, 596:

> * * * It is one of the maxims of the common law, and which is a dictate of com-

mon sense, that the law will not attempt to do an act which would be vain, or to enforce an act which would be frivolous. *Lex nil frustra facit. Lex non cogit ad vana seu inutilia.*

The application of the above principle to the facts of this case should result in a reversal of the decree of the Court of Appeals.

It is respectfully submitted that a writ of certiorari should issue as prayed.

JOHN W. DAVIS,
Solicitor General.
CHARLES WARREN,
Assistant Attorney General.

OCTOBER, 1916.

○

In the Supreme Court of the United States.

OCTOBER TERM, 1916.

THOMAS EWING, COMMISSIONER OF PATENTS, petitioner,
v.
THE UNITED STATES EX REL. THE FOWLER CAR COMPANY.
No. 721.

ON WRIT OF CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

MOTION TO ADVANCE.

Comes now the Solicitor General, appearing on behalf of the Commissioner of Patents, and respectfully moves the court to advance the above-entitled cause for hearing on a day convenient to the court.

This is a petition filed in the Supreme Court of the District of Columbia by the Fowler Car Company, praying for a writ of mandamus directed to the Commissioner of Patents commanding the latter to declare an interference between the Fowler application for a patent for a certain invention relating to railway cars and the application of an unknown applicant then pending. The latter application had been filed in the Patent Office prior to the filing of

said Fowler application. Issuance of the writ was prayed in order that opportunity be given to the owners of the Fowler application to be heard upon the question of priority of invention.

Before the filing of the petition in the Supreme Court of the District the Commissioner of Patents had refused to declare an interference between the two applications because the dates of invention claimed in the Fowler application were subsequent by several months to the filing date of the application of the other party.

The Supreme Court of the District ordered the writ to issue, and its judgment was affirmed by the Court of Appeals of the District. Thereafter the present writ of certiorari was granted by this court upon petition filed by the Commissioner of Patents.

The question presented is:

Where the Commissioner of Patents has knowledge based on admissions of the junior applicant himself which show that no question of priority of invention exists, is he obliged, under the patent laws, to refer the matter to a primary examiner to determine the question of priority, or may he decide that no such interference exists and decline to refer the determination of the question of priority to a primary examiner?

The case is of importance to the Patent Office because the decision of the Court of Appeals of the District overturns a systematic reform instituted by the Commissioner of Patents, claimed by him to be

in the interest of the public and in conformity with the law and rules governing his office, and, as the decision of this court will determine the course of that officer in a number of similar cases now pending, an early hearing of the cause is desirable.

Notice of this motion has been served on opposing counsel.

JOHN W. DAVIS,
Solicitor General.

JANUARY, 1917.

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I. All of the proceedings in the Patent Office relative to grant of a patent are ex parte and not adversary, with the exception of interference proceedings.

The statutory provision of an interference proceeding is made necessary solely to afford a means to determine which of two persons filing applications covering the same invention is the prior inventor.

If the Commissioner of Patents has knowledge that any facts exist which render it inherently impossible that two applications can "interfere," he has a right, without more, to find that there is no interference in fact. He is not required to institute an interference proceeding to determine priority, when he is aware of facts which show that no question of priority or actual interference can arise in the case.

The original respondent contends that the statute requires the Commissioner to refer the matter to the primary examiner for a determination of priority, irrespective of the knowledge which the Commissioner may have as to the date claimed for his invention by the applicant.

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The Commissioner, on the other hand, contends that where he knows from the applicant's own statement that the date of the invention is subsequent to the date of the application of the senior applicant, then he (the Commissioner) is entitled to find that no interference exists in fact between the two applications, and that it is only when he is of "opinion" (under Rev. Stat., sec. 4904) that such interference in fact exists that the statute makes any further action mandatory 12

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II. That the above is the proper construction of the statute and of the powers of the Commissioner thereunder is made very plain by reference to the practice of the Patent Office for upward of 50 years in relation to interference between an unexpired patent and a pending application.

In case of such an alleged interference, the Patent Office rule required that before an interference would be declared by the Commissioner, the junior applicant must file an affidavit that he made the invention before the filing date of the patentee. This rule would be void and unauthorized on the contention made by the respondent that the Commissioner has no power to inquire as to the date of the invention by the junior applicant,

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or to consider, in arriving at an "opinion" as to the existence of interference, the date when given by the junior applicant 25

III. This case is important, in that the decision of the Court of Appeals of the District of Columbia overturns a systematic reform instituted by the Commissioner of Patents to expedite the business of the office, which, as he contends, is in conformity with the statute and rules.

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IV. The respondent contends that because of the existence of Patent Office Rule 122, which provides for a motion to dissolve the interference, he is entitled to have the interference declared so that he may later move to dissolve it; and he contends that the failure of the commissioner deprives him of his alleged right to move to dissolve. The commissioner contends that the privilege of such a motion is not an independent substantive right, but is a mere incident to the procedure, after the commissioner shall have found the existence in fact of an interference 42

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In the Supreme Court of the United States

OCTOBER TERM, 1916

THOMAS EWING, COMMISSIONER OF PATENTS,

v.

UNITED STATES EX REL. THE FOWLER CAR COMPANY.

No. 724.

ON WRIT OF CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF FOR THE COMMISSIONER OF PATENTS.

THE FACTS.

This case comes here on a certiorari to the Court of Appeals of the District of Columbia.

The facts are as follows:

(1) On May 22, 1905, William E. Fowler et al. filed an application for letters patent for a certain invention relating to railway cars, the rights in which inventions he had duly assigned to The Fowler Car Company. (R. 2.)

On November 18, 1905, the Commissioner of Patents wrote to the car company's attorneys: "There is another application pending claiming substantially

the same invention as that defined in the following claims." The Commissioner then set forth the specific claims. And the Commissioner continued: "*In order to determine whether it is necessary to declare an interference, you are requested to obtain a statement from Fowler setting forth when he conceived the invention defined in the above-quoted claims, when he disclosed it to others, and when he reduced it to practice. This statement will not be made a part of the record and will be returned to you*" (R. 3, 4, 9).

On November 23, 1915, the applicant's attorney, in response to this letter, filed a letter from Fowler stating that he conceived the subject matter of the claims quoted in the Commissioner's letter on or about April 16, 1915, and that he disclosed the same to others and made drawings on or about the same date and had not reduced the invention to practice by constructing any full-sized devices (R. 4, 10).

Immediately after—on November 26, 1915—the applicant's attorney filed an amendment to Fowler's original application, inserting the claims to which the Commissioner had referred in his original letter, and stated: "It is thought that these claims appear in a copending application and they are inserted at this time with the request that if such claims do appear in a copending application an interference be declared" (R. 4, 10, 11):

On December 10, the Commissioner of Patents wrote to the car company's counsel (R. 4, 11):

> The dates of invention claimed by Fowler are subsequent by several months to the filing

> date of the application of the other party. The other party's case will be passed to issue as soon as possible and when patented will be cited as a reference against such claims in Fowler's application as it may be found to anticipate.
>
> An interference will not be declared.

(2) Thereupon The Fowler Car Company filed in the Supreme Court of the District of Columbia a petition for a writ of mandamus in which it set forth the provisions of sections 4904 and 483 of the Revised Statutes, also rules 93, 94, 95, 96, and 110 of the Patent Office. The petition recited the refusal of the Patent Commissioner to declare an interference, i. e., to refer the applications to the primary examiner to determine the question of priority. The petition charged that—

> it clearly appears, and petitioner charges, the fact to be that there are now pending in the Patent Office two applications for patents, to wit: Petitioner's said Fowler application and an application of an applicant to your petitioner unknown, which applications disclose and claim the same patentable invention, and that a case of interference exists between said applications under the statutes and rules, and that it is the duty of the respondent, under the statute and rules, to declare said interference.

The petitioner further sets out that the refusal of the Commissioner to declare the interference was contrary to his duty; that the demand for a statement of Fowler's dates was irregular and unjustifiable; that the statement of the Commissioner that he

would issue a patent to the unknown applicant constituted a breach and violation of the statute and of the rules; is calculated to and will seriously damage and injure the petitioner; that the conduct of the Commissioner complained of is a matter of large public concern involving the validity and binding effect of the interference rules upon the Commissioner and other officials of the Patent Office; that for over a quarter of a century the predecessors of the present Commissioner, without exception, regarded said interference rules as imposing upon them the legal duty of declaring an interference whenever two pending applications claimed substantially the same patentable subject matter; that the Commissioner's conduct complained of is a radical departure from and violation of said long-settled practice; that the Commissioner has refused and continues to refuse to declare the aforesaid interference, and that the petitioner was without redress or remedy except by the writ of mandamus.

The petitioner, therefore, prayed that a writ of mandamus be issued commanding the Commissioner of Patents (R. 8)—

> to declare or to direct to be declared an interference between your petitioner's said Fowler application and the application of the aforesaid unknown applicant whose interfering application is now pending, and further commanding and directing him to withdraw from the issue the said interfering application of said unknown applicant, and further commanding and directing him not to issue a

patent to said unknown applicant, upon said interfering application, unless and until opportunity is given your petitioner to be heard, in lawful interference proceedings upon the question of priority of invention, as between William E. Fowler and the aforesaid unknown applicant, in respect to the patentable subject matter claimed, in common, in said aforesaid applications.

(3) The Commissioner of Patents filed an answer January 25, 1916, in which he admitted (R. 12, 13)—

that on December 10, 1915, the attorney was notified that an interference involving these claims would not be declared, for the reason that the date of conception of the invention stated by the applicant Fowler in his letter of November 23, 1915 (relator's Exhibit B), was subsequent by several months to the filing date of the application of the other party, and that the other party's application would be passed to issue as soon as possible, and that subsequently it was passed to issue.

The Commissioner further averred in his answer (R. 13)—

that the date of conception stated by the applicant Fowler is several months subsequent to the date on which the other application referred to was filed.

And he denied that (R. 13)—

in refusing to declare an interference between the application owned by petitioner and the other application, he has violated any statute or any rule of the Patent Office.

The Commissioner of Patents further averred (R. 13)—

> that an interference is, as defined by the rules of practice of the Patent Office, a proceeding for the purpose of determining the question of priority of invention, and that where an applicant informs the Patent Office that the invention shown in his application was made at a date which is subsequent to the date upon which another application for the same invention was filed, the statute does not require that an interference be established between his application and the prior application.
>
> Respondent avers that in asking the later applicant to inform the Patent Office of his date of invention he was only asking for information upon which he might form, as required by section 4904 of the Revised Statutes, an opinion whether a situation existed where the statute required that said later application be put into interference with said earlier pending application.
>
> Respondent further answering avers that his action was not in conflict with the rules of practice relating to interferences, since these rules do not contemplate a declaration of an interference where it is known that the later applicant made his invention subquently to the filing of the earlier application; in other words, they do not contemplate the declaration of an interference except where there is a possible conflict in the dates of invention.

(4) The Supreme Court of the District of Columbia on January 26, 1916, ordered that the prayer of the petition be granted and that a writ of mandamus issue (R. 15). Appeal was duly taken to the Court of Appeals of the District of Columbia, and the case was heard at the January term, 1916. On April 24, 1916, the judgment of the lower court was affirmed with costs (R. 17–21). A petition for writ of certiorari was granted by this Court (R. 21).

STATUTES AND PATENT OFFICE RULES INVOLVED.

If two or more claimants for patent file applications in the Patent Office, which applications are found to cover the same invention, a special mode of procedure is provided for by the patent act, Revised Statutes, section 4904:

> SEC. 4904. Whenever an application is made for a patent which, *in the opinion of the commissioner*, would interfere with any pending application or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners in chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe. [Italics ours.]

The Patent Office Rules (framed under Rev. Stat., sec. 483) provide for the administration of interference proceedings as follows: [1]

Patent Office Rule No. 93 defines what an interference proceeding is:

> Rule 93. An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. The fact that one of the parties has already obtained a patent will not prevent an interference, for, although the commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor.

Rule No. 94 states the cases in which interferences will be declared, and so much as is applicable to the present case is as follows:

> Rule 94. Interferences will be declared in the following cases when all the parties claim substantially the same patentable invention:
>
> (1) Between two or more original applications containing conflicting claims.
>
> (2) Between an original application and an unexpired patent containing conflicting claims, when the applicant, having been rejected on the patent, shall file an affidavit that he made the invention before the patentee's application was filed. * * *

[1] The Patent Office Rules referred to are those in force at the time of the proceedings in question, viz. the "Rules of Practice in the United States Patent Office, Revised July 17, 1907." On January 1, 1916, the rules were again revised and to some degree renumbered.

The form of the proceeding is as follows:

First. The Commissioner must (Rev. Stat., sec. 4904) form an opinion that the later application would "interfere with any pending application or with any unexpired patent."

Second. The primary examiner must (under rule 95) decide that the invention in question is patentable, and that the claims are in proper form.

> Rule 95. Before the declaration of interference all preliminary questions must be settled by the primary examiner, and the issue must be clearly defined; the invention which is to form the subject of the controversy must be decided to be patentable, and the claims of the respective parties must be put in such condition that they will not require alteration after the interference shall have been finally decided, unless the testimony adduced upon the trial shall necessitate or justify such change.

Third. And various other formalities (not in question in this suit) must take place. (See rules 96–101.)

Fourth. An official known as the examiner of interferences is to "institute and declare the interference."

> Rule 102. When the notices of interference are in proper form, the examiner of interferences will add thereto a designation of the time within which the preliminary statements required by rule 110 must be filed, and will, *pro forma*, institute and declare

the interference by forwarding the notices to the several parties to the proceeding.

The case then proceeds in the Patent Office in the form of a litigated suit between parties. (See rules 103–132.)

After the interference has been actually declared, rule 122 makes provision for a motion to dissolve the interference as follows:

> Rule 122. Motions to dissolve an interference (1) alleging that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (2) denying the patentability of an applicant's claim, or (3) denying his right to make the claim, should contain a full statement of the grounds relied upon and should, if possible, be made not later than the thirtieth day after the statements of the parties have been received and approved. Such motions, and all motions of a similar character, should be accompanied by a motion to transmit the same to the *law* examiner, and such motion to transmit should be noticed for hearing upon a day certain before the examiner of interferences. When in proper form the motion presented will be transmitted by the examiner of interferences, with the files and papers, to the *law* examiner for his determination, who will thereupon fix a day certain when the said motion will be heard before him upon the merits, and give notice thereof to all the parties. If a stay of proceedings be desired, a motion therefor

should accompany the motion for transmission.

When the motion has been decided by the law examiner the files and papers, with his decision, will be sent at once to the docket clerk.

Motions to shift the burden of proof should be made before, and will be determined by, the examiner of interferences. No appeal from the decision on such motions will be entertained, but the matter may be reviewed on appeal from the final decision upon the question of priority of invention.

QUESTION PRESENTED.

The question presented is:

Whether the Commissioner of Patents in arriving at an "opinion" under Revised Statutes, section 4904, as to the existence of interference between two pending applications for patent may decide that no such interference exists and may decline to refer the determination of the question of priority to a primary examiner, in cases where he (the Commissioner) has knowledge that the person filing the later application (i. e., the junior applicant) claims as the date of the conception of his invention a date subsequent to the filing of the application of the earlier applicant (i. e., the senior applicant). In other words, where admissions of the junior applicant himself show that no question of priority of invention exists in the case, is the Commissioner obliged to refer the matter to the primary examiner to determine the question of priority?

ARGUMENT.

I.

All of the proceedings in the Patent Office relative to grant of a patent are ex parte and not adversary, with the exception of interference proceedings.

The statutory provision of an interference proceeding is made necessary solely to afford a means to determine which of two persons filing applications covering the same invention is the prior inventor.

If the Commissioner of Patents has knowledge that any facts exist which render it inherently impossible that two applications can "interfere" he has a right, without more, to find that there is no interference in fact. He is not required to institute an interference proceeding to determine priority, when he is aware of facts which show that no question of priority or actual interference can arise in the case.

The respondent contends that the statute requires the Commissioner to refer the matter to the primary examiner for a determination of priority, irrespective of the knowledge which the Commissioner may have as to the date claimed for his invention by the applicant.

The Commissioner, on the other hand, contends that where he knows from the applicant's own statement that the date of the invention is subsequent to the date of the application of the senior applicant, then he (the Commissioner) is entitled to find that no interference exists in fact between the two applications, and that it is only when he is of "opinion" (under Rev. Stat., sec. 4904) that such interference in fact exists that the statute makes any further action mandatory.

In order to comprehend the exact part which an interference proceeding plays in the patent-law system and procedure, and to understand the scope and intent of Revised Statutes, section 4904, a brief statement should be made as to the nature of the proceedings which ensue on the filing of an application for patent.

The persons who may secure a patent for an invention are described in Revised Statutes, section 4886.

> SEC. 4886. Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor.

The requisites for an application for patent are set out in section 4888. The oath as to his invention prescribed for an applicant is set out in section 4892.

On the filing of an application, section 4893 provides for an examination of the alleged invention:

> and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently

useful and important, the Commissioner shall issue a patent therefor.

Provision is made in section 2305 for the procedure "whenever an examination and claim for patent is rejected," and for a reexamination if "the applicant persists in his claim for a patent with or without altering his specification."

An appeal is provided for in section 2306 from the decision of the primary examiner to the board of examiners in chief, in case any of the applicant's claims have been twice rejected, and from the latter, an appeal to the Commissioner.

Now, all these proceedings in the Patent Office are ex parte; i. e., the person has only to deal with the grant the granting of the patent. Rules 42 to 82 and 134 to 138 govern these proceedings.

The question presented is, Has the applicant any right which entitles the applicant, or an assignee, himself and the public entitled to the grant from patent.

Some of the reasons for which the patent may be refused are:

(a) Noncompliance.

(b) Publication or disclosure of the invention to the public before entry by applicant for more than two years prior to filing.

(c) Failure of original application to include the subsequently claimed invention. Sec. 24, Fig. 1, Angus 37 F. R. 201.

> The mere refusal of the Commissioner to direct an investigation and determination of the examiners as to an alleged interference of an application for a patent with any pending application, or with any unexpired patent, is but a preliminary *opinion*, as to the propriety of such examination, formed in the exercise of a sound discretion; and as the foundation for the exercise of such discretion, the Commissioner is at liberty to obtain extrinsic information as to the interfering claims. (*Potter* v. *Dixon*, 5 Blatchf. 160.) From this preliminary opinion of the commissioner, no appeal lies to this court. (*Westinghouse* v. *Duncan* (1894), 2 App. Cas. D. C. 131, 135.)
>
> * * * I think the sixth, seventh, and eighth sections must be taken together in construction, from which it will appear clear that the nature of the interference alluded to in the eighth section is a patentable interference, and that it can not exist before the commissioner has satisfied himself by the examination as directed that there is *prima facie* evidence (from the vouchers produced by the applicant) that all the conditions exist and all the previous requirements of the sixth and seventh sections have been fulfilled; and without such interference no question of priority of invention can arise in which is included the patentability of the invention. (*Jones* v. *Wetherill* (1855), 1 MacArthur's Patent Cas. D. C. 409, 412.)

In order to constitute an interference, there must be two applications which conflict—i. e., two appli-

cations on which, on the known facts, a patent could be issued to either of the applicants. Out of this situation arises the necessity to ascertain priority of invention, in order to determine to which applicant patent shall issue. If an application shows on its face, or the commissioner has knowledge from the junior applicant, or otherwise from the records of the office, that his date of invention is later than the date shown in the senior application, it is an absurdity to say that there are two conflicting applications—i. e., two applications as to which there could be any conflict as to the right of the applicant to patent.

It is entirely illogical to say that the Commissioner, when he knows that the later applicant did not conceive the invention until after the earlier applicant filed his application, may not refuse to declare an interference and pass the earlier application to issue, having found that it is in all respects allowable. Clearly, the statute does not compel the Commissioner to decide that an interference exists in fact, when he *knows* the contrary.

The following illustration may be used: Suppose the Commissioner knows from the record that the junior applicant was not born at the time of the filing of the senior applicant's application. Is the Commissioner obliged to delay granting a patent to the senior, until after he has referred the determination of the question of priority to a primary examiner? Is the junior applicant, unborn at date of the senior's application, to have the right to obstruct the issue of

the patent by interference proceedings in such case? That this is not an impossible situation may be seen from the fact that in this year, 1917, a patent issued based on an application filed in the year 1880. (See *In re Josephine H. Fritts Adm'x* (1916) 45 App. D. C., not yet published.) While this was not actually an interference case, it appears that the inventor prosecuted in the Patent Office his application up to his death in 1905. Suppose that in 1904 a person born in 1882 had filed an application covering the same invention, could he have an absolute right (as claimed by the respondent in the case at bar) to have the Commissioner declare interference proceedings to determine priority of invention?

The Commissioner in arriving at his "opinion," under Revised Statutes, section 4904, must determine not only whether the invention contained in the later application is the same as that in the earlier, but also whether there is any bar to the grant of a patent to the later applicant which does not affect the earlier. All these questions are determined *ex parte*.

While in the instant case the Commissioner has obtained his information as to date of invention from an answer to an inquiry addressed by him to the junior applicant, such is not the only way in which this information might be had by the Commissioner. He might have notice as to the date of invention from the records of the office in many ways, some of which are as follows: (1) An applicant sometimes accompanies his application with a statement of the date of invention; (2) the fact

of an earlier application on file in the office might not be discovered until after an interference had been tried between two later applicants, in which case the Commissioner would have the winning party's date of invention from the testimony taken in the interference; (3) the date might be stated in affidavit filed under rule 75.

The following possible cases also are analogous to the instant case, as showing that it is not merely conflicting claims which the Commissioner has to consider in forming an "opinion" (under sec. 4904) as to the existence of an interference in fact:

It might appear on the face of the papers of the junior applicant that he had abandoned his invention, or the Commissioner might have definite knowledge that the invention had been abandoned. In such case, the Commissioner could not find that any interference existed in fact between the two applications, inasmuch as no patent could be issued to an applicant who had abandoned his invention (see Rev. Stat., sec. 4886); and hence there could be no interference in fact between two applications when to one of the applicants no patent under the law could be issued.

So, also, it might appear in the papers of the junior applicant that he had filed an application for a foreign patent more than twelve months prior thereto, and that a foreign patent had issued thereon, or the Commissioner might have independent knowledge of that fact. In such case, under the law (Rev. Stat., sec. 4887) no patent could be issued. Clearly, the

Commissioner could not conclude that, in his "opinion," any conflict existed between such an application and a prior pending application.

In the case of *Emmett* v. *Fullagar* (130 O. G. 2719) the Commissioner said:

> The questions raised are all such as could have been considered in the *ex parte* prosecution of Fullagar's applications and which, if finally decided adversely to him, would have resulted in the rejection of his claims. In such an event it would have been manifestly improper for the primary examiner to have declared the interference. The mere fact that two parties claim the same invention is not sufficient to justify the declaration of an interference but it must appear that each one is entitled to claim it. If for any reason one of the parties is barred from claiming the invention then he has no more interest in the other party's claim thereto than has any other member of the public.

See also the decisions in *ex parte Boyer* (49 O. G., 1985); *ex parte Meucci* (51 O. G., 299); and *Abel and Dewar* v. *Maxim* v. *Nobel* (56 O. G., 139). In the second of these cases the Commissioner said:

> Divested of all extraneous matter the present question is whether an applicant who is not entitled to a patent may have an adjudication that he is entitled to a patent to the end that an interference may be declared. There is no precedent or principle justifying such a procedure.

DARK PAGE BLEED THRU

THE ERROR OF THE COURT OF APPEALS.

The Court of Appeals held that "the finding by the Commissioner of the existence of an interference raises an issue between the parties upon which they are entitled to be heard" (Rec. 20), and that under Revised Statutes, section 4904, it is the mandatory duty of the Commissioner, when he has found an interference to exist, to direct the primary examiner to proceed to determine the question of priority of invention, and that "he is required to put the machinery of law in operation by the declaration of the interference as prescribed by the rules" (Rec. 20).

The Court of Appeals evidently proceeded on an erroneous assumption. It states (Rec. 18):

> Concededly, the Commissioner found that an interference existed between the pending applications, but to avoid what he deemed must, in all probability, result in fruitless litigation, he refused to declare an interference. It is urged by counsel for petitioner that having found the existence of an interference the Commissioner is without discretion to refuse its declaration.

This statement, that "concededly, the Commissioner found that an interference existed," assumes a concession which was not made by the Commissioner or by his counsel, and which, on the other hand, is expressly repelled by the Commissioner.

The Commissioner of Patents not only did not decide that "there was such an interference," but in the answer filed by him in this case he expressly

states that (Rec. 13) "in asking the later applicant to inform the Patent Office of his date of invention he was only asking for information upon which he might form, as required by section 4904 of the Revised Statutes, an *opinion* whether a situation existed where the statute required that said later application be put into interference with said earlier pending application," i. e., an "opinion" whether the pending applications interfered in fact.

The Court of Appeals confuses the two uses of the word "interference":

(*a*) An interference in fact, as to the existence of which the Commissioner, under Revised Statutes, section 4904, must arrive at an "opinion."

(*b*) The technical "declaration of interference" provided for by the Patent Office Rules 93 and 94, which is a proceeding to be instituted under said rules only after the Commissioner shall have decided that in his "opinion" an interference in fact existed.

The decision of the Commissioner as to the existence of an interference in fact is not subject to the control of the court.

> The determination of the existence of an interference is confided by statute to the judgment and discretion of the Commissioner of Patents; and whether in the exercise of that judgment in the present case he was right or wrong, the conclusion was a possible one, and is not subject to review by mandamus. (*United States ex rel. Trussed Concrete Steel Co.* v. *Ewing* (1914), 42 App. D. C. 179, 183; 42 W. L. R. 314.)

The above case was cited by the Court of Appeals in its opinion, but the court went on to say:

> But we have here a different case. Not only had an interference been found to exist, but the claims in interference were suggested in the Commissioner's letter to petitioner (Rec. 19).

This reference is to the Commissioner's letter of November 18, 1915, in which he notified Fowler that (Rec. 9):

> There is another application pending claiming substantially the same invention as that defined in the following claims. * * *
>
> In order to determine whether it is necessary to declare an interference, you are requested to obtain a statement from Fowler setting forth when he conceived the invention defined in the above quoted claims, when he disclosed it to others, and when he reduced it to practice.

But there is nothing in his letter which can be construed as a finding by the Commissioner, as required by section 4904, that Fowler's application, "in the opinion of the Commissioner would interfere with any pending application," and the Commissioner in his answer filed in this case (as stated *supra*) expressly negatives any such construction.

In fact, it is perfectly evident that the Commissioner was seeking to obtain from Fowler the information as to the date of his conception of his invention *for the express purpose of "forming an opinion" as to whether any interference existed.* The claims were recited in order that Fowler might be definitely

informed of the invention as to which dates were inquired about.

Revised Statutes, section 4904, should be construed in the same liberal manner as Revised Statutes, section 4916.

The language of section 4904 is similar to that of section 4916, which provides that:

> SEC. 4916. *Whenever* any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, * * *

This court, however, when it had before it reissues granted long after the issuance of the original patents did not construe the statute as entitling a patentee to a reissue "*whenever*" the error arose by inadvertence, accident, or mistake, but held that by delay in filing the application for reissue the right thereto could be lost.

In the case of *Miller* v. *Brass Co.* (1881—104 U. S., 350, 352), the court said:

> Any unnecessary laches or delay in a matter thus apparent on the record affects the right to alter or reissue the patent for such cause. If two years' public enjoyment of an invention with the consent and allowance of the inventor

> is evidence of abandonment, and a bar to an application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public. Nothing but a clear mistake, or inadvertence, and a speedy application for its correction, is admissible when it is sought merely to enlarge the claim.

This holding was followed and extended in a number of later decisions.

Just as in those decisions the statute was held not to confer the right to reissue in all cases, so here the language of section 4904 should be construed, not as conferring a right to an interference in all cases, but only in those cases where a question of priority of invention is actually involved. Under such an interpretation of the statute the practice here attacked was instituted.

II.

That the above is the proper construction of the statute and of the powers of the Commissioner thereunder is made very plain by reference to the practice of the Patent Office for upward of 50 years in relation to interference between an unexpired patent and a pending application.

In case of such an alleged interference, the Patent Office rule required that before an interference would be declared by the Commissioner, the junior applicant must file an affidavit that he made the invention before the filing date of the patentee. This rule would be void and unauthorized on the contention made by the respondent, that the Commissioner has no power to inquire as to the date of the invention by the junior applicant, or to consider, in arriving at an "opinion" as to the existence of interference, the date when given by the junior applicant.

There is no difference between the language of the statute with reference to applications interfering with other applications and the language of the statute with reference to applications interfering with unexpired patents.

Revised Statutes, section 4904:

> Whenever an application is made for a patent which, in the opinion of the Commissioner, *would interfere with any pending application, or with any unexpired patent*, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

Yet it has been the practice of the Patent Office for upward of 50 years to refuse to declare an interference between an unexpired patent and an application filed after a grant of the patent, unless the applicant shall file an affidavit alleging that he made the invention prior to the date of the filing of the application upon which the patent was granted. This provision is found in rule 94 of the Patent Office Rules, as revised January 1, 1916, as follows:

> Interferences will be declared between applications by different parties for patent or

> for reissue when such applications contain claims for substantially the same invention which are allowable in the application of each party, and interferences will also be declared between applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved: *Provided*, That where the filing date of any applicant is subsequent to the filing date of any patentee, the applicant shall file an affidavit that he made the invention before the filing date of the patentee.

And in the previous rules, in force from December 1, 1879, in substantially the following form:

> Between an original application and an unexpired patent, when the applicant having been rejected on the patent shall file an affidavit showing that he made the invention before the patentee's application was filed.

From 1871 to 1879 the corresponding section of the rule did not specifically require an affidavit, and read as follows:

> When an applicant having been rejected upon any unexpired patent claims to have made the invention before the patentee. * * *

It thus appears that from 1871 to 1879, a junior applicant was obliged, in his claims, to set forth that he made the invention before the patentee (which of course means before the date of the application of the patentee); and since 1879, under the rules of the

Patent Office, before a declaration of interference will be made by the Patent Office the junior applicant has been obliged to file an affidavit that he made the invention before the patentee's application was filed.

See Commissioner Paine in Ex Parte Kapp, C. D. (1899), 17, 111:

> It is provided in section 4904 of the Revised Statutes that—
>
> Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention.
>
> This obviously does not mean that the Commissioner is to declare an interference whenever an applicant is found to submit a claimed an invention which is also claimed in an unexpired patent. On the contrary, as a rule, an application is to be rejected if it contains a claim embraced in an unexpired patent. It is only when the applicant makes oath that he made the invention before the filing of the patentee's application that an interference is declared between an original application and an unexpired patent. It instead of the prima facie proof furnished by the date of the patentee's application and of his patent, on the one hand, and the contradictory proof furnished by the affidavit of the applicant, the record presented contains

conception from a junior applicant in the instant case; and certainly having secured such a statement he may use it as a ground for finding that no question of interference in fact exists in the instant case.

Respondent then continues (p. 11):

> Such patent is a public record. Its disclosure and its history are open to the applicant. He may determine its efficacy as a bar and its sufficiency as to disclosure by a comparison with his own application. He need leave nothing to the *ex parte* consideration of the Patent Office, but may contest every point with full knowledge of the facts;

while, he says (p. 11):

> the case of two pending applications is obviously different. Here the junior applicant knows nothing concerning the facts. He is not permitted to know who his opponent is, to see his application or to know when it is filed. He must accept the mere dictum of the Patent Office as to its existence, contents, and legal effect.

But these alleged conditions afford no reason why the commissioner should be deemed to have the power to refrain from declaring an interference *between a patent and a junior application* until the junior applicant shall file an antedating affidavit, but should be denied the power to refrain equally from declaring interference *between two applications* until the junior applicant should file a statement claiming a date of invention earlier than the date of the senior application.

The commissioner's power as to interferences arises in both cases from the same statute (Rev. Stat., sec. 4904), and his right to require preliminary knowledge of the junior applicant's *claim* as to his date of invention must be the same in both classes of cases for which the statute provides for interference proceedings.

III.

This case is important, in that the decision of the Court of Appeals of the District of Columbia overturns a systematic reform instituted by the Commissioner of Patents to expedite the business of the office, which, as he contends, is in conformity with the statute and rules.

It is submitted that the statute under consideration should be construed with specific reference to the business which it is intended to regulate.

BUSINESS OF THE OFFICE.

There are filed in the Patent Office approximately 68,000 applications a year. A large number of them are found to contain conflicting claims. It is of the highest public interest that the prosecution of all applications be brought to a speedy conclusion, so that patents may be issued on those which are found to be allowable. It was found that in the years 1911, 1912, and 1913 the office ran behind at the rate of approximately 4,000 applications a year, and that a steady falling behind, in the course of years, had resulted in the accumulation of over 140,000 applications, being more applications than the total receipts of two years.

Among all the classes of the work which the office is called upon to do nothing so readily develops complex situations as that which is concerned with the rights of rival inventors. The difficulty of disposing of interference proceedings has been so great and the cost and delay to applicants has been so serious as to cause grave injury and well-founded complaint. The complicated system of interference proceedings which has gradually grown up, all based on the very few and simple words of Revised Statutes, section 4904, has been a source of much animadversion.

In *Allen* v. *United States ex rel. Lowry* (1905), 26 App. D. C. 8, 18, it is said:

> * * * From the simple and summary mode first adopted for determining the question of priority of invention, that proceeding, by system of Patent Office rules, has grown to be a veritable old man of the sea, and the unfortunate inventor who becomes involved therein is a second Sinbad the Sailor. It is known to all who are familiar with the practice in interference proceedings that, by motions, petitions, and appeals of every conceivable character that the ingenuity of the skilled attorney can devise, interferences can be, and are, prolonged for years, to the injury of the public, and often to the financial ruin of the parties.

One of the direct and serious results of inefficient handling of interferences has been the detention of applications in the office for many years. It fre-

quently happens that after an application has gone through an interference, it immediately enters upon another. This may continue until the value of the invention has been lost, or until the applicant rightfully entitled to a patent, if he is not a man of means, is worn out and defeated.

There are pending in the office at the present time more than 1,600 applications which have been there not less than five years, some of them for ten years or more. If the filing of an application to-day disclosing and claiming subject matter conflicting with one of these many applications necessitates the declaration of an interference to try out the supposed question of priority, no limit can be set to the delay which may occur before a case will be free to be passed to issue.

A strict application of section 4904, as construed by the court below, would make it well-nigh impossible to get through the office a fundamental application upon an invention which had gone into general use and become the basis of widespread further invention. Meanwhile, anyone could appropriate it, and when the patent was granted there could be no recovery of damages.

THE PRACTICE ATTACKED.

The practice which the Commissioner instituted and which is attacked in the mandamus proceeding is as follows: Where the interval between the filing of the application was such as to render it probable that the junior party had conceived after the senior application was filed (and one year was taken as

such an interval), the Commissioner wrote a letter to the later applicant, sometimes referring to his own claims and sometimes stating the claims which had been made by the other applicant, asking him to state the date when he conceived the invention, when he disclosed it to others, and when he reduced it to practice, and also stating that the purpose of asking these questions was to determine whether it was necessary to declare an interference. If the date of conception alleged was subsequent to the filing date of the senior applicant, the later applicant was notified that no interference would be declared, that the senior application would be passed to issue; and when a patent was granted, his claims would be rejected thereon, in so far as it is found to be pertinent.

This practice, which is here under attack, is only a part, though an essential part, of a general effort to expedite the prosecution of applications.

This policy is also a part of an organized scheme provided to enable the Commissioner to perform the duty imposed upon him by the section of the statute under discussion (sec. 4904) of forming an "opinion" as to the existence of interfering applications before an interference is declared. Heretofore each one of the 43 primary examiners decided for himself all questions of the initiation of interferences. Now, one law examiner reviews all of the proposed interferences with the examiner who has charge of the applications involved and, in case of doubt, submits the question to the Commissioner for decision. In carry-

ing out this plan the Commissioner conceives it to be his duty under this section of the statute further to ascertain by inquiry, if possible, whether or not any actual question of priority of invention can be raised. It is the contention of the Fowler Car Company that, in this respect, the Commissioner is exceeding his authority.

STATUTE DOES NOT GIVE RIGHT OF OPPOSITION.

Applicants are presumed to have made their inventions in the order in which the applications are filed, but this presumption is rebuttable. The object of section 4904 is to direct how questions of priority of invention may be tried. It is submitted that this section should not be construed as conferring upon an applicant a right, which is not enjoyed by the general public, of opposing the grant of a patent to a rival applicant; but should be construed as merely providing means for determining whether a patent will be granted to a later applicant, notwithstanding an earlier rival application for the same invention.

It will be assumed that a junior applicant who is unable to allege a date of conception earlier than the filing date of the senior applicant is an independent inventor. Even though he has evolved a new thing independently and has put it to practical use, that, under the patent law, is not a defense against a suit brought upon a patent granted to the first inventor. If the later independent inventor does not file an application for patent, he has no right to oppose the grant of a patent to the earlier inventor. It is illogical to hold that he can acquire a right of opposi-

tion by the mere fact that he has filed an application. The patent statute nowhere grants in terms to anyone other than the tribunals of the Patent Office a right to oppose the grant of a patent. If a system of opposition is to obtain, it should be general in its applicability. To enforce the construction of any section of the patent statutes which will result in development of oppositions dependent upon the chance filing of an application is to modify the practice in a manner not in harmony with the general scheme of *ex parte* grants made by the Government after an official examination.

In passing out a patent to a senior applicant, no attempt is made to adjudicate the rights of the junior applicant. Every precaution is taken, even to returning his statement, to leave him free to prosecute his own application after the patent to his senior rival is issued; and after it is issued the patent and all proceedings in the office thereon are public documents.

The Fowler Car Company seeks to make it appear that it is contending against a rejection of its application, but no rejection has been made. If there is to be any rejection, it will only follow the granting of the senior party's patent, when the whole proceeding incident and leading up thereto will be thrown open to public inspection.

What the respondent is claiming is the right to see the application of his senior rival, before the patent is granted thereon, in order that he may oppose the grant. But having stated to the Commissioner a

date of invention which is later than the date of application of the senior applicant, and having thus eliminated any question of priority, why should the Fowler Car Company have a right to oppose the grant of a patent, inasmuch as the Patent Office rules make all patent proceedings (other than interference proceedings) *ex parte*? There appears in respondent's arguments an attempt to confuse the court—an attempt to convey the idea that a grant of patent to the senior applicant would, in some way, constitute a judgment as to priority against the junior applicant. Of course, this is not so. Such a grant is no judgment of priority at all.

SERIOUSNESS OF INJURY TO SENIOR PARTIES.

Against the asserted right of opposition must be weighed the right of an applicant to obtain his patent when he asks for it.

An applicant without considerable means may be prevented by a succession of interferences with parties junior to him from obtaining his patent for 5, 10, or 15 years. It may mean financial ruin. Consider, for example, inventions in the field of toys and puzzles, ornamental designs, or patterns in dress goods, or other articles of mere fashion which are usually short lived. Or, to cite a large engineering development, take the propulsion of street cars by cable, which came into vogue in the last century during the late seventies, flourished during the eighties, and became obsolete during the early nineties. Aside from these special cases, there are many inventors

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in every field of endeavor who must obtain their patents promptly or lose all reward of their industry and talent.

The injustice to the senior party arising out of delay in the granting of his patent can not be too strongly pressed. Oppositions growing out of interference proceedings have been made in the past in many cases instruments of oppression by strong manufacturing concerns engaged in infringing. While the application is still in the office, no right of action and no ultimate right of recovery is acquired. Though there is a right of recovery after patent against individual users (which practically speaking can not be enforced), whatever manufacturing is done and profits made by rival manufacturers while the application is delayed in the office is absolutely lost to the inventor. This is true, even though he ultimately obtains a satisfactory patent and is successful in suits upon it. It is not a compensation that his patent extends for 17 years from the date of grant; for 17 years is more than the life of many inventions and may extend beyond the life of the patentee. The infringer may skim the cream and get out of business before the patent is granted. This is of frequent occurrence. It is the interest of the inventor which the office, in the practice now attacked, is seeking to protect, not as against an assignee, but against a rival and junior inventor or infringer.

During the year 1916 there were declared 1,286 interferences. In 344 of these interferences orders to show cause why judgment should not be entered were issued against all junior parties because they alleged dates of conception of the invention subsequent to the dates of the filing of the applications of the senior party. The larger part of these 344 interferences, under the practice of making a preliminary investigation to ascertain the date of conception by the latter applicant, would never have been declared.

In the court below it was argued that the fact that in only a small percentage of cases does the later applicant succeed in proving priority, where the dates are a year apart, was no reason for refusing this small percentage their right. It has not been contended that it was. But the fact that only a small percentage ever succeeds is a reason for making a preliminary investigation, and for confining the interferences to approximately that small number, instead of declaring a large number of interferences in order to include them. Of the 344 interferences referred to above, in which orders to show cause were issued during 1916, from 250 to 300 would in all probability have been eliminated by the procedure attacked in this case.

In every legal proceeding some one is inconvenienced. The theory of the practice attacked is to spare the man who on the record presented presumably has the right to a patent, and to subject the junior applicant, who presumably has no right, to the

inconvenience of postponing any objection as to patentability, etc., that he may be able to present until after the patent to his rival has been granted. Thus, hundreds of applicants are spared vexation and delay which in the end is shown to be needless.

INJURY TO THE PUBLIC.

The interest of the senior applicant is not alone involved. There is a large public interest which demands for its protection prompt prosecution of applications. Manufacturers have frequently been injured by the granting of patents upon applications which have been pending for years in the secret archives of the office, and which when granted are found to cover business developed innocently and in ignorance of the pending applications. In 1914 there were more than 4,200 applications which had been pending over five years. To-day there are about 1,600. Little further progress can be made with this salutary reform if hundreds of unnecessary interferences are to be established each year. This is what is meant by the statement made above that the practice here attacked is an essential part of a general effort to expedite the prosecution of applications.

To the statement made to the court below, that the Commissioner is overturning a practice of 40 years, it may be answered that during these years the public interest has not been respected; and applications have either willfully or unavoidably been detained in the office far beyond any reasonable need.

The correction of such evils is the business of administrative officers, which should not be prevented by the courts, except for the preservation of important and clear rights.

The right that is claimed here is the right to see that the office makes no mistake in passing out the senior applications. If the office were entering a judgment against the junior party, there might be force in the contention. But, as stated above, no judgment is entered. All that happens is that another applicant gets a patent. In so far as that patent discloses the invention, the junior party has lost nothing to which he is entitled. In so far as the patent fails to disclose the invention, the junior party has lost no rights; for he is free to show the deficiency of the patent and to obtain a patent on what is left.

It must be clearly borne in mind, however, that the case at bar does not involve the question of the legality of the Commissioner's practice as a whole. It involves the single question whether, when, in accord with the practice, the Commissioner has received a statement from the applicant himself alleging a date of invention later than the date of the senior party's application, the Commissioner is obliged by any statute or Patent Office rule to go through the useless form of referring the alleged question of priority to a primary examiner for determination by the institution of technical interference proceedings.

IV.

The respondent contends that because of the existence of Patent Office Rule 122, which provides for a motion to dissolve the interference, he is entitled to have the interference declared so that he may later move to dissolve it; and he contends that the failure of the Commissioner deprives him of his alleged right to move to dissolve. The Commissioner contends that the privilege of such a motion is not an independent substantive right, but is a mere incident to the procedure, after the Commissioner shall have found the existence in fact of an interference.

The respondent contends that by the failure of the Commissioner to cause a declaration of interference he is deprived of some right, because, incidental to the procedure for interference proceedings provided for by the Patent Office rules, there is a rule allowing a motion to dissolve an interference (rule 122). In other words, there being a certain rule which enables applicants to contest certain points regarding the issue of a patent when it appears that a question of priority of invention is raised, the respondent conceives that, even in a case where through his own statement, it is apparent that no question of priority arises, he is entitled to have an interference declared in order to enable him to take advantage of this rule. This contention of the respondent has been discussed to some extent (*supra*, pp. 35–37) under the heading "statute does not give right of opposition."

It was virtually stated at the hearing below that the declaration of interference was sought, not in

order that Fowler might be shown to be the first inventor, but that the petitioner might have an opportunity to oppose the granting of a patent to the unknown applicant; in other words, *it was sought to have the declaration of interference in order that it might be shown later to the Patent Office (on a motion for dissolution of the interference) that it ought not to have been declared.*

It is submitted that the statute does not require the declaration of an interference for any such purpose. A and B may independently make the same invention. If A files an application and B does not, B has no right to contest in the Patent Office the patentability of A's claims; for the rules provide that the proceedings as to patentability shall be *ex parte*. If B files a later application, but states to the Patent Commissioner a date of his invention which is later than A's application, he has no greater right to contest the patentability of A's claim than if he, B, had filed no application whatever, inasmuch as the only provision made in the Patent Act for a contest or litigated proceeding is under section 4904 in a case where priority of invention is necessary to be determined.

The motion to dissolve is a mere incident to the procedure after the Commissioner shall have found the existence of an interference in fact in his "opinion," and after the technical declaration of interference by the examiner. The making of such a motion is not an independent, substantive right, and

can only be made when and as provided for by the rules.

> * * * motions to dissolve are not the creature of any statute, but of the rules of the Patent Office, and no provision, by Patent Office Rules, for such motions, was made until many years after the statutes relating to interferences were enacted. Section 42 of the act of 1870, reenacted in 1874 and now in force and known as section 4904 of the Revised Statutes, in line with the earlier statutes (act of 1793, § 9, and 1836, § 8), provides for the institution of interferences for the sole purpose of determining the question of priority of invention. * * * (*Allen* v. *United States ex rel. Lowry* (1905), 26 App. D. C., 8, 16, 17.)

The argument made in this attack on the procedure adopted by the Commissioner in the case at bar is very similar to that made on the seventy-third rule of the Supreme Court of the District of Columbia, which, it was contended, deprived the defendant in an action *ex contractu* of a constitutional right to a jury trial. That rule reads as follows (par. 1):

> 73. 1. *Summary Judgment on Affidavit.* In any action arising *ex contractu*, if the plaintiff or his agent shall have filed, at the time of bringing his action, an affidavit setting out distinctly his cause of action, and the sum he claims to be due, exclusive of all set-offs and just grounds of defense, and shall have served the defendant with copies of his declaration

> and of said affidavit, he shall be entitled to a judgment for the amount so claimed, with interest and costs, unless the defendant shall file, along with his plea, if in bar, an affidavit of defense, denying the right of the plaintiff as to the whole or some specified part of his claim, and specifically stating also, in precise and distinct terms, the grounds of his defense, which must be such as would, if true, be sufficient to defeat the plaintiff's claim in whole or in part. And where the defendant shall have acknowledged in his affidavit of defense his liability for a part of the plaintiff's claim as aforesaid, the plaintiff, if he so elect, may have judgment entered in his favor for the amount so confessed to be due.

In overruling the contention as to its unconstitutionality, the Supreme Court of the District of Columbia, sitting in general term, said in *National Metropolitan Bank* v. *John Hitz et al.* (1879), MacArthur and Mackey's Reports, 198, 199:

> The rule in question was not adopted with a view of striking down the rights of parties litigant to a trial under the Constitution and the laws: and for a very good reason, no power existed in the court to do that. The Constitution has provided that a party may make up an issue and have a trial before a jury in all cases where the value in controversy exceeds $20. And this court did not propose to repeal the Constitution.

We adopted this as a rule of practice; one of the means that is pointed out in the processes of the court to produce results. It provides that when a plaintiff comes into court, states his demand fully and clearly and under the sanction of an oath, the defendant must present his denial of that demand and his purpose of defense under a sanction as high and as binding.

This rule was adopted in this jurisdiction when we were overwhelmed with a great oppression of business. The calendar in the Circuit Court had run up to a thousand cases or thereabouts. Great delays in judgment occurred; creditors were postponed in their collections to an indefinite time. Defendants naturally resorted to the formal denials of pleading for the purpose of securing the time that the delays of the law gave them.

In *Cropley* v. *Vogeler* (1893), 2 App. D. C. 28, 33, the court said:

> The contention is that the rule is in derogation of the constitutional right to trial by jury, as well as an exercise by the court of a power that properly belongs, if anywhere, to the legislature.
>
> The seventh amendment to the Constitution provides that "in suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved." And in the fifth amendment there is the provision that "no person shall be deprived of life, liberty, or property, without due process of law." And, in view of these pro-

visions, it is claimed that a defendant can not lawfully be deprived by any rule of court, or even by a legislative enactment, of his absolute and unqualified right to trial by jury, which it is argued that this rule seeks to do by the substitution of trial by affidavit for trial by jury.

The argument is specious but not substantial.

The question came before this court in the case of *Fidelity and Deposit Company of Maryland* v. *United States* (1902), 187 U. S., 315. In upholding the constitutionality of the rule, this Court said (319–321):

> There is but one element in this contention—the right of a jury trial. In passing upon it we do not think it necessary to follow the details of counsel's elaborate argument. In *Smoot* v. *Rittenhouse* (decided January 10, 1876), the validity of the rule was sustained as well as the power of the court to make it. If it were true that the rule deprived the plaintiff in error of the *right* of trial by jury, we should pronounce it void without reference to cases. But it does not do so. It prescribes the means of making an issue. The issue made as prescribed, the right of trial by jury accrues. The purpose of the rule is to preserve the court from frivolous defenses and to defeat attempts to use formal pleading as means to delay the recovery of just demands.
>
> Certainly a salutary purpose and hardly less essential to justice than the ultimate means of trial. And the case at bar illustrates this. It certainly does not seem unreasonable to charge

> one who has become responsible for the performance of an act by another with knowledge of that act or with means of ascertaining it, so as to state a defense within the liberal interpretation of the rule declared by the Court of Appeals. * * *
>
> It would seem a logical result of the argument of plaintiff in error that there was a constitutional right to old forms of procedure, and yet it seems to be conceded that Congress has power to change them, even to the enactment of rule 73. The concession of that power destroys the argument based on the Constitution, and whether Congress exercised the power directly or delegated it to the Supreme Court of the District of Columbia can make no difference. And that such power had been delegated to the Supreme Court of the District was virtually decided in *Smoot* v. *Rittenhouse*, supra.

In his brief in opposition to the petition for certiorari, the respondent claims that the Commissioner misunderstands his position, and says (p. 12):

> * * * But lest we be further misunderstood, we say now that we desire that an interference be declared in order that we may know what we have to meet; that we may have an opportunity to contest the question of priority, and that the issuance of a patent to an opponent with interfering claims in an *ex parte* proceeding may be prevented.

The question arises: What contest can there be on the question of priority when the respondent

admits a date of invention which is later than the date of filing of the senior applicant's application?

On page 13 of the same brief, the respondent discusses the point that, as a result of the procedure known as a motion to dissolve (under rule 122)—

> it may appear—and often does appear—that the party who was the first to file was not the first to disclose the invention covered by the claims, and therefore it may and frequently does turn out that the junior party, whose dates of conception are later than the other party's filing date nevertheless prevails because the application of the senior party as originally filed may not disclose the invention.

As to the frequency of these occurrences, the Patent Commissioner desires to enter an emphatic denial.

Either the senior party's application does or it does not disclose the same invention as the junior party's. If it does, then the junior party gains nothing by his motion to dissolve; if it does not, then the junior party loses nothing by the issue of the patent to the senior party.

If the respondent's argument is directed at the possibility of introduction of new matter after the filing of the senior application, it may be observed that the rules of the Patent Office prohibit introduction of new matter. See present rule 70, as follows:

> Rule 70. In original applications all amendments of the drawings or specifications, and all additions thereto, must conform to at least

> one of them as it was at the time of the filing of the application. Matter not found in either, involving a departure from the original invention, can not be added to the application even though supported by a supplemental oath, and can be shown or claimed only in a separate application.

New matter is, as will be seen, refused admission. In no case is the matter added with the idea that the application will be treated as filed on the date that the new matter is added.

That occasional office mistakes may occur can not be denied in the handling of multitudes of applications. How such a mistake is treated appears in the case of *McKnight* v. *Pohle* (1907), 30 App. D. C. 92, 130 O. G. 2069. This opinion closes with the following statement (96):

> The Commissioner repeats his conclusion, therefore, that McKnight's original application did not disclose the invention now in issue, and was not a proper foundation for the amendments by which it was made to include this invention, and further concludes that the patent granted upon this application is not to be accepted as proof of the invention of the issue at the date of the application and since the amendments were unwarranted the patent is not to be deemed evidence of this invention by McKnight at any time.

We submit that an occasional office mistake in violation of a plain rule is not a proper basis for argument limiting the power of the Commissioner.

The brief further says, on page 13:

> Even assuming that the Commissioner after careful consideration decides that the earlier filed application discloses the invention so as to entitle such earlier applicant to his original filing date he is not warranted in refusing to declare an interference on such *ex parte* examination because under the rules of practice that is an *inter partes* question.

The Patent Commissioner is not greatly concerned respecting the proper construction of the present rules of practice; for the rules may be amended as the exigencies of the great and growing business demand. What he is concerned about here is the holding of the court below that the statute prohibits a course such as the Commissioner took, or a rule permitting such action on his part.

In reply, however, to the suggestion that the rules of practice make the question an *inter partes* question, the answer is clear. The Commissioner being granted full authority to form an opinion whether an interference in facts exists or not, and the rules of the office prohibiting new matter, the Commissioner should be trusted to determine whether a question of new matter is presented or not. If a question of new matter is presented, it would properly be his duty to declare the interference and permit the question to be fought out *inter partes*, but if in his judgment no question of new matter arises he should not be required to declare a multitude of interferences lest now and then through bald mistake a patent may be improvidently granted.

Particularly is this true where, as the *McKnight-Pohle* case shows, such a mistake is not fatal to the rights of the party aggrieved thereby.

The statement in the opinion below, that it is the design of the law to protect the property rights of the small minority who may be found entitled to prevail, assumes a loss of right that does not occur by the mistakes of the office, for correction of which the statute, in fact, by elaborate provisions supplies a remedy. Meanwhile, under the interpretation of the statute by the Court of Appeals, every man justly entitled to a patent is subjected to hindrance which may, and frequently does, amount to persecution at the behest of men who have no rights whatsoever. The interpretation would not be urged, but for the desire to maintain the right of opposition which has engrafted itself upon the interference practice, and which should be eradicated therefrom.

CONCLUSION.

In conclusion, we respectfully ask this court to bear in mind that the right under the statute is what is here important. If this court should conclude that the right exists under the statute, but that the Commissioner's power has been limited by the rules of practice, we trust that this will be made clear. The question of power under the statute could not be more simply presented than in the case at bar, and several hundred like cases arise in the office every year.

Whether the practice attacked should be applied in such a case as *Christensen* v. *Noyes* (1899), 15 App. D. C. 94, 90 O. G. 223, where rights under a renewal application were involved, or where the junior party refuses information, or in other suggested cases, can be considered when the question presents itself.

But this is no such case. Here the statement is clearly made in the answer to the rule to show cause "that the date of conception stated by the applicant Fowler is several months subsequent to the date on which the other application referred to was filed." There is but one application of the senior applicant involved, and therefore no questuon arises of renewal, division, or continuation; nor, in the opinion of the Commissioner, does any possible question of new matter arise. If, in such a simple case, the Commissioner, though possessed of information actually gained from the junior applicant himself, showing that there is no question of priority, is none the less obliged to refer the applications to the primary examiner "to determine the question of priority of invention," and hold up the senior application while the proceeding of interference is gone through with, then the right of opposition based on the chance filing of a concurrent application is read into a statute, which, under all other circumstances, refuses right of opposition excepting to the constituted authorities of the Government itself.

It is respectfully submitted that the decree of the Court of Appeals of the District of Columbia should be reversed and the petition for writ of mandamus be denied.

CHARLES WARREN,
Assistant Attorney General.

R. F. WHITEHEAD,
Counsel.

MARCH, 1917.

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1916.

THOMAS EWING, COMMISSIONER OF PATENTS,
Petitioner,
vs.
UNITED STATES, ex rel. THE FOWLER CAR COMPANY,
Respondent.

Petition for Writ of Certiorari to the Court of Appeals for the District of Columbia.

BRIEF FOR RESPONDENT.

The petition herein does not correctly state the question involved. The real question involved in this proceeding is, "May the Commissioner of Patents refuse to declare an interference between copending applications for patents where he has determined that one exists, on the ground that it is unnecessary, in his judgment, because he has learned that the date of conception of the invention alleged by the party last to file is later than the assumed effective filing date of the other party."

The petition presents the question as though the application for the writ of mandamus sought to control the

action of the Commissioner upon a question which was committed to his determination; in other words, the petition represents that an effort is being made to control the *opinion* of the Commissioner concerning matters which are referred to his judgment.

The statement of facts contained in the petition is correct as far as it goes, but it omits material matters.

Statement of Facts.

The Commissioner on November 18, 1915, under a practice long followed in the Patent Office, suggested certain claims to the applicant Fowler. The purpose of such a suggestion is to enable the applicant to include the suggested claims in his own application if he desires an interference with another applicant. In the same letter the Commissioner requested Fowler to furnish a statement as to his dates of invention. This statement is not provided for in the Rules of Practice; its requirement is an innovation established by the present Commissioner; it is without warrant of law or authority of any sort under the statute or the rules; is irregular in character, in that the statement is not made a part of the files, but is returned to the applicant, and the furnishing of such a statement cannot be enforced and no penalty can be attached lawfully to a failure to furnish such statement.

The applicant Fowler furnished this informal statement and in connection therewith filed an amendment to his application in regular form including the claims suggested. Fowler's amendment was received and filed on November 26, 1915 (Petition, page 3). This of course made these claims a part of Fowler's case and established that there was an interference in fact, because the

notice to Fowler by the Commissioner said: "There is another application pending, claiming substantially the same invention as that defined in the following claims." Fowler requested that if such claims did appear in a co-pending application, an interference be declared. The Commissioner thereupon refused to declare the interference, basing his refusal on the ground that Fowler's dates of invention as set forth in the irregular statement furnished by Fowler were some months subsequent to the filing date of the application of the other party.

Upon this refusal to declare the interference, the petition for mandamus was filed.

The petition for the writ of certiorari states (page 7) that Rules 93 to 132 point out the method by which interferences are determined, but the petition refers to only three of these rules. One of the rules, not set out in the petition, provides for certain motions and for decisions thereon. This rule is numbered 122 and is printed below.* Under this rule, which was promul-

*122. Motions to dissolve an interference (1) alleging that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (2) denying the patentability of an applicant's claim, or (3) denying his right to make the claim, should contain a full statement of the grounds relied upon and should, if possible, be made not later than the thirtieth day after the statements of the parties have been received and approved. Such motions and all motions of a similar character if in the opinion of the Commissioner they be in proper form, will be heard and determined by the law examiner, due notice of the day of hearing being given by the Office to all parties. If in the opinion of the Commissioner the motion be not in proper form, or if it be not brought within the time specified and no satisfactory reason be given for the delay, it will not be considered, and the parties will be so notified.

When the motion has been decided by the law examiner the files and papers, with his decision, will be sent at once to the docket clerk.

Motions to shift the burden of proof should be made before, and will be determined by, the Examiner of Interferences. No appeal from the decision on such motions will be entertained, but the matter may be reviewed on appeal from the final decision upon the question of priority of invention.

gated more than twenty-five years ago and followed during that period by the Patent Office, the question of interference in fact, the question of seniority of the parties, the patentability of the claim to one or the other, and a number of other questions became *inter partes*, and it often happens that the interference is dissolved because of mistake in declaring it or the burden of proof shifted on the ground that the senior party is not entitled to his original filing date as his effective date for the reason that he did not disclose the invention in his case as originally filed, or that he was not entitled to make the claims, or that the junior party had an earlier filed case disclosing the invention, or that the issues as formed did not apply to the structures of the two parties.

All of these questions arise, or may arise, in every interference which is declared, and by means of these preliminary motions and the judgment of the Patent Office thereon the issues are clearly defined, the relations of the parties to each other are settled, and if no conflict in fact exists the interference is terminated. This practice prevents a judgment of record based solely upon an *ex parte* consideration by the Commissioner and affords each of the parties an opportunity to contest the right of the other party to a judgment. This practice is still followed by the present Commissioner when interferences are declared. The irregular practice here complained of was engrafted by him upon the rules, or rather established outside of the rules for the purpose, he declares, of avoiding a declaration of interferences wherein, in his opinion, the junior party could not prevail. It is this practice which Fowler complained of and which the courts below have forbidden.

The petition for mandamus set out the filing of the

application by Fowler, the assignment thereof to the Fowler Car Company, the appointment of an attorney to prosecute the application, the Commissioner's letter of November 18, 1915, calling for a statement as to Fowler's dates of invention, the response by Fowler, the amendment to Fowler's application incorporating the suggested claims, and the statute requiring the Commissioner to declare an interference.

The petition for mandamus also set out the authority for the Rules of Practice and the relevant rules which had been established, and charged that:

> "it clearly appears, and petitioner charges, the fact to be that there are now pending in the Patent Office two applications for patents, to-wit: Petitioner's said Fowler application and an application of an applicant to your petitioner unknown, which applications disclose and claim the same patentable invention, and that a case of interference exists between said applications under the statutes and rules, and that it is the duty of the respondent, under the statute and rules to declare said interference."

The petitioner further sets out that the refusal of the Commissioner to declare the interference was contrary to his duty; that the demand for a statement of Fowler's dates was irregular and unjustifiable; that the statement of the Commissioner that he would issue a patent to the unknown applicant constituted a breach and violation of the statute and of the rules; is calculated to and will seriously damage and injure the petitioner; that the conduct of the Commissioner complained of is a matter of large public concern involving the validity and binding effect of the interference rules upon the Commissioner and other officials of the Patent Office; that for over a quarter of a century the predecessors of the present Commissioner without exception regarded said interference rules as imposing

upon them the legal duty of declaring an interference whenever two pending applications claimed substantially the same patentable subject-matter; that the Commissioner's conduct complained of is a radical departure from and violation of said long settled practice; that the Commissioner has refused and continues to refuse to declare the aforesaid interference, and that the petitioner was without redress or remedy except by the writ of mandamus.

The answer of the Commissioner admits the filing of the Fowler application, the call upon Fowler for a statement of his dates of invention, Fowler's response thereto and the filing of the amendment containing the claims suggested to Fowler, and the request that an interference be declared. The answer admits that the respondent notified Fowler's attorney that the interference would not be declared. The Commissioner's answer further denied that he had violated any statute or rule of the Office, and contained *arguendo* his reasons for refusing to declare the interference. *The answer nowhere denies that an interference in fact exists.*

I.

The statute allows no discretion to the Commissioner to declare an interference if one exists. Section 4904 provides:

> "Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application or with any unexpired patent, he shall give notice thereof to the applicants or applicant and patentee as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention."

The fact that the Commissioner had formed the

opinion that an interference existed is shown, first, by his call upon Fowler to furnish a statement, second by the suggesting of the claims to Fowler, and third by the language of the Commissioner's letter of November 18, 1915 (Exhibit "A," page 9), which concludes:

> "In order to determine whether *it is necessary to declare an interference,* you are requested to obtain a statement from Fowler," etc. (Italics ours.)

The statute, it is to be noted, is mandatory so far as the declaration of the interference is concerned. Rule 94 of the Rules of Practice in the Patent Office which was in effect until January 1, 1916, is also positive in its provisions. It says:

> "Interferences will be declared in the following cases when all the parties claim substantially the same patentable invention: 1. Between two or more original applications containing conflicting claims," etc.

In the present case there is no doubt these two applications contain conflicting claims. The Commissioner was not seeking information to enable him to form an opinion whether there was an interference, but he was seeking information which would enable him to avoid declaring an interference which existed. The Court of Appeals took this view, for its opinion says:

> "The Commissioner's return to the rule to show cause is based upon the ground that petitioner's date of conception is several months subsequent to the date on which the other application was filed and that this finding justifies the Commissioner in refusing to declare an interference. Concededly the Commissioner found that an interference existed between the pending applications, but to avoid what he deemed must in all probability result in fruitless litigation he refused to declare an interference."

The Commissioner's brief in support of his petition

(page 13) says that the Court of Appeals was in error and that no such concession was made by the Commissioner or by his counsel and that it is expressly repelled by him. Of course we are not permitted to speak except from the record, but we submit that the Commissioner's answer nowhere denies that an interference exists, and that the correspondence showed that he believed that an interference did exist, and that the filing of the amendment to Fowler's application established an interference. The discretionary power of the Commissioner does not go so far as to permit him to refuse to act where his own correspondence shows that action was required. It is not the business of the Commissioner to decide whether interferences are wise or otherwise, but simply to follow the law and the rules.

II.

The brief for the Commissioner says:

> "If the Commissioner of Patents has knowledge that any facts exist which render impossible an interference or conflict between claims, he has a right, without more, to find that there is no interference in fact. He is not required to institute an interference proceeding to determine priority, when he is aware of facts which show that no question of priority can arise in the case." (Page 14.)

This simply means that if the Commissioner concludes that the junior party cannot prevail in the interference, he will refuse to declare it. Interference is a question of fact; it exists, or it does not exist. If it exists it must be determined in the way pointed out by the statute and the rules.

The brief for petitioner contends that the Court of Appeals confuses the meaning of the word interference as used in the statute and in the rules. As we under-

stand the opinion it clearly recognizes the right of the Commissioner to form an opinion as to whether an interference exists and as clearly declares that when the Commissioner has formed and expressed such an opinion he is obliged to declare it.

The answer to the petition for mandamus and the present petition and brief in substance amount to nothing more than an argument against the positive mandate of the statute and the rules based upon the Commissioner's views as to the propriety of the legislation.

The letter of the Commissioner to Fowler (Exhibit "A," Rec., p. 9) says:

> "There is another application pending *claiming* substantially the same invention as that defined in in the following claims." (Italics ours.)

Then follow seven claims.

Fowler immediately filed an amendment (Exhibit "C," Rec., p. 10), incorporating those claims in his application and requested an interference.

The Commissioner having thus formed and expressed an opinion that the pending application of another applicant was "claiming substantially the same invention as that defined in the following (suggested) claims" which were then made by Fowler, the provisions of the statute and of the rules applied and nothing remained for the Commissioner to do but to declare the interference.

This he refused to do and therefore the court clearly recognizing the distinction between this case and the Trussed Concrete Steel Company case ordered the Commissioner to follow the statute.

With all due respect we submit the contention of the petitioner's brief (p. 15) that the Commissioner was seeking to obtain from Fowler the information as to

the date of his conception of his invention for the express purpose of "forming an opinion" as to whether any interference existed is contradicted by his own acts.

The *fact* as to whether an interference existed was the only thing to be determined by him. The question as to which of the parties was entitled to an award of priority as to that invention could only be determined by the institution of an interference and due proceedings therein. That determination is not conditioned by any such considerations as those advanced by the petition under the heading "Reasons of public import for the issue of the writ" (pp. 8-11, Commissioner's petition and brief).

In answer to the suggestions of the Commissioner (pp. 17-18) forming, it is contended, exceptions under the statute and the rules we reply:

(*a*) There is no claim here that Fowler had abandoned his invention. On the contrary he made the interfering claims at the same time that he demanded the interference.

(*b*) There is no claim that Fowler was debarred from obtaining a patent in this country because of an earlier filed foreign application.

(*c*) The Commissioner had no knowledge from Fowler's statement that no interference in fact existed or that the senior applicant was the prior inventor, for the Commissioner had himself declared that an interference in fact existed and he sought to avoid its declaration by an *ex parte* determination that Fowler could not prevail whereas the Commissioner did not and could not *know* that fact.

Nor does the practice of the Patent Office with respect to the declaration of interferences between an application and an unexpired patent affect the present inquiry.

The reason for the rule requiring an applicant to file an antedating affidavit as a prerequisite to the declaration of an interference between his application and an unexpired patent is that such patent until overcome by an antedating affidavit is a bar to the grant of any patent to the applicant. Such patent is a public record. Its disclosure and its history are open to the applicant. He may determine its efficacy as a bar and its sufficiency as to disclosure by a comparison with his own application. He need leave nothing to the *ex parte* consideration of the Patent Office but may contest every point with full knowledge of the facts. Therefore unless he can overcome the patent as a bar he is not entitled to an interference.

But the case of two pending applications is obviously different. Here the junior applicant knows nothing concerning the facts. He is not permitted to know who his opponent is, to see his application or to know when it was filed. He must accept the mere dictum of the Patent Office as to its existence, contents and legal effect.

In the case of a patent the Office has no power to alter, modify, restrict or cancel. In the case of a pending application the Office may require the applicant to modify his claims and if he does not may reject them.

III.

Petitioner contends (pp. 22-24 of his petition and brief) that even if the Court of Appeals was right in holding that the Commissioner had found an interference existed it should have refused the writ because it required a vain thing.

This argument is based on the assumption that when Fowler disclosed his date of invention the Commis-

sioner might institute a comparison of such dates with the mere chronology of the unknown application and say that no interference could exist. He admits (p. 22) that in such case the "senior applicant's application would go through the Patent Office in the regular course of procedure in an *ex parte proceeding*, and patent would issue to him." This is precisely what the Commissioner told Fowler in the letter (Exhibit "D," Rec., p. 11), and he further added that "the pending application when patented will be cited as a reference against such claims in Fowler's application as it may be found to anticipate."

It would be difficult to conceive of a more arbitrary or high-handed proceeding in the face of a statute and the Commissioner's own rules than this.

The only answer possible to the statement of the middle paragraph, page 23 of the brief in support of the petition, is that our position was misunderstood. We are not obliged to give reasons for asking in our client's behalf that the statute, the rules and the practice of the Patent Office be followed by the Commissioner. But lest we be further misunderstood we say now that we desire that an interference be declared in order that we may know what we have to meet; that we may have an opportunity to contest the question of priority and that the issuance of a patent to an opponent with interfering claims in an *ex parte* proceeding may be prevented.

Further to prevent misunderstanding we point out that the Commissioner had no power to deny applicant Fowler *any* right which is given him by the statute and the rules of the Patent Office.

If the right of opposition is a substantial right following and dependent upon the declaration of an interference then Fowler has the right to have the interference declared.

IV.

The declaration of interference confers certain rights upon each of the parties, and the procedure provided in Rule 122 affords an opportunity for arranging the parties in proper order according to the true and effective dates of their respective applications whereby the burden of proof is fixed and the presumption of priority attaches. The motions allowed by this rule are not necessarily motions to destroy an interference, but they are provided in order to secure the proper alignment of the parties and to determine the order and burden of proof. In short, to prevent the issue of patents to the wrong person.

As a result of these motions it may appear—and often does appear—that the party who was the first to file was not the first to disclose the invention covered by the claims, and therefore it may and frequently does turn out that the junior party, whose dates of conception are later than the other party's filing date nevertheless prevails because the application of the senior party as originally filed may not disclose the invention. It is quite true that a party whose dates of conception are subsequent to his opponent's filing date has the burden of showing that his opponent is not entitled to his filing date but this burden can be and often is successfully borne and the junior party prevails in the contest.

Even assuming that the Commissioner after careful consideration decides that the earlier filed application discloses the invention so as to entitle such earlier applicant to his original filing date he is not warranted in refusing to declare an interference on such *ex parte* examination because under the rules of practice that is an *inter partes* question.

The fact that motions to shift the burden of proof often prevail is a sufficient answer to the present claim of the Commissioner that he is authorized to substitute his judgment for the procedure provided by his own rules.

The petitioner's brief says (p. 24) that the motions provided for by Rule 122 are a mere incident of the procedure *after* the Commissioner shall have found an interference in fact, and after the technical declaration of an interference. It is true such motions cannot be made *before* the interference is formally declared and it is also true that these motions are provided for by rule and not by statute.

But it does not follow that the Commissioner may refuse to follow the statute and thus cut off the right of the applicant to avail himself of the provisions of the rule.

The fact is that the statute and the rules taken together determine the rights of the parties and the procedure to be followed.

The power to make rules or regulations governing procedure in the Patent Office is conferred by Section 483 of the Revised Statutes, which reads as follows:

> "Sec. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

In pursuance of this provision the Commissioner of Patents from time to time and with the approval of the Secretary of the Interior has made rules or regulations and from time to time with like approval has amended the same, the last amendment having been made during the current year.

These rules or regulations have the force and effect of law and are binding as well upon the Commissioner as upon applicants. Such rules or regulations can only be repealed or modified by the same authority that promulgated them, namely, by the Commissioner of Patents with the approval of the Secretary of the Interior.

The right of an applicant to have an interference declared between the claims of his pending application and a pending application of another party claiming the same or substantially the same patentable subject-matter has never been questioned by any former Commissioner of Patents nor by the present Commissioner until within a very recent period.

Respondent invokes the settled practice of the Patent Office in support of its position. Even if the statute and the rules were ambiguous (which is not the fact), the long-established interpretation of them by previous Commissioners should not be disturbed.

In *Allen* v. *U. S. ex rel. Lowry*, 22 App. D. C., 8, the Court of Appeals, District of Columbia, speaking through Mr. Justice Duell, said:

> "While we recognize the rule as laid down in *Houghton* v. *Payne*, 194 U. S. 88, 48 L. Ed. 888, 24 Sup. Ct. Rep. 590, and in other decisions of the Supreme Court, that, if a practice is contrary to law, it is not made lawful by the practice of a department for a long period of time, yet due regard should be given to a practice which admittedly has prevailed for more than twenty-five years in proceedings of a judicial character, even should there be a reasonable doubt in the mind of the court as to the proper construction to be placed upon a statute. The Supreme Court said, in *Bate Refrigerating Co.* v. *Sulzberger*, 157 U. S. 1, 39 L. Ed. 601, 15 Sup. Ct. Rep. 508:
>
> "'If the statute be not so explicit as to preclude construction, if, upon applying to it the

established rules of interpretation; if, looking at it in the light of previous legislation on the subject; if there be reasonable ground for adopting one of two constructions;—this court, without departing from sound principle, may well adopt that construction which is in harmony with the settled practice of the executive branch of the government."

V.

Mandamus a Proper Remedy.

This does not seem to be controverted by counsel for petitioner, the only suggestion being as already noted that the writ would in the opinion of the Commissioner be ineffective.

Respondent recognizes the limitations upon the power of courts to control the actions of an executive or judicial officer by mandamus. Neither discretion, when discretion is permitted, nor judicial power, when such power is conferred, can be so controlled. But where no discretion is permitted or where the exercise of judicial power is sought to be avoided or evaded, mandamus is the proper remedy.

The courts may not compel the Commissioner to declare an interference if none exists, nor say how he shall decide an interference which has been declared, but they have power to compel the declaration of an interference when interference admittedly exists, and to compel the Commissioner to proceed to a determination of the question of priority. In short, to take jurisdiction. We simply asked that the Commissioner be required to take jurisdiction and then to proceed according to law and the rules of practice.

See *Commissioner of Patents* v. *Whitely*, 4 Wall., 522.

Ex parte Parker, 120 U. S., 737.
Hudson v. *Parker*, 156 U. S., 277.
United States ex rel. Todd v. *Gongwer*, 37 App. D. C., 555.

It is respectfully submitted that the writ of mandamus was properly granted and that the petition for certiorari should be denied.

MELVILLE CHURCH,
CHARLES C. LINTHICUM,
Counsel for Respondent.

October, 1916.

White Supreme Court, U. S.
APR 16 1917
JAMES D. MAHER
Clerk

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1916.

THOMAS EWING, COMMISSIONER OF PATENTS,
Petitioner,
vs.
UNITED STATES, ex rel. THE FOWLER CAR COMPANY,
Respondent.

No. 722.

On Writ of Certiorari to the Court of Appeals for the District of Columbia.

BRIEF FOR RESPONDENT.

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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, [illegible]

THOMAS LYNCH, COMMISSIONER OF [illegible]

No. 781.

UNITED STATES ex rel. THE HOWLAND [illegible] COMPANY.

On Writ of Certiorari to the Court of Appeals for the District of [illegible]

BRIEF FOR RESPONDENT

[illegible]
[illegible]

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1916.

THOMAS EWING, COMMISSIONER OF PATENTS,
Petitioner,
vs.
UNITED STATES, ex rel. THE FOWLER CAR COMPANY,
Respondent.
No. 721.

On Writ of Certiorari to the Court of Appeals for the District of Columbia.

BRIEF FOR RESPONDENT.

The sole question involved is the construction of U. S. Rev. Stat. 4904, which reads as follows:

> "Sec. 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the

decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty years, as the Commissioner shall prescribe."

Respondent contents, and its contention was upheld by the Supreme Court and Court of Appeals of the District of Columbia, that the construction which has uniformly been given said statute for more than twenty-five years, in fact ever since its enactment, is correct, while respondent argues that as a matter of expediency a new construction should be given to it.

Statement of Facts.

The Commissioner on November 18, 1915, under a practice long followed in the Patent Office, suggested certain claims to the applicant Fowler. The purpose of such a suggestion is to enable the applicant to include the suggested claims in his own application if he desires an interference with another applicant. In the same letter the Commissioner requested Fowler to furnish a statement as to his dates of invention. This statement is not provided for in the Rules of Practice; its requirement is an innovation established by the present Commissioner; it is without warrant of law or authority of any sort under the statute or the rules; is irregular in character, in that the statement is not made a part of the files, but is returned to the applicant, and the furnishing of such a statement cannot be enforced and no penalty can be attached lawfully to a failure to furnish such statement.

The applicant Fowler furnished this informal statement and in connection therewith filed an amendment to his application in regular form including the claims suggested. Fowler's amendment was received and filed on November 26, 1915 (Petition, page 3). This of course

made these claims a part of Fowler's case and established that there was an interference in fact, because the notice to Fowler by the Commissioner said: "There is another application pending, claiming substantially the same invention as that defined in the following claims." Fowler requested that if such claims did appear in a copending application, an interference be declared. The Commissioner thereupon refused to declare the interference, basing his refusal on the ground that Fowler's dates of invention as set forth in the irregular statement furnished by Fowler were some months subsequent to the filing date of the application of the other party.

Upon this refusal to declare the interference, the petition for mandamus was filed.

The petition for the writ of certiorari states (page 7) that Rules 93 to 132 point out the method by which interferences are determined, but the petition refers to only three of these rules. One of the rules, not set out in the petition, but printed on page 10 of petitioner's brief, provides for certain motions and for decisions thereon. This rule is numbered 122 and is printed below.* Under this rule, which was promulgated more

* 122. Motions to dissolve an interference (1) alleging that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (2) denying the patentability of an applicant's claim, or (3) denying his right to make the claim, should contain a full statement of the grounds relied upon and should, if possible, be made not later than the thirtieth day after the statements of the parties have been received and approved. Such motions and all motions of a similar character if in the opinion of the Commissioner they be in proper form, will be heard and determined by the law examiner, due notice of the day of hearing being given by the Office to all parties. If in the opinion of the Commissioner the motion be not in proper form, or if it be not brought within the time specified and no satisfactory reason be given for the delay, it will not be considered, and the parties will be so notified.

When the motion has been decided by the law examiner the files and papers, with his decision, will be sent at once to the docket clerk.

Motions to shift the burden of proof should be made before, and will be determined by, the Examiner of Interferences. No appeal from the decision on such motions will be entertained, but the matter may be reviewed on appeal from the final decision upon the question of priority of invention.

than twenty-five years ago and followed during that period by the Patent Office, the question of interference in fact, the question of seniority of the parties, the patentability of the claim to one or the other, and a number of other questions became *inter partes*, and it often happens that the interference is dissolved because of mistake in declaring it or the burden of proof shifted on the ground that the senior party is not entitled to his original filing date as his effective date for the reason that he did not disclose the invention in his case as originally filed, or that his application discloses an inoperative embodiment of the invention, or that he was not entitled to make the claims, or that the junior party had an earlier filed case disclosing the invention, or that the issues as formed did not apply to the structures of the two parties.

All of these questions arise, or may arise, in every interference which is declared, and by means of these preliminary motions and the judgment of the Patent Office thereon the issues are clearly defined, the relations of the parties to each other are settled, and if no conflict in fact exists the interference is terminated. This practice prevents a judgment of record based solely upon an *ex parte* consideration by the Commissioner and affords each of the parties an opportunity to contest the right of the other party to a judgment. This practice is still followed by the present Commissioner when interferences are declared. The irregular practice here complained of was engrafted by him upon the rules, or rather established outside of the rules for the purpose, he declares, of avoiding a declaration of interferences wherein, in his opinion, the junior party could not prevail. It is this practice which Fowler complained of and which the courts below have forbidden.

The petition for mandamus set out the filing of the application by Fowler, the assignment thereof to the

Fowler Car Company, the appointment of an attorney to prosecute the application, the Commissioner's letter of November 18, 1915, calling for a statement as to Fowler's dates of invention, the response by Fowler, the amendment to Fowler's application incorporating the suggested claims, and the statute requiring the Commissioner to declare an interference.

The petition for mandamus also set out the authority for the Rules of Practice and the relevant rules which had been established, and charged that:

> "it clearly appears, and petitioner charges, the fact to be that there are now pending in the Patent Office two applications for patents, to-wit: Petitioner's said Fowler application and an application of an applicant to your petitioner unknown, which applications disclose and claim the same patentable invention, and that a case of interference exists between said applications under the statutes and rules, and that it is the duty of the respondent, under the statute and rules to declare such interference."

The petition further set out that the refusal of the Commissioner to declare the interference was contrary to his duty; that the demand for a statement of Fowler's dates was irregular and unjustifiable; that the statement of the Commissioner that he would issue a patent to the unknown applicant constituted a breach and violation of the statute and of the rules; is calculated to and will seriously damage and injure the petitioner; that the conduct of the Commissioner complained of is a matter of large public concern involving the validity and binding effect of the interference rules upon the Commissioner and other officials of the Patent Office; that for over a quarter of a century the predecessors of the present Commissioner without exception regarded said interference rules as imposing upon them the legal duty of declaring an interference whenever two pending applica-

tions claimed substantially the same patentable subject-matter; that the Commissioner's conduct complained of is a radical departure from and violation of said long-settled practice; that the Commissioner has refused and continues to refuse to declare the aforesaid interference, and that the petitioner was without redress or remedy except by the writ of mandamus.

The answer of the Commissioner admits the filing of the Fowler application, the call upon Fowler for a statement of his dates of invention, Fowler's response thereto and the filing of the amendment containing the claims suggested to Fowler, and the request that an interference be declared. The answer admits that the Commissioner notified Fowler's attorney that the interference would not be declared. The Commissioner's answer further denied that he had violated any statute or rule of the Office, and contained *arguendo* his reasons for refusing to declare the interference. *The answer nowhere denies that an interference in fact exists.*

Section 4904 Mandatory.

The statute allows no discretion to the Commissioner to declare an interference if one exists. Section 4904 provides:

> "Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application or with any unexpired patent, he shall give notice thereof to the applicants or applicant and patentee as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention."

The Commissioner endeavors to reconcile his refusal to declare the interference with the plain requirement of the statute to do so, by taking the position that no application in his opinion can interfere with another ap-

plication unless the date of conception of the invention by the later applicant is prior to the filing date of the earlier applicant, and hence as he has ascertained that Fowler's date of conception was subsequent to the filing date of the other application, the statute does not require him to declare an interference, as in his opinion none exists. This contention, while ingenious, is unsound, as it confuses two separate and distinct questions which arise in the interference practice in the Patent Office. The first question which is presented, and which must be decided before an interference is declared, is whether or not there is in reality a conflict in patentable subject-matter between two co-pending applications. In determining this question the Commissioner is undoubtedly authorized to exercise his own judgment. When in the opinion of the Commissioner an interference does exist between two co-pending applications, then, and only then, does the question of priority of inventorship arise as between the two applicants. While the existence of an interference is a matter within the judgment of the Commissioner, yet the determination of priority as between the parties is not a matter which he is permitted to pass upon *ex parte*. The statute expressly requires that when in the opinion of the Commissioner one application interferes with a pending application or with an unexpired patent, he shall give notice thereof to the parties and "shall direct the primary examiner to proceed to determine the question of priority of invention."

If it is clear from the record that in the opinion of the Commissioner the application of Fowler interfered with another pending application, then it became his duty under the statute to give notice thereof to the parties and to "direct the Primary Examiner to proceed to de-

termine the question of priority of invention." The statute allows no discretion to the Commissioner to declare or not to declare an interference if in his opinion there is an interference of subject-matter between two co-pending applications or between a pending application and an unexpired patent.

The fact that the Commissioner had formed the opinion that an interference existed is shown, first, by his call upon Fowler to furnish a statement; second, by the suggesting of the claims to Fowler; third, by the language of the Commissioner's letter of November 18, 1915 (Exhibit "A," page 9); and fourth, by the fact that the Commissioner, since the granting of the mandamus herein, has declared interferences in those instances in which he previously wrote letters similar to that written to Fowler.

The Commissioner of Patents did not write to Fowler to ascertain his date of conception merely as a matter of idle curiosity. He obviously wrote Fowler because in his opinion Fowler's application disclosed the same invention which had already been adjudged patentable in the application of the other party, and he desired to himself decide the question of priority against Fowler should his dates be later than the filing date of the other party's application, and thereby avoid the delay incident to directing "the Primary Examiner to proceed to determine the question of priority of invention," as required by the statute.

Nor would the Commissioner have suggested the claims of the other party to Fowler had not Fowler's application, in the Commissioner's opinion, disclosed the subject-matter defined by the claims, and hence interfered with the other application. This action of the Commissioner was a clear admission on his part that the

two parties were claiming the same patentable invention.

The letter of the Hon. Commissioner of Patents of November 18, 1915, to the attorney for Fowler, referred to in the statement of the case, is found on page 9 of the Record. This letter states in the opening paragraph that the attention of the Commissioner has been called to the application of Fowler in which the person addressed was the attorney of record. The next sentence of the letter states that there is another application pending claiming substantially the same invention as that defined in the following claims. Then follows seven claims. The letter concludes:

> "In order to determine *whether it is necessary to declare an interference* you are requested to obtain a statement from Fowler setting forth when he conceived the invention defined in the above quoted claims, when he disclosed it to others and when he reduced to practice. This statement will not be made a part of the record and will be returned to you." (Italics ours.)

Considering the terms of this letter with the view to determine their meaning and effect it seems to us:

1st. That it admits an interference existed. The only question was whether it should be declared. The fact that the application of Fowler had been called to the personal attention of the Commissioner implies that the Primary Examiner had found that there was an interference.

2nd. The last paragraph of the letter is also in effect an admission that there was an interference and that the interference related to the subject-matter of the claims which were suggested to Fowler and that those claims were based or could be based upon Fowler's application. This is the only reasonable inference from the Commissioner's letter, because he asks when Fowler conceived the invention defined in the above quoted claims; when

he disclosed it to others and when he reduced to practice. This was in effect a declaration that the unknown applicant was claiming what is covered by the claims suggested; that Fowler disclosed the invention defined in said claims and the information requested was that which is covered by a preliminary statement in an interference.

There is no denial that the application of Fowler and the application of the unknown applicant contained interfering subject-matter at the date of the Commissioner's letter.

But whether or not there was at the date of that letter an interference in fact is immaterial, because Fowler in Exhibit C (Rec. 10), on May 22, 1915, filed an amendment in which the suggested claims were included, and stated as a part of the amendment.

> "It is thought that these claims appear in a co-pending application and they are inserted at this time with the request that if such claims do appear in a co-pending application an interference be declared."

Accompanying said amendment was Exhibit B, which is the statement requested from Fowler as to the dates of his invention as called for by the Commissioner's letter of November 18th. Of course it was within the power of the Commissioner when this amendment of Fowler's was received to reject the claims, but this he did not do. Therefore it must be assumed that the co-pending application contained patentable subject-matter and that this patentable subject-matter was claimed in identical terms by both parties.

All the conditions existed, therefore, which required the declaration of an interference under Section 4904.

If then we are correct in assuming that the Commissioner had already formed an opinion that there was an

interference in fact between the two applications, it is clear that Section 4904 was applicable.

Exhibit D (Rec. 11), being a letter from the Commissioner to the attorney returning Fowler's statement, says that Fowler's dates are several months subsequent to the filing date of the other party; that the other party's case would be passed to issue as soon as possible and when patented would be cited against Fowler and concludes with the statement, "An interference will not be declared."

That there was an interference at the date of his letter of November 18, 1915, is also manifest from the fact that he called upon Fowler to furnish an informal preliminary statement. No conceivable reason can exist for this demand unless the Commissioner had at the time his letter was written already formed an opinion that there was an interference between the two applications.

The Commissioner in his annual report to Congress and on page 39 of his brief states that since the mandamus was granted in this suit he has been compelled to declare 250 or 300 interferences which would never have been declared had his practice of ascertaining the dates of the junior applicants been permitted to continue. As the Commissioner would have proceeded in all such cases as he did in this case, but being unable to do so declared interferences, it is obvious that when he wrote Fowler for his dates he was not seeking information to guide him in forming an opinion as to the existence of an interference, but information to serve as a basis for refusing to declare an interference which he had already found to exist.

The statute, it is to be noted, is mandatory so far as the declaration of the interference is concerned. Rule 94 of the Rules of Practice in the Patent Office which was

in effect until January 1, 1916, is also positive in its provisions. It says:

> "Interferences will be declared in the following cases when all the parties claim substantially the same patentable invention: 1. Between two or more original applications containing conflicting claims," etc.

In the present case there is no doubt that these two applications contain conflicting claims. The Commissioner was not seeking information to enable him to form an opinion whether there was an interference, but he was seeking information which would enable him to avoid declaring an interference which existed. The Court of Appeals took this view, for its opinion says:

> "The Commissioner's return to the rule to show cause is based upon the ground that petitioner's date of conception is several months subsequent to the date on which the other application was filed and that this finding justifies the Commissioner in refusing to declare an interference. Concededly the Commissioner found that an interference existed between the pending applications, but to avoid what he deemed must in all probability result in fruitless litigation he refused to declare an interference."

The Commissioner's brief (page 21) says that the Court of Appeals was in error and that no such concession was made by the Commissioner or by his counsel and that it is expressly repelled by him. Of course we are not permitted to speak except from the record, but we submit that the Commissioner's answer nowhere denies that an interference exists, and that the correspondence showed that he believed that an interference did exist, and that the filing of the amendment to Fowler's application established an interference. The discretionary power of the Commissioner does not go so far as to permit him to refuse to act where his own correspondence and actions show that action was required. It is

not the business of the Commissioner to decide whether interferences are wise or otherwise, but simply to follow the law and the rules.

Interference Exists Regardless of Relative Dates of the Parties.

On page 12 of the brief for petitioner, a statement is made "if the Commissioner of Patents has knowledge that any facts exist which render it inherently impossible for two applications to interfere he has a right, without more, to find that there is no interference in fact." The foregoing statement is undoubtedly true, but is wholly inapplicable to the facts presented by the record. The facts of which the Commissioner has knowledge are as to the dates when Fowler first conceived and reduced to practice the invention, and such facts, while pertinent upon the question of priority between Fowler and the unknown applicant, have no bearing whatever upon the question whether Fowler and the unknown applicant both disclose the same patentable subject-matter.

The statement above quoted from page 12 of petitioner's brief immediately precedes the following statement:

> "He (the Commissioner) is not required to institute an interference and proceed to determine priority when he is aware of facts which show that no question of priority or actual interference can arise in the case."

The foregoing statement again confuses the two separate and distinct questions which must be determined in any interference proceeding, namely, whether an interference exists and if one does exist, which one of the parties is the prior inventor. As the facts of which the Commissioner is aware bear solely upon the question of

priority and throw no light whatever upon the existence of the conflict in subject-matter, they cannot relieve the Commissioner from his statutory duty to refer the interference which he has already found to exist to the Primary Examiner to have him determine the question of priority in accordance with the statute and Patent Office rules of practice promulgated in pursuance thereof.

Interference is a question of fact; it exists, or it does not exist. If it exists then priority must be determined in the way pointed out by the statute and the rules.

The brief for petitioner contends that the Court of Appeals confuses the meaning of the word interference as used in the statute and in the rules. As we understand the opinion it clearly recognizes the right of the Commissioner to form an opinion as to whether an interference exists and as clearly declares that when the Commissioner has formed and expressed such an opinion he is obliged to declare it.

The answer to the petition for mandamus and the petition's brief in substance amount to nothing more than an argument against the positive mandate of the statute and the rules, based upon the Commissioner's views as to the propriety of the legislation.

The letter of the Commissioner to Fowler (Exhibit "A," Rec., p. 9) says:

> "There is another application pending *claiming* substantially the same invention as that defined in the following claims." (Italics ours.)

Then follow seven claims.

Fowler immediately filed an amendment (Exhibit "C," Rec., p. 10), incorporating those claims in his application and requested an interference.

The Commissioner having thus formed and expressed an opinion that the pending application of another applicant was "claiming substantially the same invention

as that defined in the following (suggested) claims" which were then made by Fowler, the provisions of the statute and of the rules applied and nothing remained for the Commissioner to do but to "direct the Primary Examiner to proceed to determine the question of priority of invention."

This he refused to do, and therefore the court clearly recognizing the distinction between this case and the Trussed Concrete Steel Company case (42 App. D. C., 179), ordered the Commissioner to follow the statute.

With all due respect we submit the contention of the petitioner's brief that the Commissioner was seeking to obtain from Fowler the information as to the date of his conception of his invention for the express purpose of "forming an opinion" as to whether any interference existed is contradicted by his own acts.

The *fact* as to whether an interference existed was the only thing to be determined by him. The question as to which of the parties was entitled to an award of priority as to that invention could only be determined by the institution of an interference and due proceedings therein. That determination is not conditioned by considerations of alleged expediency as advanced by the petitioner.

In answer to the suggestions of the Commissioner (pp. 18-19) forming, it is contended, exceptions under the statute and the rules we reply:

(*a*) There is no claim here that Fowler had abandoned his invention. On the contrary he made the interfering claims at the same time that he demanded the interference.

(*b*) There is no claim that Fowler was debarred from obtaining a patent in this country because of an earlier filed foreign application.

(*c*) The Commissioner had no knowledge from Fow-

ler's statement that no interference in fact existed or that the senior applicant was the prior inventor, for the Commissioner had himself declared that an interference in fact existed and he sought to avoid its declaration by an *ex parte* determination that Fowler could not prevail whereas the Commissioner did not and could not *know* that fact.

Nor does the practice of the Patent Office with respect to the declaration of interferences between an application and an unexpired patent affect the present inquiry.

The reason for the rule requiring an applicant to file an antedating affidavit as a prerequisite to the declaration of an interference between his application and an unexpired patent is that such patent until overcome by an antedating affidavit is a bar to the grant of any patent to the applicant. Such patent is a public record. Its disclosure and its history are open to the applicant. He may determine its efficacy as a bar and its sufficiency as to disclosure by a comparison with his own application. He need leave nothing to the *ex parte* consideration of the Patent Office, but may contest every point with full knowledge of the facts. Therefore unless he can overcome the patent as a bar he is not entitled to an interference.

But the case of two pending applications is obviously different. Here the junior applicant knows nothing concerning the facts. He is not permitted to know who his opponent is, to see his application or to know when it was filed. He must accept the mere dictum of the Patent Office as to its existence, contents and legal effect.

In the case of a patent the Office has no power to alter, modify, restrict or cancel. In the case of a pending application the Office may require the applicant to modify his claims and if he does not may reject them.

Fowler Legally Entitled to Have Interference Declared.

Petitioner contends that even if the Court of Appeals was right in holding that the Commissioner had found an interference existed it should have refused the writ because it required a vain thing.

This argument is based on the assumption that when Fowler disclosed his date of invention the Commissioner might institute a comparison of such dates with the mere chronology of the unknown application and say that no interference could exist. He admits that in such case the senior applicant's application would go through the Patent Office in the regular course of procedure in an *ex parte proceeding,* and patent would issue to him. This is precisely what the Commissioner told Fowler in the letter (Exhibit "D," Rec., p. 11), and he further added that "the pending application when patented will be cited as a reference against such claims in Fowler's application as it may be found to anticipate."

It would be difficult to conceive of a more arbitrary or high-handed proceeding in the face of a statute and the Commissioner's own rules than this.

The only answer possible to the statement on pages 42-43 of the brief for petitioner, is that our position was misunderstood. We are not obliged to give reasons for asking in our client's behalf that the statute, the rules and the practice of the Patent Office be followed by the Commissioner. But lest we be further misunderstood we say now that we desire that an interference be declared in order that we may know what we have to meet; that we may have an opportunity to contest the question of priority and that the issuance of a patent to an opponent with interfering claims in an *ex parte* proceeding may be prevented.

Further to prevent misunderstanding we point out that the Commissioner had no power to deny applicant Fowler *any* right which is given him by the statute and the rules of the Patent Office.

If the right of opposition given by Rule 122 is a substantial right following and dependent upon the declaration of an interference, then Fowler has the right to have the interference declared.

The declaration of interference confers certain rights upon each of the parties, and the procedure provided in Rule 122 affords an opportunity for arranging the parties in proper order according to the true and effective dates of their respective applications whereby the burden of proof is fixed and the presumption of priority attaches. The motions allowed by this rule are not necessarily motions to destroy an interference, but they are provided in order to secure the proper alignment of the parties and to determine the order and burden of proof. In short, to prevent the issue of patents to the wrong person.

As a result of these motions it may appear—and often does appear—that the party who was the first to file was not the first to disclose the invention covered by the claims, or disclosed it in inoperative form, and therefore it may and frequently does turn out that the junior party, whose dates of conception are later than the other party's filing date nevertheless prevails because the application of the senior party as originally filed may not disclose the invention, or may disclose it in inoperative form. It is quite true that a party whose dates of conception are subsequent to his opponent's filing date has the burden of showing that his opponent is not entitled to his filing date, but this burden can be and often is successfully borne and the junior party prevails in the contest.

Even assuming that the Commissioner after careful consideration decides that the earlier filed application discloses the invention so as to entitle such earlier applicant to his original filing date, he is not warranted in refusing to declare an interference on such *ex parte* examination because under the rules of practice that is an *inter partes* question.

The fact that motions to shift the burden of proof often prevail is a sufficient answer to the present claim of the Commissioner that he is authorized to substitute his judgment for the procedure provided by his own rules.

The petitioner contends that the motions provided for by Rule 122 are a mere incident of the procedure *after* the Commissioner shall have found an interference in fact, and after the technical declaration of an interference. It is true such motions cannot be made *before* the interference is formally declared and it is also true that these motions are provided for by rule and not by statute.

But it does not follow that the Commissioner may refuse to follow the statute and thus cut off the right of the applicant to avail himself of the provisions of the rule.

The fact is that the statute and the rules taken together determine the rights of the parties and the procedure to be followed.

The power to make rules of regulations governing procedure in the Patent Office is conferred by Section 483 of the Revised Statutes, which reads as follows:

> "Sec. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

In pursuance of this provision the Commissioner of Patents from time to time and with the approval of the Secretary of the Interior has made rules or regulations, and from time to time with like approval has amended the same, the last amendment having been made during the current year.

These rules or regulations have the force and effect of law and are binding as well upon the Commissioner as upon applicants. Such rules or regulations can only be repealed or modified by the same authority that promulgated them, namely, by the Commissioner of Patents with the approval of the Secretary of the Interior.

The right of an applicant to have an interference declared between the claims of his pending application and a pending application of another party claiming the same or substantially the same patentable subject-matter has never been questioned by any former Commissioner of Patents nor by the present Commissioner until within a very recent period.

Respondent invokes the settled practice of the Patent Office in support of its position. Even if the statute and the rules were ambiguous (which is not the fact), the long-established interpretation of them by previous Commissioner should not be disturbed.

In *Allen* v. *U. S., ex rel. Lowry*, 22 App. D. C., 8, the Court of Appeals, District of Columbia, speaking through Mr. Justice Duell, said:

> "While we recognize the rule as laid down in *Houghton* v. *Payne*, 194 U. S. 88, 48 L. Ed. 888, 24 Sup. Ct. Rep. 590, and in other decisions of the Supreme Court, that, if a practice is contrary to law, it is not made lawful by the practice of a department for a long period of time, yet due regard should be given to a practice which admittedly has prevailed for more than twenty-five years in pro-

ceedings of a judicial character, even should there be a reasonable doubt in the mind of the court as to the proper construction to be placed upon a statute. The Supreme Court said, in *Bate Refrigerating Co.* v. *Sulzberger,* 157 U. S. 1, 39 L. Ed. 601, 15 Sup. Ct. Rep. 508:

> "'If a statute be not so explicit as to preclude construction, if, upon applying to it the established rules of interpretation; if, looking at it in the light of previous legislation on the subject; if there be reasonable ground for adopting one of two constructions;—this court, without departing from sound principle, may well adopt that construction which is in harmony with the settled practice of the executive branch of the government.'"

Prejudicial Results of Interference Practice at Issue.

In order to determine the precise meaning of the words of the statute and the attempted justification thereunder of the practice followed in this case it may be well to remind the court that the interference practice has not at all times been uniform. Interferences were and still are frequently declared between applications which do not contain identical claims. At one period it was not the practice to suggest claims contained in one party's application to another applicant. At a later period and at the present time this is done. During the former period claims were seldom identical in terms. During the later period and at different periods in the history of the Patent Office identical claims were present because of suggestion by the Office to each of the parties, but during the whole period it has been the practice of the Office to define the subject-matter of the interference in a number of distinct issues to which the claims of the parties must substantially correspond. This practice of course is in harmony with

the statute. It permits the Commissioner of Patents to declare interferences between claims covering substantially the same patentable subject-matter although not in identical terms. It also permits or at least it does not forbid the Commissioner to suggest claims to the parties and thereby bring about identity of language between the claims of the parties, some of which may be adopted as the issues of the interference. In fact in some cases the Examiner in effect defines the invention for both parties by suggesting claims which become the issues of the interference. A moment's reflection will show that at all times therefore in the history of the Office there was room for the exercise of the Commissioner's discretion and the formation of an opinion as to whether or not an interference existed.

But this stage was passed in this case when the Commissioner suggested to Fowler claims from another application which Fowler adopted and upon which he demanded an interference. There was no room for opinion, inquiry, investigation or the exercise of discretion from that time on. Under that state of affairs the statute became immediately applicable and its language mandatory. The Commissioner had formed the opinion that an interference existed; the filing of the identical claims by Fowler made that interference an actual fact, and the only thing left to be done was to follow the statute and formally declare the interference.

The statute is to be construed with reference not alone to the business of the Office but with reference to the rights of applicants before the Office. It is not denied that the Patent Office is a great business institution; so is the Post Office; so are the courts, the Internal Revenue Department, and the various other branches and departments of the Government. The

function of the Patent Office is to examine applications for patents and to grant patents to the original and first inventor. It was never intended that the Patent Office should grant patents to anybody else except the original and first inventor. Neither the Federal Constitution nor the statutes made in pursuance thereof authorizes the grant of patents to anybody but the first inventor. The work of the Patent Office therefore divides into two general classes:

1st. To examine pending applications to ascertain whether the thing claimed is patentable; and,

2nd. To determine as between two parties claiming the same invention which one is the prior inventor and entitled to the patent.

It is not within the province of the Commissioner of Patents to judge without a hearing that one applicant is entitled to a patent rather than another. The Commissioner can only determine the question of priority by the medium of an interference.

The 67,000 applications referred to in the answer to the petition for mandamus as constituting the annual business of the Office are furnished to the Office for examination by inventors of the country who are represented by attorneys and solicitors practicing before the Patent Office. It may be assumed that these inventors and the attorneys are as well informed concerning their own rights and as zealous to protect them as the Commissioner of Patents is to expedite the business of his office. It is said that a large number of these applications are found to contain conflicting claims and that it is of the highest public interest that the prosecution of all applications be brought to a speedy conclusion so that patents may be issued on those which are found to be allowable. Granting all this, what has it to do with the question whether a

patent shall be granted to A for the invention of B? The speediest way to bring the prosecution of applications to a conclusion would be to issue patents in accordance with the dates of their application; in short, to abolish the interference practice, and this reform has been suggested by a great many well informed patent lawyers. But it is not the law. The law as it stands is that patents shall be granted to the original and first inventor, and the interference system is a fixed part of the law, and cannot be ignored either by the Patent Office or by the lawyers.

It is further said in the answer that only in a small percentage of cases does a later applicant succeed in establishing that he is the first inventor, where the dates are a year apart. Surely that is no reason why the small percentage of later applicants should be denied their rights.

It is pointed out that the business of the Patent Office ran behind during three years at the rate of four thousand applications a year. This might very well be brought to the attention of Congress, but we fail to see where it has any application to the question before this court.

It is also pointed out by the Commissioner that the expense and delay to applicants caused by interferences has occasioned injury and ground for well founded complaint. We have nothing to do with the management of the Patent Office and cannot see that this fact has any bearing upon the question at issue. It is further pointed out that successive interferences may be brought about and that the value of his invention may be lost to the rightful owner. It may be suggested in answer that the failure to declare an interference where one exists may produce a like result. To digress a moment, it may be

pointed out that there is no requirement that the Commissioner of Patents shall suggest claims to applicants. This practice has grown up until now it may be said that in a vast majority of the cases interferences are brought about by the Patent Office rather than by the applicants themselves. It is not intended here to criticise this practice, which was not established under the present Commissioner, but it is only mentioned to show that it is the practice of the Office and not the actions of the applicants which bring about the majority of the interferences declared. With the accumulation of business in the Office we have nothing to do, but we may call the attention of the court to the fact which we shall illustrate later that many of these old applications are kept in the Patent Office purposely to catch or entrap later applicants who are developing the arts.

The brief for petitioner outlines the organized scheme of the Commissioner to accelerate the progress of applications through the Office. The present Commissioner has inaugurated many salutary reforms, but in that particular part of the general scheme which is here in question we think he had exceeded his power and is acting in direct conflict with the statute and with the rules of practice of the Patent Office.

The statute says that when an interference exists the Commissioner shall so declare and then points out what he shall do, namely, direct the Primary Examiner to proceed to determine the question of priority of invention. The mode of determining this question is pointed out in the rules by which applicants and the Commissioner are alike bound.

Statute Gives the Right of Opposition.

The brief for petitioner says it does not. Whether the statute gives a right of opposition in the sense in which the expression is used in the brief is perhaps immaterial, but in the broad sense there is no question that it does give the right of opposition. The statute says that when an interference exists it shall be declared and that the Primary Examiner shall then proceed to determine the question of priority. Clearly, then, there is a fundamental and basic right of opposition on the part of any applicant, whether junior or senior, to prevent the wrongful grant of a patent to his opponent. The rules of practice not only provide for this by the declaration of an interference and point out the mode in which it shall be conducted, but they go farther and provide for certain proceedings which are strictly in the nature of opposition. Thus the rules provide that any party to an interference may within a certain limit of time bring a motion to dissolve and this may be on various grounds, *e. g.*, that the opponent has no right to make the claim; that the issue is unpatentable; that the issues do not mean the same thing when applied to the cases of the two parties, or that there has been irregularity in declaring the interference. Aside from this, motions are made which seek to shift the burden of proof and these various motions are frequently sustained and interferences are dissolved and patents refused as a result thereof.

It requires no construction of the statute to show that the right of opposition exists; that it is a valuable right; that it is recognized by the Rules of Practice and has heretofore been allowed and it requires no argument to show that the practice here complained of would utterly destroy that right.

The right of opposition is not only expressly given by Rule 122, heretofore considered, but by Rule 124, which reads in part as follows:

> "Where, on motion for dissolution, the law examiner renders an adverse decision upon the merits of a party's case, as when he holds that the issue is not patentable or that a party has no right to make a claim, he shall fix a limit of appeal not less than twenty days from the date of his decision. Appeal lies to the examiners in chief in the first instance and will be heard *inter partes.*"

Alleged Injury to Senior Parties.

In petitioner's brief the right of the senior party to obtain his patent without opposition is weighed against the right of the junior party to oppose, and illustrations are given as to what might happen because of following the plain language of the statute and of the Rules of Practice. If illustrations are in order perhaps we may be able to give one which will illustrate a class of actual cases within the knowledge of the Commissioner of Patents and of every practitioner before the Office.

An application is filed for a patent by a professional inventor or by some one who is following an art with a view to speculation containing indefinite description and nebulous claims. Under the rules of the Office such an application may by amendment be kept in the Office for a number of years. Several years after the filing of such application another applicant who has developed a machine, improved a process, or advanced an art, comes into the Office with a clean-cut, properly-drawn application covering a distinct improvement in the art. Under the present practice the Patent Office, comparing the two applications, discovers that it is possible to read upon or out of the earlier-filed application the invention which

the later applicant seeks to patent, and thereupon it suggests to the earlier applicant the claims of the later. Under the practice here in question the Commissioner would inquire of the later applicant when he conceived his invention and would probably learn that the later applicant could not allege a date of conception earlier than the filed application. Thereupon he would refuse to declare an interference and the senior applicant would have handed to him claims which he never thought of making for an invention which he did not conceive and which could only be spelled out of his application by the aid of the more precise and specific disclosure of the second applicant.

This is no fanciful case because it has occurred many times in the Patent Office.

Now, whose interest would be sacrificed in such case if the present practice had not been adopted? Clearly not that of the first applicant. If he was in a hurry he could have had his patent long before, but he does not wish it to come out. He has set his eel trap in the Patent Office and he catches many eels as they come down the stream.

What Inquiry Should Be Made?

In petitioner's brief it is asserted that if the later applicant does not claim a date of invention prior to the date upon which the earlier application was filed, there is no question of priority and therefore no ground for instituting the interference, and reference is made to the practice with relation to granted patents. Let us see whether this argument is sound. In arranging the parties to an interference it is the practice to consider the dates of the applications, the earlier to file being considered the senior party and the junior party having the burden of proof on the question of priority. It fre-

quently happens that an interference is declared, the parties being thus arranged in the order of their dates of application, and it turns out that the senior applicant did not disclose the invention in question in his application as originally filed. It often turns out, also, that the junior applicant, when the files of his opponent's case are opened for inspection and the matter is thoroughly understood, is able to show that he (the junior applicant) had a still earlier filed application which disclosed the subject-matter, and motion is made to shift the burden of proof. Again, it sometimes happens that the date of application accorded the senior applicant is not his true date under the law.

From the report of *Christensen* v. *Noyes*, 15 App. D. C., 94, it appears that Noyes filed an application in the Patent Office May 13, 1895, which was allowed November 26, 1896, became forfeited for nonpayment of fee and was not renewed till June 28, 1897.

Christensen filed his application April 30, 1896. The Commissioner held that Noyes was entitled to consider May 13, 1895, the filing date of his forfeited case, as his effective date of application, but such holding was reversed by the court on the ground that Noyes' effective date was the date of the filing of the renewed application of June 28, 1897, and not that of his first forfeited application.

We of course do not know what the facts are in the case at bar, or by what course of reasoning the Commissioner has arrived at the date of application of the unnamed applicant, but it is at least conceivable that the Commissioner has given the undisclosed interfering applicant the benefit of a filing date to which in law he is not entitled, just as his predecessor did in the Noyes case. On the declaration of an interference such error

could be corrected and justice done and the rights of the petitioner preserved.

It also not infrequently occurs that on motions to dissolve interferences it develops that one of the parties discloses an inoperative structure in his application and hence, no matter how long he filed his application before that of his opponent, he is not entitled to be awarded priority of invention. Numerous published decisions disclose such a situation. A recent instance is found in *Carlin* v. *Goldberg*, 236 O. G., 1222. It may be that the other application referred to by the Commissioner in his letters to Fowler discloses an inoperative structure, and hence Fowler may for that reason be entitled to an award of priority, notwithstanding his later date of conception.

All of these questions may be raised on motions to dissolve and to shift the burden of proof under the Rules as applied before the adoption of the practice complained of. And it often happens that after an interference was formally declared it was found that the position of the parties must be reversed; or that the interference must be dissolved because the subject-matter of the interference was unpatentable; or because there was no interference in fact; or because the Examiner had made a mistake in deciding that the issues meant the same thing when applied to the cases of two parties. All of these safeguards against the issuance of a patent to the wrong party are utterly swept aside by the present practice.

It was stated by petition that over three hundred cases were disposed of during one year under the practice in question. In our view this simply shows that in three hundred instances the Commissioner has exceeded his authority and violated the rules of the Office. No mention was made, however, of the number of interfer-

ences that were disposed of after declaration and without the taking of proof in one of the ways pointed out above. In the annual report of the Commissioner to Congress he states that motions for dissolution of 241 interferences were heard during 1916, of which 57 were granted entirely and 44 in part and that ten other interferences were dissolved because the subjected matter was found unpatentable to anyone. A large number of interferences are thus disposed of upon motion by the aid of the parties themselves and with due regard to the rights of both applicants. Furthermore, a large number of these interferences are disposed of on the initiative of the junior applicant, and the issuance of many invalid patents is prevented by turning the search-light of investigation upon the rights of the senior applicant while in this stage. We do not mean to imply, of course, that the Commissioner does not inquire into the question of interference in fact, nor into the various other questions suggested before demanding a statement from a junior applicant under his present practice. What we do say is, that this investigation has always been made—perhaps not with the same care as under the present Commissioner—but the law has always required that the Commissioner should investigate and that he should decide whether an interference existed, and as to the alignment of the parties to the interference, thereby fixing the burden of proof, etc., and that notwithstanding such examination and determination by the Commissioner, it has turned out, in innumerable cases—and still does occur—that the Office was mistaken in its determination and is obliged to correct the mistake by dissolving interferences or rearranging the parties.

There are, as we have previously shown, abundant reasons for declaring an interference even if the nomi-

nal dates of the applications be far apart. The point which petitioner's brief overlooks is that neither the relative dates of the applications nor the fact that the junior party admits a date of conception later than the nominal date of an unknown applicant is controlling. The Commissioner substitutes his own judgment as to the expediency of declaring an interference for an *inter partes* inquiry as to the matter. The law gives the parties a right to be heard. The new practice denies that right. It is the purpose of this proceeding to determine whether or not the Commissioner has that power.

In short, it is not the business of the Commissioner to sit in judgment as to whether it is wise or otherwise to declare an interference.

Petitioner urges that there is here no question of overlapping dates, and that it was the deliberately formed opinion of the Commissioner that no question of insufficient disclosure arises as to the earlier dated application. But that is quite beside the point. The law and the Rules of Practice provide that the parties shall have an opportunity to raise these questions. To refuse to declare an interference is to deny that opportunity. Call it opposition or what you will, the plain right exists.

We state here most emphatically and from long personal experience that the number of instances in which the *ex parte* action of the Office in aligning parties and in determining the metes and bounds of issues has been corrected justifies us in the contention that this right of applicant's is substantial, that the judgment of the Office is often at fault and that the errors of first decision require correction and are often corrected by the officials of the Office and by the court as a result of the proceedings provided by the statute and the Rules.

Patent Office Rules of Practice Relative to Interferences.

It is argued by petitioner that Rule 93 justifies the action of the Commissioner. This is founded on the wording of the rule defining an interference as a proceeding instituted for the purpose of determining the question of priority, but this definition cannot be given such a narrow or illiberal interpretation as to exclude the operation of the other rules relating to the conduct of interferences, nor to exclude from consideration all other questions save the sole question of priority. Indeed, the question of priority involves many considerations, and the purpose of the statute and of the Rules is to make certain that the Patent Office shall grant patents only to the original and first inventor. The whole scheme and purpose of the interference legislation is to this end that patents shall not be improvidently granted and the public vexed by unlawful claims. The right of a junior applicant to contest an interference is as important in one aspect as in another, and any denial of that right vitiates the entire scheme and purpose of the law.

Of course Rule 93, and every other Rule of Practice, must conform to the statute, and if out of harmony therewith the rule and not the statute must yield. We see no conflict. The rule was meant to carry out the plain meaning and intent of the statute and must be so construed.

Has Injury or Damage Been Shown?

Petitioner has suggested that respondent has shown no damage and therefore is not entitled to the writ. It seems to us that but little argument is required to show that the right to obtain a patent, or the right to prevent

another from unlawfully obtaining a patent, is substantial, and its deprivation an injury.

If petitioner has a right to the declaration of an interference he is not to be denied because he cannot state in dollars and cents what his damage would be. It would be as idle to inquire as to that matter as it would to attempt to assign a monetary value to the right to vote or obtain a marriage license.

See:

U. S., ex rel. Rodriguez, v. *Bowyer*, 25 App., 121.

Roberts v. *United States*, 176 U. S., 221-231.

Petitioner suggests here that Fowler will not be damaged even if the unknown applicant be given a patent without a declaration of interference, and points out that Fowler may contest the validity of such patent in the courts. If he is entitled to contest it here, why is not that right a substantial and valuable one and the denial of that right a legal injury or damage? A moment's reflection will show that the right to contest the question of priority is of greater value than the right to defend a suit for infringement. It does not follow that any suit for infringement will ever be brought against Fowler or his assignee or his or their vendees. It is quite sufficient to notify a railroad company of the ownership of a patent relating to cars to prevent sales of the improvement by others. The right of the junior applicant may be entirely destroyed by the improvident issue of a patent covering his invention either broadly or narrowly, and he has no remedy because suit for infringement is not brought for the simple reason that he does not get a chance to sell his goods.

It is also suggested that respondent will not be damaged because he has a right to demand an interference with the patent to be granted to the unknown applicant. This is not a fair argument because he cannot

contest on equally favorable conditions. The burden is greater, for the issuance of the patent carries with it the presumption of validity and priority.

Petitioner's brief says that since Fowler has alleged a date of invention subsequent to the date upon which the unknown application was filed, there would be no basis for a holding that he was the first inventor. Of course this is wrong. Very frequently it happens that a junior applicant alleges a date of conception later than the nominal or claimed date of the other party and still wins the interference, and this might be true in a case under Section 4918. It is certainly true while the applications are still pending in the Patent Office.

The Long Recognized Construction of Section 4904 is in Harmony with Other Sections of the Patent Statutes.

The interpretation which has always been placed upon Section 4904, and which the present Commissioner seeks to have changed, is in harmony with the spirit and intent of the entire Patent Act. The underlying principle of the United States patent law is that patents shall only be granted to those who have complied with certain conditions precedent, and the Commissioner of Patents is empowered to investigate each application to determine whether or not such conditions have been complied with. The conditions upon which a person may obtain a patent are set forth in Sec. 4886 U. S. Rev. Stat., which reads as follows:

> "Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his in-

> vention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. . . ."

In order that the Commissioner of Patents may investigate each application to determine whether the applicant is entitled to a patent by his compliance with all of the conditions recited in the above-quoted section of the statute, a large examining corps is provided whose duty it is to make searches through prior United States and foreign patents and publications. This is covered by Sec. 4983, which reads as follows:

> "On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

In order to facilitate the investigation as to the novelty of the invention covered by each application a scientific library is provided. A classification division exists to so arrange and classify patents and publications as to render them most conveniently accessible.

As the question whether or not the invention covered by an application has been in public use or on sale more than two years prior to the filing of the application cannot be ascertained by an examination of prior patents and publications, a fund is provided to enable the Commissioner to conduct the necessary investigation. Sec. 4886.

Inasmuch as only one person can be the original and first inventor of an invention, the Commissioner of Pat-

ents is given the necessary authority by Sec. 4904 to institute interference proceedings to determine which of two or more applicants all claiming the same invention is in reality entitled to the patent covering the same by reason of his priority over his opponent.

For many years the Patent Office has, under the authority of Sec. 4904, utilized interference proceedings as a means to not only determine which of two or more interfering parties is entitled to a patent, but to determine whether either them should be granted a patent. This has been accomplished by means of motions brought by the parties after the declaration of an interference. This practice is not only in the interest of the applicants for patents, but also in the interest of the public, for as is frequently the case, interference proceedings develop the existence of statutory bars against the granting of patents to either of the contestants in interference and the rights of the public are thereby protected.

As previously stated, the Commissioner in his report of January 31, 1917, to Congress stated that of 241 motions for dissolution of interferences which were heard and disposed of, 111 were granted either entirely or in part, and that out of thirteen interferences in which statutory bars were discovered by the Examiner during the pendency of the interference, ten of them were dissolved.

The long-established practice in declaring interferences which the Commissioner sought to curtail therefore affords the Commissioner an otherwise unavailable avenue for investigation of the rights of applicants to patent monopolies for their claimed inventions. The Commissioner in his said report and in his brief herein laments the fact that the granting of the mandamus in this case necessitated the declaration of two hundred fifty to three hundred interferences which he could other-

wise have avoided declaring. In other words, in all of such interferences the Commissioner would have preferred to grant patents to the senior parties rather than to set in motion, through the declaration of interferences, lines of investigation which in a large number of such interferences undoubtedly lead to the development of statutory bars against one or both parties to the granting of a monopoly for the inventions involved. Had interferences not been declared in such two hundred fifty or three hundred instances, patents would have been granted to the senior parties which in many instances belonged legally to the junior parties, and in many instances rights of the public would have been prejudiced by the granting of monopolies for inventions which already belonged to the public.

The endeavors of the present Commissioner of Patents to expedite the work in his office by [illegible] as promptly as practicable after the filing of the applications therefor, is most commendable. There is, however, a more important consideration than that of expediting the granting of patents, and that is the granting of valid patents. In a large proportion of suits instituted for patent infringements, the patents in suit are held to be invalid and usually in view of prior patents or publications which were not cited in the Patent Office during the prosecution of the applications, or in view of statutory bars unknown to the Patent Office. The declaration of interferences, as conclusively proved by the report of the Commissioner, in many instances, leads to the establishment of statutory bars which were unknown to the Examiners during the *ex parte* consideration of the applications. If no interferences at all were declared it would necessarily follow that the number of invalid patents which would be granted would be greatly increased, and consequently the restriction in

the declaration of interferences, which the present Commissioner seeks to bring about by the practice in question, necessarily leads to the granting of many invalid patents, which could be avoided by following the long-established interference practice.

The granting of invalid patents is detrimental not only to the public in general, but to those industries which involve the manufacture and sale of devices dominated by such illegal monopolies. Invalid patents deprive the public of rights legally belonging to it and afford means of embarrassing manufacturers and others engaged in the industrial arts.

A comparison of relative dates of invention of two parties claiming the same invention is but one element to be considered in the question of which party is entitled to a patent. The senior party may not be entitled to his filing date as to the subject matter in controversy (*American Lava Co.* v. *Steward*, 215 U. S., 161). (3) The inventions of the two parties may be so different that they are not the same even though capable of being described by the same claims (*Westinghouse* v. *Boyden*, 170 U. S., 537). (4) Statutory bars may exist to the granting of a patent to either party.

In all of such instances the practice of the Commissioner in question would result in the granting of invalid patents to the senior parties.

Mandamus a Proper Remedy.

This does not seem to be controverted by counsel for petitioner, the only suggestion being as already noted, that the writ would in the opinion of the Commissioner be ineffective.

Respondent recognizes the limitations upon the power

of courts to control the actions of an executive or judicial officer by mandamus. Neither discretion, when discretion is permitted, nor judicial power, when such power is conferred, can be so controlled. But where no discretion is permitted or where the exercise of judicial power is sought to be avoided or evaded, mandamus is the proper remedy.

The courts may not compel the Commissioner to declare an interference if none exists, nor say how he shall decide an interference which has been declared, but they have power to compel the declaration of an interference when interference admittedly exists, and to compel the Commissioner to "direct the Primary Examiner to proceed to a determination of the question of priority of invention." In short, to take jurisdiction. We simply asked that the Commissioner be required to take jurisdiction and then to proceed according to law and the rules of practice.

See:

Commissioner of Patents v. *Whitely*, 4 Wall., 522.
Ex parte Parker, 120 U. S., 737.
Hudson v. *Parker*, 156 U. S., 277.
United States ex rel. Todd v. *Gongwer*, 37 App. D. C., 555.

It is respectfully submitted that the writ of mandamus was properly granted and that the decree of the Court of Appeals should be affirmed.

MELVILLE CHURCH,
GEO. L. WILKINSON,
Counsel for Respondent.

April, 1917.

CASES ADJUDGED

IN THE

SUPREME COURT OF THE UNITED STATES

AT

OCTOBER TERM, 1916.

EWING, COMMISSIONER OF PATENTS, *v.* UNITED STATES EX REL. FOWLER CAR COMPANY.

CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

No. 721. Argued April 17, 1917.—Decided May 7, 1917.

When an applicant for a patent admits that the invention shown in his application was made at a date subsequent to the date upon which another application for the same invention was filed, and by amendment of his application adopts the prior applicant's claims, he thereby concedes the priority of the other's invention, its utility and the sufficiency of the claims.

In such a case the Commissioner of Patents can not be required by mandamus to declare an interference.

Under Rev. Stats., § 4904, the duty of the Commissioner to declare an interference arises only when, in the exercise of his judgment upon the facts presented, he is of opinion that a senior application will be interfered with by a junior one; the mere fact that the junior application covers the same ground or that the junior applicant asserts an interference is not enough to require the Commissioner to act.

The judicial remedy for determining priority of invention is by suit in equity between the parties, not by mandamus against the Commissioner in an attempt to control the administrative discretion conferred upon him by Rev. Stats., § 4904.

45 App. D. C. 185, reversed.

THIS writ is directed to a judgment of the Court of Appeals of the District of Columbia which affirmed a judgment of the Supreme Court of the District of Columbia in mandamus commanding the Commissioner of Patents "to declare or direct to be declared an interference between the application of William E. Fowler, Sr., filed May 22, 1915, for Improvements in Car Floor Construction, and the application for a similar invention" of an unnamed applicant "pursuant to the statute and rules in such cases made and provided."

The judgment was rendered upon motion of petitioner's attorney upon the petition, rule to show cause and answer. It was affirmed by the Court of Appeals.

As the Fowler Car Company and Ewing, Commissioner of Patents, were petitioner and respondent, respectively, in the court below, we shall so designate them here.

The facts as stated by the petition are as follows:

William E. Fowler, Sr., was the first and original inventor of certain new and useful improvements in car floor construction.

On May 22, 1915, he applied for a patent in the usual form and manner and his application was accepted and became known and designated as application serial No. 29794.

On May 19, 1915, he duly assigned his right, title and interest in the invention to the Fowler Car Company, which company appointed Charles C. Linthicum its attorney.

On November 18, 1915, the Commissioner of Patents wrote to Linthicum stating that "there is another application pending, claiming substantially the same invention as that defined" in certain of the claims which were set out. He further stated: "In order to determine whether it is necessary to declare an interference you are requested to obtain a statement from Fowler setting forth when he conceived the invention defined in the above quoted claims, when he disclosed it to others, and when he re-

duced it to practice. This statement will not be made a part of the record and will be returned to you."

Fowler replied that he had conceived the subject-matter of the claim quoted in the Commissioner's letter on or about April 16, 1915, disclosed the same to others and made drawings on or about the same date but had not reduced the same to practice by constructing any full-sized devices.

On November 23, 1915, Linthicum filed an amendment to Fowler's application in which all of the claims suggested by the Commissioner were inserted. Of these claims Linthicum said: "It is thought that these claims appear in a co-pending application and they are inserted at this time with the request that, if such claims do appear in a co-pending application an interference be declared."

To this communication the Commissioner replied as follows:

"Sir: Enclosed please find the statement of William E. Fowler, Sr., made in response to the request in my letter of November 18, 1915.

"The dates of invention claimed by Fowler are subsequent by several months to the filing date of the application of the other party. The other party's case will be passed to issue as soon as possible and when patented will be cited as a reference against such claims in Fowler's application as it may be found to anticipate. An interference will not be declared."

Section 483, Rev. Stats., provides: "The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent-Office."

Pursuant to this authority regulations known as "Rules of Practice in the United States Patent Office" have been established by the Commissioner by and with the approval of the Secretary of the Interior and now govern

the declaration of interferences between pending conflicting applications and have the force and effect of law, binding as well upon the Commissioner as upon the applicant for patents.

It is further alleged that it clearly appears from the correspondence recited and under the statute and rules that an interference exists between the Fowler application and that of the applicant unknown to petitioner, which applications disclose and claim the same patentable invention and it is the duty of the Commissioner to declare an interference and to call upon each applicant for the sworn preliminary statement required by Rule 110.

That if the unknown applicant receive a patent and thereafter petitioner's (Fowler's) application is put in interference with it and petitioner afterwards be awarded priority over the unknown applicant and receive a patent, in order to get rid of the menace of the outstanding patent to such unknown applicant petitioner will have to file a bill in equity under the provisions of § 4918, Rev. Stats., for the cancellation of such patent or the owner of the outstanding patent may file such bill against petitioner, all of which possibility of litigation may be prevented if the Commissioner be required to discharge his plain duty under the statute and rules and declare an interference when the rights of both parties are in the application stage and before either party receives a patent. That conduct of the Commissioner is a matter of public concern and for over a quarter of a century his predecessors have, without exception, regarded the interference rules as imposing upon them the legal duty of declaring an interference under the circumstances detailed. And petitioner is advised and believes that unless the Commissioner be restrained a patent in due course will be issued to the unknown applicant and petitioner is without remedy unless the court by writ of mandamus shall interpose in its behalf.

Mandamus was prayed.

A rule to show cause was issued and the Commissioner's action stayed until the determination of the cause.

The Commissioner in his answer admitted the filing of the applications as alleged and the correspondence with Linthicum, but denied the legal conclusion drawn by petitioner therefrom. He alleged that an interference as defined by the rules of the patent office is a proceeding for the purpose of determining the question of priority of invention and that when an applicant informs the office that the invention shown in his application was made at a date which was subsequent to the date upon which another application for the same invention was filed, the statute does not require that an interference be established between his application and the prior application. That in asking the later applicant to inform the office of the date of its invention the Commissioner was only asking for information upon which he might form, as required by § 4904, Rev. Stats., an opinion whether a situation existed where the statute required that the later application should be put into interference with the earlier application, and that the rules do not require or contemplate a declaration of interference where it is known that the later applicant made his invention subsequently to the filing of the earlier application; in other words, they do not contemplate the declaration of an interference except where there is a possible conflict in the dates of invention.

The answer further denied that petitioner had shown injury or threatened injury and alleged that the only injury averred in the petition was that if the application of petitioner be put in interference with the patent granted upon the other application, and if priority should be awarded to petitioner and a patent granted to it a bill in equity under § 4918, Rev. Stats., would be necessary to get rid of the menace of the outstanding patent. That the date of Fowler's invention being subsequent to the filing

date of the other party, there would be no ground of awarding priority to Fowler. That even if interference should be declared, "a litigation to be conducted between the application owned by the petitioner and the patent issued to the other party would be no longer or more expensive than a litigation to be conducted between the two applications. No suit could be brought under section 4918 of the Revised Statutes either by or against this petitioner, unless it were proved that Fowler was the first inventor and a patent issued to him; but, as above stated, the date upon which Fowler states he conceived the invention is subsequent to the date upon which the other application was filed."

There was detail of the business of the Patent Office and of the inconvenience to its administration if the right insisted upon by petitioner were allowed.

A discharge of the rule was prayed.

The Solicitor General, with whom *Mr. Assistant Attorney General Warren* and *Mr. R. F. Whitehead* were on the brief, for petitioner.

Mr. George L. Wilkinson, with whom *Mr. Melville Church* was on the brief, for respondent.

MR. JUSTICE MCKENNA, after stating the case as above, delivered the opinion of the court.

The case is not in broad compass. It depends upon a few simple elements. Section 4904, Rev. Stats., provides: "Whenever an application is made for a patent which, *in the opinion* of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question

of the priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe."

The duty prescribed by this section and the other duties of the Commissioner, it was provided (§ 483, Rev. Stats.), might be regulated by rules established by the Commissioner, subject to the approval of the Secretary of the Interior. And rules were established. They define an interference to be a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming the same patentable invention (Rule 93) and provide that an interference shall be declared between two or more original applications containing conflicting claims (Rule 94). Before the declaration of an interference all preliminary questions must be settled by the primary examiner, the issue clearly defined and the claims put in such condition that they will not require alteration (Rule 95). Whenever the claims of the co-pending applications differ in phraseology they must be brought to expression substantially in the same language and claims may be suggested to the applicants and if not followed the invention covered by them shall be considered as disclaimed. The declaration of an interference will not be delayed by the failure of a party to put his claim in condition for allowance (Rule 96). Each party to the interference will be required to file a concise statement, under oath, showing (1) the date of original conception of his invention, (2) the date upon which a drawing of it was made, (3) the date of its disclosure to others, (4) the date of its reduction to practice, (5) the extent of its use, and (6) the date and number of any foreign application. If a drawing has not been made or the invention has not been reduced to practice or dis-

closed to others or used to any extent, the statement must specifically disclose these facts (Rule 110).

Priority of invention is necessarily the essential thing, and to determine it interference proceedings are provided. But are they considered as a matter of course on the mere assertion or appearance of a conflict? Upon the answer to the question the controversy here turns. The Commissioner contends for a negative answer and supports the contention by the language of § 4904 reinforced by the assertion that there is no necessity for proceedings to determine what is already apparent as in the pending case by the admission of respondent. The mere fact of asserted antagonism does not put the proceedings in motion, is the contention. There must be the precedent and superintending judgment of the Commissioner. The law requires, it is said, his opinion to be exercised upon the effect of a conflict in applications, and such indeed is the language of § 4904. It provides that "whenever an application is made for a patent which, *in the opinion* of the Commissioner, *would interfere with any pending application*. . . . he shall give notice thereof . . . and shall direct the primary examiner to proceed to determine the question of priority of invention."

In opposition to this view petitioner replies that the only fact upon which the Commissioner is to exercise an opinion is the fact of the conflict in the applications, and, that fact ascertained, the duty is imperative upon the Commissioner to declare an interference. "Interference," it is said, "is a question of fact; it exists or it does not exist. If it exists then priority must be determined in the way pointed out by the statute and the rules." Other conditions than priority in time determine priority of invention, it is insisted; that the rules of the Patent Office and the motions for which they provide contemplate such conditions, and that in twenty-five years of practice under them "the question of interference in fact, the question

of seniority of the parties, the patentability of the claim to one or the other, and a number of other questions became *inter partes*, and it often happens that the interference is dissolved because of mistake in declaring it or the burden of proof shifted on the ground that the senior party is not entitled to his original filing date as his effective date for the reason that he did not disclose the invention in his case as originally filed, or that his application discloses an inoperative embodiment of the invention, or that he was not entitled to make the claims, or that the junior party had an earlier filed case disclosing the invention, or that the issues as formed did not apply to the structures of the two parties."

The result of the practice is declared to be that it "prevents a judgment of record based solely upon an *ex parte* consideration by the Commissioner and affords each of the parties an opportunity to contest the right of the other party to a judgment."

If there are such possibilities in some interferences they are precluded in petitioner's case. Seven claims of a prior application were adduced by the Commissioner as making a conflict with the invention claimed by petitioner. The latter, through its attorney, adopted six of the claims and directed that they be inserted in its application. It did not intimate the existence of any circumstances which would overcome the priority of invention as determined by the difference in times of the conceptions of the contending applicants.

The conceptions were thus established to be identical and that that of Fowler did not come to him until some months after the filing of the other application. And it is to be observed that the priority was complete. There was not only the precedent conception but there was its expression in claims; and that it was practical, a useful gift to the world, petitioner concedes by adopting the claims. There were, therefore, all of the elements of a completed

invention—one perfected before the filing of petitioner's application—all that the preliminary statement required by Rule 110 could disclose.

This, then, was the situation presented to the Commissioner. There was nothing shown to change it, there is nothing alleged in the petition for mandamus to change it, and there is only urged that an experience of twenty-five years has demonstrated that in interference proceedings circumstances may be shown that determine against the date of filing or the claim of invention.

If it could be conceded that there is antagonism between § 4904, and the rules, the former must prevail. *Steinmetz* v. *Allen*, 192 U. S. 543, 565. But there is no antagonism. The former provides that "whenever an application is made for a patent which, *in the opinion* of the Commissioner, would interfere with any pending application . . . he shall direct the primary examiner to proceed to determine the question of priority of invention." The section, therefore, commits to the opinion (judgment) of the Commissioner the effect of an application upon a pending one—whether it will interfere with a pending one; something more, therefore, than the fact of two applications, something more than the mere assertion of a claim. The assertion must be, in the opinion of the Commissioner, an interference with another. And it is this other that is first in regard, not to be questioned except at the instance of the Commissioner by an exercise of judgment upon the circumstances. And there is no defeat of ultimate rights; there may be postponement of their assertion remitted to a suit in equity under § 4918.

But anterior to such relief petitioner contends that "there is a fundamental and basic right of opposition on the part of any applicant, whether junior or senior, to prevent the wrongful grant of a patent to his opponent." It is further contended that the declaration of an interference and the motions which are permitted to be made

under the rules "prevent a judgment of record based solely upon an *ex parte* consideration by the Commissioner and affords each of the parties an opportunity to contest the right of the other party to a judgment." There indeed seems to be a less personal right claimed, the right of opposition in the interest of the public, displacing the superintendency of the Commissioner constituted by the law. It is to be remembered that the law gives the Commissioner both initial and final power. It is he who is to cause the examination of an asserted invention or discovery and to judge of its utility and importance; [1] it is he who is to judge (be of opinion) whether an application will interfere with a pending one; [2] and it is he who, after an interference is declared and proceedings had, is the final arbiter of its only controversy, priority of invention.[3]

The contentions of petitioner put these powers out of view, put out of view the fact that the so-called "judgment of record" is, as the action of the Commissioner may be said to be, but a matter of administration. A suit in equity may follow and be instituted by either party and even in it nothing can be determined but priority of invention. "There is but one issue of fact in an interference suit. That issue relates to the dates wherein the interfering matter was respectively invented by the interfering inventors. If the complainant's invention is the older, the defendant's interfering claim is void for want of novelty. And the complainant's interfering claim is void for want of novelty, if the defendant's invention is found to antedate the other." Walker on Patents, § 317, 3d ed.

Such suit, therefore, is the judicial remedy the law provides. Section 4904 concerns and regulates the administration of the Patent Office, and the utility of the dis-

[1] Section 4893, Rev. Stats.; *Butterworth* v. *Hoe*, 112 U. S. 50.

[2] Section 4904.

[3] Section 4910.

cretion conferred upon the Commissioner is demonstrated by his answer in this case.

Judgment reversed and case remanded with instructions to reverse the judgment of the Supreme Court of the District of Columbia and direct it to discharge the rule and dismiss the petition.